

THE LAW OF PATENTS, DESIGNS AND TRADE MARKS

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CRUIKSHANK & FAIRWEATHER, LTD.

International Patent Agency

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INTERNATIONAL PATENT AGENCY



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Searches made to ascertain the novelty of inventions.
Licences and assignments of Patents registered.
Opinions given on the validity and infringement of Patents.
Opposition and revocation proceedings conducted.
Trade Marks and Designs registered and expert evidence given
in Courts of Law, by

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13 April 54

PREFACE.

OUR object in issuing this book is, primarily, to provide an adequate reply to those enquiries which are addressed to a patent agent by inventors and others from day to day. The book is intended as a business man's guide to the law of industrial property, and touches on matters of history, industrial or political, only where historical considerations are of practical importance in the interpretation of the law as it now stands.

The subject of the protection of industrial property is hardly susceptible of uniform treatment, but, for its exposition, demands the consideration of rights of entirely distinct character. Accordingly, the first part of this book is divisible into three main sections corresponding to the three subjects of legislation, *i.e.*, patents for inventions, designs, and trade marks.

The latest of a long list of statutes relating to this branch of law are the Patents and Designs Act, 1907, and the Trade Marks Act, 1905.¹ These Acts, with the Rules made under them, deal with most of the questions that come up for discussion in daily practice. However, for the interpretation of the statutes, reference must be made to numerous cases, mostly decided under former Acts, to which careful attention has been given in the preparation of this book. Of almost equal importance to those interested is the unwritten practice of the Patent Office, our experience of which is the source of a large part of the information contained in the following pages. In view of the recent date of the Acts above mentioned, decisions are still wanting on many

¹ At the time of going to press a Bill is before Parliament intituled "An Act to explain section ninety-two of the Patents and Designs Act, 1907."

points. Where opinion is relied on, recognised authorities have generally been followed, and, as far as possible, consideration has been given, not only to the interpretation of analogous provisions in various Acts of similar character, such as the Copyright Acts, but also to the practice in the Colonies, the United States of America, and certain continental countries, though, of course, foreign legislators and foreign judges are not recognised by our Courts as guides to the interpretation of British laws.

On account of the superior importance of the subject the greater part of the book is devoted to the exposition of the law of patents, although it is almost superfluous to say that the discussion of the subject would not be exhausted in several volumes of this size. We believe, however, that the present summary will be of as much real service to business men as a voluminous treatise.

The business of obtaining patents is now practised almost exclusively by patent agents. The Patents and Designs Act provides that a person shall not be entitled to describe himself as a patent agent unless he is registered as such. One condition of registration now imposed is the passing of an examination set by the Board of Trade.

The value of a patent being entirely dependent on the manner in which the specification and claims are drawn, no one who regards his invention as worth anything at all, and looks forward to deriving profit from a patent, should either himself undertake the professional duties of a patent agent or entrust the performance to an agent who has not been recommended to him by others with experience in the matter. As many cases arise in which it is inexpedient for a prospective patentee to consult his friends before protecting his invention, we have appended a list of representative firms for whom we have had the pleasure of acting, and upon whose recommendation we are content to be judged. While far from exhaustive, this list also shows that our experience extends over the whole field of invention.

With the system of official search and examination now

adopted, it is frequently advisable and even necessary to argue an applicant's case orally before the Comptroller or to interview the examiners in connection with objections raised by them. As we have our own offices in London as well as in Glasgöw, we are in a position to render equal services to Scotch and English clients.

Besides the solicitation of patents, we undertake the duties of advisers in all matters connected with the maintenance and revocation of patents, the conduct of opposition cases, and actions for infringement of patents. In addition, we make exhaustive searches to ascertain the novelty of inventions, and prepare reports on the scope and validity of patents for reproduction in the prospectuses of public companies. Our services are also available as expert witnesses in all legal proceedings relating to patents. It is our endeavour to suit the requirements of all classes of applicants, and since all patents, whether for great or small inventions, are treated alike in law, we make it a rule to prepare personally all specifications, reports, and other documents of a confidential nature.

The subject of copyright in designs is one of increasing importance, and an attempt has been made in this book to supply a more exact summary of the practice in design cases than has, we believe, been previously offered.

Inasmuch as in case of objection to an application for registration the inspection of previously registered designs quoted by the official searcher must be made in London, and the hearing of the case also takes place in London, the necessity for direct representation there will be apparent.

While the possession of a patent for an invention or of copyright in a design rests entirely on the strict fulfilment of conditions defined by statute, the owner of a trade mark has a choice of ways of asserting his rights. Since, however, the value of the good-will of a business firm is almost wholly dependent on the degree of protection afforded to that firm's trade marks, the importance of registration

cannot be overestimated. The chapters relating to the law of trade marks deal for the most part, therefore, with the conditions precedent to, and the effects of, registration.

At this point it will suffice to remark that while objections are made to a large proportion of the applications for registration of trade marks, in most of those cases where the opportunity is taken of attending a hearing before the Registrar the objections can be overcome by proper arguments, that is, by arguments having a legal justification.

The law of property in trade marks is correlated with the general law on passing-off and with the criminal law relating to the forgery of merchandise marks, to which a brief reference is made below.

Notice is also taken of the subjects of literary and artistic copyright, and 'patent' medicines, which, however, belong in reality to other branches of law.

The second part of this book is devoted to the subject of foreign and colonial laws on patents, designs, and trade marks, the information given having been most carefully checked and being quite up to date.

The value of foreign and colonial patents or registrations depends on diverse conditions, for instance, on the suitability of the invention for foreign and colonial requirements, or the possibility of trade in the goods in face of hostile tariffs, to which consideration must be given before deciding in any case whether protection outside the United Kingdom is likely to be valuable or desirable.

We have contented ourselves, therefore, with summarising the various laws, but, where our experience may be useful in connection with other than legal questions, we shall be glad to give advice or render such other services as may be required.

We are represented by correspondents of the highest standing in every country where industrial property is protected, and, being acquainted with the principal languages employed, besides having experience of patent practice

acquired abroad, we are able to ensure accurate translation of all specifications and other documents.

We may add that we shall be pleased to give any further information required either by letter or in consultation, and also offer our clients facilities for consulting the reports, journals, abridgments and various legal and technical books and periodicals contained in our library.



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PART ONE.

THE BRITISH PATENT SYSTEM.

INTRODUCTION.

The practice of granting patents for inventions was first systematised in England during the reign of Queen Elizabeth, and even in her time provided a grievance for discussion in Parliament as well as a source of litigation. As a consequence, a long controversy arose between the Crown and the subjects, rendered more and more acute by the arbitrary action of the Crown, which exceeded legal bounds and exploited the public as a source of private revenue to the general prejudice of other interests.

The common law on the subject was expounded as follows in the famous case of *Darcy v. Allein*, decided in 1603, relative to a patent for the exclusive importation and sale of playing cards :—

“Where any man by his own charge and industry or by his own wit or invention doth bring any new trade into the realm, or any new engine tending to the furtherance of a new trade that never was used before and that for the good of the realm : that in such case the King may grant to him a monopoly patent for some reasonable time until the subjects may learn the same in consideration of the good he doth bring by his invention to the commonwealth : otherwise not.”

The alleged policy of the Crown was set forth in the “Book of Bounties,” published in 1610 by King James I., in which he differentiates petitions for illegal monopolies

from those for "projects of new invention so they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade or otherwise inconvenient."

Advantage was adroitly taken of this publication by Parliament, which passed the celebrated Statute of Monopolies (21 Jac. 1, c. 3) 1623-24, in which the expression of approval of His Majesty's declared policy is expanded into a declaration of the common law on the subject.

The sixth section of this statute, in condemning monopolies generally, excepted "letters patents, and grants of privilege for the term of fourteen years or under hereafter to be made of the sole working or making of any manner of new manufacture within this realm to the true and first inventor and inventors of such manufactures which others at the time of making such letters patents and grants shall not use so as also they be not contrary to the law nor mischievous to the State by raising prices of commodities at home or hurt of trade, or generally inconvenient. . . ."

This section is still in force, and the statement therein contained of what may be patented constitutes the present statutory definition of invention. The grant is still made in practically the same form as that originally employed, and confers on the patentee and his nominees the sole right to make, use, exercise and vend the invention, with the further right to prevent others from doing the like. This latter right is exercised by bringing an action, in which if successful the patentee may obtain an injunction to restrain further infringement, an account of profits or damages, and the costs of litigation, with the destruction or delivery up of the infringing articles.

Though letters patent are issued in virtue of the royal prerogative, it is customary in reviewing the relations between the Crown and the subject to regard them as joint parties to a contract, in which the monopoly is granted in exchange for the disclosure of a new invention. The consideration for such a contract being 'entire',

if any part of the consideration fails, or if the Crown has been deceived in its grant, the patent is void, and not enforceable.

In lieu of the royalties formerly paid to the Crown progressive renewal fees are now exacted to continue the patent from year to year. The revenue derived from these fees is largely utilised for the upkeep of the Patent Office. A further object served by the imposition is the extinction of purely obstructive patents.

The custom of filing specifications of inventions patented or sought to be patented began to be regular in the reign of Queen Anne, and the deposit of a specification of the invention is now a prerequisite of every grant. It is the invention specified for which a patent is granted, and by the specification the patent is judged.

The development of the purely Anglo-Saxon practice of granting temporary protection on lodging provisional specifications has been largely due to the International Exhibition of 1851. In the Act of 1907 the practice is established on a more secure as well as a wider basis.

The present Patent Office was established under the Act of 1883, and is under the immediate control of the Comptroller, who, in turn, acts under the superintendence of the Board of Trade, and is assisted by a staff of examiners and other officers and clerks. As before, the Comptroller may take directions of the Law Officers.

Certain other features of the patent system that may be mentioned here are either of foreign origin, or, as reintroduced into this country, have been copied from the jurisprudence of other nations.

The system of investigation into the novelty of inventions sought to be patented has long been practised in the United States of America, where examination is pursued as a science, and has been adopted in Germany and other countries. One desirable result is the tendency to prevent the issue of worthless patents, although cases do arise in

which inventors and officials take opposite views. The practice in this country is a compromise between that of granting a patent on the mere deposit of an application, and that of examination and occasional rejection, as followed in the United States.

In the earlier grants the condition was frequently imposed on the patentee of working his invention within a specified period, but this requirement passed out of use as the other requirement arose, namely, of filing a specification from which others could work the invention on the expiry of the patent. The obligation to exploit the patented invention was made statutory in the French patent law of 1791, adopted by the revolutionists to whom the idea of the social contract meant more than the old doctrine of royal prerogative. A like provision has been incorporated in the patent legislation of almost every foreign country, the United States of America presenting a noteworthy exception. The principle has now been definitely accepted in this country, and the Act provides an effective remedy against the abuse of patents that are taken out to further foreign manufactures at the expense of native industries.

The practice of protecting improvements on a patented invention by patents of addition which remain in force with the principal patent without the payment of further renewal fees was instituted by the French patent law of 1844, and has now been adopted in all European countries, in the United Kingdom latest of all.

The Act of 1907 introduces further changes which have been found necessary in the execution of the law, and also provides simpler and cheaper procedure. These and the subjects above mentioned are discussed at greater length in the following commentary.

WHO MAY OBTAIN A PATENT.

The Statute of Monopolies recognised as lawful patents granted to 'the true and first inventor' only 'of any manner of new manufacture within the realm.' Consequently, a patent granted to anyone other than the true and first inventor would be outside the sixth section, and share the condemnation of other monopolies declared by the Statute to be void and of no effect.

In patent law, the term 'inventor' still has the same general meaning as it had at the date of the Statute.

Primarily, the true and first inventor is the person who, being a true inventor—that is, not having borrowed the invention from someone else—either first publishes the invention or first files in respect thereof a specification on which letters patent are granted.

The fact that before an application is filed by an inventor another has already made the same invention will not by itself avoid the letters patent subsequently sealed, even though the applicant for letters patent be in point of time the later inventor of the two. There may be many discoverers starting at the same time, many rivals running on the same road, and it is the first of these to come to the Crown and take out a patent, the invention being yet unknown to the public, who has the right to clothe himself with the authority of the patent and to enjoy its benefits. On the other hand, a man may first publish to the world something which is perfectly new in all its use and has not before been enjoyed, and yet he may not be the true and first inventor: he may have borrowed the idea from some

other person or taken it from a book, and certainly the legislature never intended that a person who had taken his knowledge from the art or labours of another should be the one to receive the benefit of the other's skill.

Among the earliest patents granted were those for the introduction into this country of industries practised exclusively abroad. Such monopolies were recognised as valid at common law, in the exposition of which quoted from the case of *Darcy v. Allein* they are placed on the same footing as patents for original inventions. It was stated again in the case of the 'Clothworkers of Ipswich' in 1615:—

"If a man hath brought in a new invention and a new trade within the Kingdom in peril of his life and consumption of his stock, *etc.*, or if a man hath made new discovery of any thing, in such cases the King of his grace and favor in recompense of his costs and travail may grant by charter unto him that he alone shall use such trade or traffic for a certain time because at the first the people of the Kingdom are ignorant, and have not the knowledge or the skill to use it. . . ."

This statement of the law has frequently been approved of since, and at the present day the first importer of an invention into the realm can apply for a patent as the 'true and first inventor,' and occupies in the eye of the law the same position as the actual author of an invention.

Instead of bringing their inventions personally from abroad, it became customary for foreigners and others to communicate them to residents in this country, who, on application, received patents in their own name in trust for the foreign correspondents. At the present time patents are granted to foreigners and British subjects equally, although residents abroad must give an address for service in the United Kingdom. The practice of communicating inventions is, however, still found useful, as it avoids raising the question of the authorship of the invention. The communicatee need not be a meritorious importer, and may be merely an agent or servant: the communicator may be

any person, firm or company located outside the United Kingdom and the Isle of Man.

Again, the patentee may be a person to whom part of the invention has been communicated from abroad and who has himself invented the other part.

The usual application form contains a declaration to the effect that the applicant claims to be the true and first inventor of the invention. Since the patent is granted by the Crown on the strength of the applicant's declaration, if deception be practised on the Crown in making the declaration, the patent will be invalid.

Accordingly, when several persons have together made an invention all must join in making an application for a patent: the omission from the application of the name of any of the inventors is fatal, for in that case the applicant or applicants did not invent the thing sought to be patented, but only helped to invent it.

Again, the patentee must be the true and first inventor of every part for which he claims protection. If he claims a number of things as being the inventor of them, when in fact some of them are not original, the patent will be void.

Where, however, a person having discovered a new principle in a manufacture employs others to assist him in carrying out that principle, and they in the course of experiments arising from that employment make valuable discoveries accessory to the main principle and tending to carry that out in a better manner, the improvements so made are the property of the employer, and may be embodied in his patent. It is often difficult to determine how far the suggestions made by a person employed to carry out an invention are to be considered as distinct inventions by him so as to avoid a patent incorporating them taken out by his employer; but where the main principle and object are complete without the suggestions, and the suggestions are only of matters calculated to carry

into effect the conceptions of the employer, they are considered as merely accessory.

In connection with the relations between master and servant, it is to be observed that the mere existence of a contract of service does not *per se* disqualify a servant from taking out a patent for an invention made by him during his term of service, even though the invention may relate to subject matter germane to and useful for his employer in his business, and that, even though the servant may have made use of his employer's time and servants and material in bringing his invention to completion, and may have allowed his employer to use the invention while in his employment. Cases may arise, however, in which it is inconsistent with an observance of the good faith which ought to be inferred or implied as an obligation arising from a contract of service that the servant should hold the patent otherwise than as trustee for his employer, and a declaration of the Court to that effect may be obtained.

Later legislation has in certain respects modified the rule that the patentee must be the inventor.

Any person, or the legal representative of a deceased person, who has made a previous application for protection of an invention in any of the foreign states or in any of the British possessions with which certain arrangements for mutual protection of inventions are in force (see pages 97 to 99) may apply for a patent in the United Kingdom, claiming the priority of the foreign or colonial application, without making a declaration of inventorship.

The Act also authorises the grant of a patent to the legal representative of an inventor who has died before applying for a patent, or of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent: in the latter case the patent may be sealed at any time within twelve months after the date of the applicant's death.

A joint application may be made by two or more persons, some or one of whom only are or is the true and first inventors or inventor. In this way a capitalist, employer or other person having an interest in an invention can control the prosecution of the application. In such a case it must be stated in the application which of the applicants claims or claim to be true and first inventor or inventors.

In some cases an inventor may be debarred from taking out a patent by virtue of his position or of the terms of his employment. On the other hand, certain persons, *e.g.*, minors and married women, though subject to disabilities in other directions, have yet the right to apply for and hold a patent.

If the inventor is a lunatic or other incapable person, application for a patent may be made on his behalf by his guardian or committee, or a person appointed by any Court possessing jurisdiction in respect of his property.

A company (body corporate) or a firm or partnership may apply for a patent as joint applicant with the inventor, but not as sole applicant, unless the application is made in respect of an invention communicated from abroad, or under the international or colonial arrangements.

WHAT MAY BE PATENTED.

When the Statute of Monopolies was drafted with the Book of Bounties as a basis, the definition 'any manner of new manufacture' as the only proper subject for a monopoly was substituted for the royal description 'project of new invention.' The Act of 1907, in turn, refers back to the Statute of Monopolies for the meaning of 'invention,' the only subject matter for which a patent can be validly granted under that Act.¹

However simple the statutory definition may have appeared in 1624, it is far from easy at the present day to locate exactly the boundaries of what it covers. On the other hand, it is all important that the whole of the matter claimed in a patent should be within the definition; otherwise, the consideration failing, the grant is contrary to law and of no effect.

With the question of the consideration for the grant may also be discussed the various questions which condition the validity or invalidity of patents in respect of their subject matter. The seven following chapters are arranged corresponding to the requisites for every grant, *viz.*, that the subject shall be a manufacture, which is new, invented, and useful, and neither previously used, nor previously patented, nor contrary to law or morality.

It should be noticed that only in respect of very limited

¹The term 'invention' has a double significance in the language of patent law. As above used it is synonymous with 'new manufacture.' In another use it stands for the abstract conception of ingenuity.

particulars is the question of validity or invalidity of a patent entertained or decided within the Patent Office. Every patent is granted at the inventor's risk and without guarantee, and its validity may be disputed in subsequent proceedings. A valid patent is therefore to be understood as meaning one that can be maintained at law, and not merely one which has been sealed by the Comptroller.

MANUFACTURE.

'Manufacture' necessarily implies production or industry and, as a corollary, the employment of labour. The development of these within the Kingdom is and has long been one of the chief cares of the grantors of patents, and it is for this purpose that the sole right to work according to a specification is conferred on the patentee of a new manufacture.

In law the term 'manufacture' may mean either the art of making or performing something, or something made by art. Again, a new manufacture may be entirely novel, or merely improved, or it may be a new or improved stage or part of a composite manufacture.

To facilitate the conduct of searches and official investigations, all inventions patented since 1855 have been officially allotted into 146 classes. For the present purpose, however, it is convenient to consider all that can be termed manufactures as belonging to one or other of four main groups or divisions: (1) processes, (2) machines, (3) compositions of matter, and (4) articles of manufacture.

'Process' may be generically defined as 'an operation performed by rule to produce a result.' A patentable process is an operation of winning, treating, or preparing raw or partly finished materials, and the result of such process an industrial result. A process as such cannot be handled, and is seen only by noting the performance of its constituent steps. On this account processes are

frequently confused with so-called 'principles,' which are equally intangible, but are not patentable.¹

There may be classified as 'machines' all contrivances, apparatus, devices and structures for producing a result. The majority of inventions are of this type, and are generally characterised by involving new industrial applications of scientific laws or natural forces, *i.e.*, principles in the sense above used.

The phrase 'composition of matter' does not include products of nature, but covers all artificially produced compositions of two or more elements or substances, final products as well as intermediate products, the results of chemical union and of mechanical mixture, whether they be gases, liquids, powders or solids. The definition does not exclude artificially prepared food-stuffs and pharmaceutical compounds.

All other patentable matters are 'articles of manufacture,' that is, artificially produced commodities, perfected or not, distinguished from machines and the like on the one hand as being the resulting products rather than means for producing results, and from compositions of matter on the other hand by possessing useful properties and functions as a whole, not shared by every fraction of the same.

The distinction between a machine and an article of manufacture is not so definite and precise that its application will be clear to every mind. The same remark is true of the distinction between articles of manufacture and compositions of matter. So long, however, as the thing claimed is a new manufacture, uncertainty on the question to which of these classes the invention belongs is not

¹ Further confusion arises due to the ambiguity of the term 'principle.' In the popular statement 'you cannot patent a principle' the expression should signify a bare scientific theory or law of nature, which is obviously outside the definition 'manufacture.' If, however, 'principle' be understood as meaning the essence or substance of an invention underlying the mere accident of form, it may be truly said that every patent is granted for a principle.

fatal, although omission to appreciate the distinction may mean failure to secure the fullest protection available. On the other hand, nothing that does not come under one of these categories is patentable, however meritorious or valuable it may be.

The raw materials available for manufacturing purposes are those offered by nature to mankind. The living human body is certainly not such a material, for which reason it is held that neither a surgical operation nor a course of medical treatment in itself constitutes subject matter for a patent; in fact, practically the only patentable process of treating the human body is a process of embalming the dead. On the other hand, patents are regularly granted for surgical apparatus, articles of clothing, in short, for all invented commodities for human use.

Again, inventions of manufactures are to be distinguished from purely intellectual exercises, *e.g.*, a proposition for a universal language, a system of shorthand, a system of book-keeping, or a mere scheme or plan, for example, a plan for becoming rich, or a plan for the better government of the State.

The Comptroller of the Patent Office has jurisdiction to decide whether the subject of an application for a patent constitutes a manufacture within the meaning of the Act. By direction of the Law Officers applications for patents are not accepted in the following cases: (a) where no material product of a substantial character is realised or affected by the alleged invention, or where the only material product is a printed sheet, ticket, coupon, or its equivalent, for use in carrying out some scheme of business or the like; (b) where it is proposed to use, modify, or imitate natural conditions existing on the earth's surface, there being no invention as to the means or apparatus applied to these purposes.

NOVELTY.

Both statute and common law require as a condition of validity that the subject of a patent shall be new within the realm. No other qualification can take the place of novelty; on the other hand, novelty alone will not suffice to make a manufacture patentable.

It may be at once stated that legal novelty and newness as ordinarily understood are not quite the same thing. In the eye of the patent law a thing may be new notwithstanding that it has long existed; legally, it only loses its novelty when it comes into the possession of the public of this country. This is in accordance with the doctrine that the first inventor is the first to publish the invention, whereas, if the public is already in possession of an invention, there can be no consideration for the grant of a monopoly. Again, a thing is not necessarily lacking in novelty merely because there has been something like it before; it is sufficient that it should be distinguished by sufficiently important characteristics from what has previously existed. Conversely, a thing may be old as being substantially the same as something already known, although there is a superficial difference.

For a thing to be known to the public it is not necessary that every individual member of the public should know it. To disprove the novelty of an invention for the purpose of the patent law, it is sufficient that the fair conclusion from the evidence should be that some people in this country besides the patentee, able and free to communicate their knowledge to others, knew of the invention before the date at which that invention came under the operation of the law.

A patent for an invention which lacks the quality of legal novelty is said to be anticipated, while the facts which destroy novelty are expressed in the general phrase 'prior publication.' Subject to certain exceptions noted below, anticipation is to be proved by evidence that before the record date claimed as the date of protection the invention

was within common knowledge or was communicated to some member of the public by oral disclosure or ocular demonstration, by public user, or from a description or drawing of the invention appearing in a document accessible to the public.

Common knowledge may be established on the evidence of witnesses who can testify to the state of general public knowledge at the date in question, that is, knowledge of the invention in its practical application as distinguished from theoretical knowledge. Since, however, it suffices to prove individual previous knowledge of the thing claimed, evidence as to general public knowledge is usually brought in support of the issue of absence of invention rather than that of anticipation.

Prior publication will, in fact, be proved by evidence that, before the record date above referred to, the invention was revealed without reserve to some person or persons in such a manner that the invention could be carried out from the information given without the necessity for further experiment and research.

To constitute publication the disclosure must have been understood and the recipient of the information capable of explaining the invention to others. For instance, if the invention was shown to a boy of eight, that would not be publication of an invention which it would have needed an expert to find out.

Publication becomes more pronounced as the number increases of those to whom the invention was disclosed. Room for doubt hardly exists when the invention has actually been explained in all its details at a lecture or public meeting. On the other hand, the mere circulation of a statement that a result can be obtained, in the absence of the necessary directions for obtaining it, will not be a disclosure sufficient to anticipate a claim for an unknown process or means for producing that result.

The Court has decided that information obtained by fraud, or disclosure in confidence or to persons in a fiduciary

relationship to the patentee, is not such a publication of an invention as will avoid a patent, although the invention will be published if these persons, in breach of confidence, disclose it to others.

To mitigate this hardship the Act provides that a patent shall not be held invalid by reason only of the invention, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the Court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication.

On the other hand, constructive abandonment follows neglect or failure on the part of an inventor to take the first opportunity of protecting his invention when faced with involuntary publication.

Further, a patent granted to the true and first inventor is not invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

The Act also provides that on prescribed conditions exhibition of an invention at certain exhibitions will not be held to be anticipatory (pages 100 to 101).

Inventions for improvements in instruments or munitions of war submitted to the War Office or to the Admiralty are protected from the consequences of publication by a special sub-section (pages 107 and 108).

There is a very important distinction between secret knowledge of an invention, even by a number of persons, that is knowledge locked away and withheld from others, and knowledge in process of circulation from one to another, the end of which is or may be that the so-called secret is

shared by all the world. The fact that before the date of application for a patent some person other than the patentee was already in possession of the invention, but confined his secret within his own breast, or showed it only to those in his confidence and under the seal of secrecy, even if proved, throws not even a shadow on the title of a later inventor who, by his specification, first publishes the invention to the world.

To be published, an invention need not be actually explained to the public. The invented article may tell its own tale, and this it may do if left or placed in such a position that members of the public can readily understand the invention without further explanation, for instance, in a workshop to which members of the public, not being employees bound by any rule of secrecy or faith, have free access, in a public highway, in a museum, or in an exhibition, without being protected under the special provisions relating to exhibitions, even in a private house, if open to visitors, or in a shop, whether it be sold or merely exposed for sale.

The issues of prior publication and prior user overlap in many cases. User which constitutes publication is public user, that is, user in public, though not necessarily by the public. On the other hand, as will be noticed below, there may be a case of prior user which does not amount to prior publication, but which, if it was not experimental, will suffice to avoid a patent.

Because, however, a proved case of user is of an experimental nature it does not follow that the invention has not been published, provided members of the public having seen the experiments could repeat them indefinitely without difficulty.

It is evident that knowledge of an invention cannot be communicated to the public until the invention has been completed, so that an experiment, though publicly made, which resulted in failure, cannot of itself be presumed to amount to disclosure of a perfected invention. It is

certainly not for the public benefit that an inventor who has achieved little or nothing should be able to block the way to others. This is eminently so when the first experimenter, so far from showing the way to success, has left his wrecked barque as a warning to others who might be thinking of pursuing the same channel.

Novelty is not affected by prior user abroad, provided knowledge of the invention has not reached this country. On the contrary, the first importer into this country of an invention already in use abroad has the same claim to protection as the actual originator of an invention.

An invention which has not yet been reduced to practice in this country may have become public property so as to prevent a valid patent being granted for it, if, before the record date of protection, a description or drawing of it appeared in a book or document or specification to which the public of this country have access, so that the fair and legitimate inference must be that they had knowledge of its contents.

In connection with 'paper' anticipations two conditions must be satisfied, *viz.*, the description given must be sufficient to convey to others a knowledge of the identical invention, and it must have been accessible to the public in this country.

Accordingly, the antecedent description must disclose a practical mode of producing the result which is the effect of the subsequent invention. A barren general description, though containing suggestive information or involving some speculative theory, will not avoid for want of novelty a successful invention covered by a subsequent specification, unless it is ascertained that the antecedent publication involves the same amount of necessary information.

Whatever is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the invention, they must be found substantially in the prior publication.

Apparent generality, or a proposition not true to its full extent, will not prejudice a subsequent statement which is limited, accurate, and gives a specific rule of practical application. The reason is manifest, because much further information, and presumably further invention, are required before the real truth can be extricated and embodied in a form to serve the uses of mankind. It is the difference between the ore and the refined and pure metal which is extracted from it.

It is necessary that the description relied on as a prior publication should be such as will when carried out lead to the thing patented; otherwise, however similar the description may be, if it will not produce the alleged invention it will not amount to anticipation.

If there is similarity of language in two specifications, and yet there are terms of art found in the one specification and also terms of art found in the other specification, it is impossible to predicate of the two with certainty that they describe the identical external object, until it is ascertained that the terms of art used in the one have precisely the same signification and denote the same external objects at the date of the one specification as they do at the date of the other.

It is not necessary that the anticipating document should be in the English language. It may be in German or French or any other language generally understood, provided that, if translated, the description would be a sufficient disclosure of the invention; or the invention may be published in a drawing alone unaccompanied by letterpress.

There may not be sufficient description in an earlier document itself to sustain a patent, and yet that description may suffice to anticipate a later patent if it conveys to experts such information as will enable them, without further research or experiment, to understand the invention and to give a workman the specific directions which the prior description failed to communicate.

Two or more documents which are public knowledge and which indicate discussion and invention in the same line may fairly be taken together and form a publication of a subsequent invention, but it is not permissible to take a mosaic of extracts from different sources and thereby deny the novelty of an invention which consists in the construction of a whole, the component parts of which have never been put together in the manner claimed by the inventor.

Difficulty is always experienced in dealing in the abstract with cases where the alleged invention consists in a combination of old things, because one has to start with the proposition that every thing is old, and until one applies himself to what is the particular exigency to be dealt with in inventing the new combination for the purpose specified he does not appreciate what that invention is: that is to say, until he puts it in a concrete form so that it can be seen what that thing is, and what the thing was intended to do, and then applies his mind to see whether the thing in its combination has been anticipated or not.

The mere existence of a printed or written document is not a publication: it becomes so only when the document is accessible to the public in this country.

Thus, a man may describe an invention in his own diary or in a confidential letter to a friend, and that description may never come before the eyes of others. But the distribution, or sale, or exposure for sale, or deposit in a public library of a document, so that some members of the British public may be supposed to have knowledge of its contents before the record date of protection of the invention, will constitute as complete a dedication to the public of the matter described or shown in the document as if the patentee had himself assigned that matter to the public. Such a publication is, however, to be distinguished from a case in which a book has been immediately recalled before a single copy was sold, or in which, though deposited in a library, it has neither been catalogued nor put within reach of readers. The existence of a single

copy of a work, brought from a repository where it has long been kept in a state of obscurity, affords a very different inference from the production of an encyclopaedia or other work in general circulation. In fact, the question in every case is whether, on the whole evidence, there has been such a publication as to make the description a part of the public stock of information.

The Act provides that an invention covered by any patent applied for on or after 1st January, 1905, shall not be deemed to be anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification.

The limitation imposed by the Act does not affect the questions of prior publication in documents other than British patent specifications and of prior user in this country.

The question arises, therefore, whether the publication in a newspaper or periodical or in a book or a foreign specification of a copy of, or an extract from, a prior specification more than fifty years old will be held to anticipate a later invention. Evidently, had there been no corresponding British patent the other publications would be entitled to consideration on the question of anticipation: it seems beyond doubt, therefore, that the existence of the earlier patent in addition to such publications only makes the case against the later patent so much worse instead of better.

There is uncertainty, however, regarding the effect of publication in the old series of official abridgments of patent specifications, some of which at least are sufficiently detailed to enable a practical man to realise an invention which might be claimed at a later date. It is submitted that such documents, which are issued solely by the Patent Office, and contain only reduced specifications, ought not

to be looked at to decide a question of anticipation. To arrive at a different conclusion would be to stultify the terms of the Act.

The date beyond which publication must be proved in order to anticipate a claim for any invention is, except in the special cases indicated above, the record date of protection of that invention. As a rule this date will be the date of filing the application for a patent. If the application is post-dated, however, publication need only be proved to precede the post-date. In other cases parts of what is patented may stand in different relations in regard to time, and publication of any part claimed must, to be effective, precede the date of leaving a specification describing that part. Similarly, if the application is ante-dated, publication must be prior to the ante-date.

In all proceedings relative to patents the calendar day of twenty-four hours is the smallest fraction of time considered. It is, therefore, unnecessary to enter into questions regarding simultaneous publication and application. On the other hand, since a new application for a patent left at the Patent Office or delivered through the post after working hours will only be entered on record on the succeeding day, or, if a Sunday or other excluded day intervenes, on the next following day, precautions must be taken against risk of publication before the actual date marked on the official certificate of protection.¹

Anticipation is not averted by the fact that the patentee was unaware of any anticipating publications when he conceived his invention. Otherwise, patents would be granted not for exclusive knowledge, but for exclusive ignorance.

Where a complete specification has been filed pursuant to an application for a patent, a search is made by an official examiner for the purpose of ascertaining whether

¹The application department of the Patent Office is open from 10 A.M. and closes at 4 P.M. on week days, and at 1 P.M. on Saturdays, and is closed altogether on Sundays and on public holidays.

the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) left pursuant to a prior application for a patent made in the United Kingdom within fifty years before the date of the application. However, the official search is not made until a complete specification with claims has been filed so that it is generally desirable, before the expense of getting a patent is incurred, to make a preliminary investigation through the official abridgments of patents in the particular class. It frequently happens that a qualified agent can, from his own experience, at once point out to intending patentees wherein their inventions are anticipated by previous patents, and thereby save them useless expense and future litigation.

It must not be overlooked that since only British specifications are considered by the examiner the official investigation is in no way a final one. Accordingly, in the event of litigation on a patent, both parties will usually find it necessary to make an exhaustive search through extant literature, the plaintiff to ascertain that his claim is good, and the defendant to find, if possible, publications that may invalidate the patent. Such a search should obviously be made by an agent qualified to give evidence as to the effect of the publications, particularly as the result of such an action generally hinges on the question of novelty.

In the case of the sale of a patent the purchaser ought always to have a search made in order to avoid spending money on what may prove to be old and worthless, and also to ascertain that the working of the invention will not involve infringement of other patents.

In the formation of a public company to exploit a patent, the report of a patent agent on the novelty of the invention in question is usually an important feature of the company's prospectus.

We are prepared to make such searches and to frame such reports, without, however, giving any guarantee that

our views will prevail in the event of the patent reported on coming before the Court. Such searches are, however, as thorough and complete as the material available permits, and reports are only written and signed after careful personal consideration of all the particulars that affect the case before us.

INVENTION.

To be patentable it is not sufficient that a manufacture is *de facto* novel. The Crown can validly grant a patent only for something invented, but not for any thing otherwise produced, though ability of a high order was required to produce it. Whether novelty is claimed for a process, apparatus, article or composition of matter, it must exhibit the redeeming quality of inventive ingenuity. The Statute cannot be invoked to curtail the rights of the ordinary skilled workman by monopolising matters seized, as it were, out of his hand; rather, so far are these rights safeguarded that the inclusion in a patent of a single substantial claim for matter wanting in invention renders the entire grant invalid.

It is not essential that an improvement should be important and necessary for the public good. On the contrary, an inventor who takes but a small step forward has the same legal right to a patent as the pioneer who revolutionises the world's industry. The consideration is an invention, however great or small it may be. On this account *Chief Justice Eyre* upheld James Watt's patent for his steam engine, while, a century later, the House of Lords decided in favour of a patent for a ladies' bustle.

What the law considers is the service rendered to industry. It looks to that fact without being preoccupied with questions as to its origin or consequences. Is there invention? The law requires no more. It has not to consider the labour of the inventor. So much the better for him if his invention has cost him neither trouble nor expense, or if the invention is profitable to him as com-

pared with his initial outlay : so much the worse for him if the invention has involved great pecuniary sacrifice, if it was attained only after almost endless labour, or if it has cost him his life even, so that the invention can no longer profit him.

Whatever mental exertion was called for in the individual, or however great the difficulty overcome appears to him, in the interests of the public it is to be considered what the public was and is entitled to use. As will be seen later, however, questions of fact as to the existence of gaps to be bridged, of obstacles, foreseen and unforeseen, between the starting line and the winning post, may be very relevant in determining whether or not invention was needed to arrive at the result which the patentee was the first to realise.

Judicial dicta on the question of ' subject matter ' abound. It is in the nature of the subject that they should be expository of what is not rather than of what is invention, and establish only negative rules that operate by a process of exclusion. The real difficulty, however, in all patent cases is in the application of these rules, as will be appreciated after consideration of the instances given below.

Invention is not the same thing as discovery. Discovery adds to the amount of human knowledge, but it does so only by lifting the veil and disclosing something which before had been unseen or dimly seen. Invention also adds to human knowledge, but not merely by disclosing something. Invention necessarily involves also the suggestion of an act to be done, and it must be an act which results in a new product, or a new result, or a new process, or a new combination for producing an old product or an old result. On the one hand, the discovery that a known thing can be used for a useful purpose for which it has never been used before is not alone a patentable invention. On the other hand, the discovery how to use such a thing for such a purpose will be a patentable invention if there is novelty in the mode of using it as distinct from the novelty of purpose, or if any new modification of the thing,

or any new appliance is necessary for using it for its new purpose, and if such mode of user, or modification or appliance involves any appreciable merit. In such a case the invention may either be found in a new process or step in a process, or in a new combination or element of a combination.

Where the alleged invention consists in the new application of an old thing, the main consideration is whether the new application lies so far out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, whether the step into the unknown is not an obvious deviation from what was previously known.

The following propositions may be taken as established: (1) A patent for the mere double use of a known contrivance, without any additional ingenuity in overcoming fresh difficulties, is bad, and cannot be supported. If the new use involves no ingenuity, but is in manner and purpose analogous to the old use, although not quite the same, there is no invention. (2) On the other hand, a patent for a new use of a known contrivance is good, and can be supported, if the new use involves practical difficulties which the patentee has been the first to see and overcome by some ingenuity of his own. An improved thing produced by a new and ingenious application of a known contrivance to an old thing is an invention within the meaning of the statute.

A process may be either new or improved, and may lead either to a new result or to an old result. Save as regards the scope of protection obtainable, there is no difference in kind between such processes in the eye of the patent law.

New processes are most frequently met with in the chemical industry: this branch of the subject bristles with difficulties, introducing, as it does, questions of chemical equivalence, homology and isomerism, which practically defy the application of any abstract rule.

A process may be improved by addition of a step or steps, by omission of a step or steps, by substitution of one or more steps for another or others of a known process, or by rearrangement of the cycle of steps. In any of these cases the invention may be measured either by the beneficial difference in the result, or by the increased economy, safety or efficiency of the operations performed.

For an invention of a process it is immaterial whether the means or apparatus employed in performing the process be new or old.

There is good authority for this proposition of law : ' Select one of a known class of machines, use it in the manner indicated in the specification, and which is insisted upon as being the essence of the patent and you will produce a new article : that could be the subject of a patent.'

Again, operating with a selection from known materials and thereby producing a beneficial result may be invention.

On the other hand, there is no basis for a process claim in an alleged invention which consists merely in subjecting materials to a known operation previously applied to strictly analogous materials when the result is logically deducible from the prior art. Nor does it necessarily follow from the circumstance that a new machine is employed for a particular purpose that the mode of operation of that machine amounts to a patentable process.

The following remarks of the late *Lord Davey* in reference to *Willson's* patent for improved metallic carbides applicable for use in the production of acetylene may be quoted with reference to patents for products :

" I need scarcely say that if the patentee had discovered a new material of the character which he mentions, a material having the very valuable commercial properties which he ascribes to it, that would have been a good subject for a patent, and there could have been no question, supposing he had done so, that his patent was a good one. He would be bound, of course, to state the means

by which he produced that material: but the novelty of the means or the process by which the material was produced would have been immaterial, because the merit and novelty of the invention would consist in the substance produced itself."

While the distinguishing feature of an invention of a composition of matter lies in the selection of the ingredients or of the proportions, there is no subject for a patent in the mere substitution of a recognised chemical equivalent for any part of a known composition, unless the new part endows the composition with an additional property, that could not be expected to follow from the substitution, nor in a mere change in the proportions, unless the result is an entirely distinct substance, having an entirely distinct function.

In the case of an article of manufacture the question of invention is to be determined by consideration of the merits of the form or construction and functions of the article rather than of the materials of which it is made. There may be invention, however, in substituting superior for inferior materials if the substitution develops new properties and uses of the article made which were not or could not be known beforehand: on the other hand, there is no invention in an article which differs from some older thing only in excellence of workmanship or magnitude.

Invention consists in many cases in putting together items of common knowledge which no one else has previously succeeded in combining. Inventions of machines are generally of this type.

A proper combination for a patent is the union of two or more integers, every one of which may be perfectly old, for effecting a new object or for effecting an old object by a new mode of operation. But the point of a combination patent must be that one result is produced as the product of the combination, and not a mere aggregate of several results, each the result of one of the combined elements.

While there may occasionally be doubt whether a certain union of integers is to be regarded as an invention of a combination or an aggregation, the question of patentability is answered in the negative for another reason, namely, want of novelty, when the alleged combination is a mere collocation of existing machines each doing its own work.

It does not follow from the fact that a particular machine constitutes a combination as distinguished from a mere aggregation that that machine is patentable. On the contrary, few judges would hold it invention to combine old devices into a new machine or apparatus producing no new result and having no new mode of operation. Equally, there is no apparent invention in merely duplicating one or more of the parts of a machine or apparatus, unless the duplication is accompanied by a new mode of operation or produces a new unitary result.

There may be invention in adding an element to an old combination, if the addition is not obvious, and the result of the complete whole is not merely the arithmetical sum of the old and the new contributions.

Similarly, there may be invention in substituting a part for any of the other parts of a combination so as to produce a more efficient entity, but not if the part inserted is a recognised equivalent of the part omitted and the function of the combination is unaltered.

It is seldom invention merely to alter the form or size or degree of part of a combination. Exceptions to this rule are generally cases where the alteration was the immediate cause of the first practical success attained by that combination.

There may be invention in omitting one or more of the parts of a combination if that omission causes a new mode of operation of the parts retained. Thus, a reconstruction of a machine so that a less number of parts will perform all the functions of the greater may be invention of a high order, but the omission of a part, with a corresponding omission of function, so that the remaining parts do just

what they did before in the combination, is only a mere matter of judgment, depending on whether it is desirable to have the machine do all or less than it did before.

The merit of a new combination depends very much on the result produced. Where a slight alteration turns what was practically useless before into what is very useful, and very valuable, though the invention is apparently small, but the result is the difference between failure and success, the patent will be upheld.

If an improvement is valuable by reason of its simplicity, there is a danger of being misled by that simplicity into the belief that no invention was needed to produce it. But experience has shown that not a few improvements, some of which have revolutionised the industries of this country, have been of so simple a character that, when once they were made known, it was difficult to understand how the ideas had been so long in presenting themselves, or not to believe that they must have been obvious to everyone.

The incident of Columbus and the egg is paralleled in the history of many inventions. As said by Francis Bacon: "Such is the infelicity and unhappy disposition of the human mind in this course of invention, that it first distrusts and then despises itself: first will not believe that any such thing can be found out; and when it is found out, cannot understand how the world should have missed it so long."

As a general rule, if a new article or process produces a beneficial result, never attained before, it may be presumed that invention was required to arrive at that result. The chief exception to this rule is found in cases in which the result was never attained before only because it was never desired.

The presence of invention may be assumed on evidence that skilled persons have attempted and failed to solve the problem of which the patentee has supplied the first meritorious solution. It may be that a man has hit upon

the right thing which others have failed, perhaps by a small margin, to hit, but not having hit it they have failed; whereas his invention once made proves an unqualified success. In such a case there may not be much or decided invention: there may, however, be enough. On the other hand, invention may be presumed to be absent if any skilful mechanic, electrician, chemist, or other expert, could produce the desired result without difficulty as soon as he directed his mind to the subject, and without research or experiment on his part. Evidence is worthless, however, which only goes to show that a person who has seen the patented thing can reconstruct some older thing so as to make it similar to that covered by the patent. It is obvious that the force of arguments for or against a patent based on alleged difficulties to be overcome and experiments made by the patentee and others depends very much on the inventive faculty and knowledge of the experimenters, and while opinions of experts may be of great assistance, the question of invention must, in the end, be determined from the object itself, and not from evidence that a particular person was a longer or short time in arriving at it.

The fact that there was a demand for some considerable time and the fact that it was not met for a considerable time, though known, may indicate that the mode by which the demand was ultimately met could not have been so very obvious as otherwise might have been supposed. Again, where an article when introduced has driven all others of the kind from the market and the public will buy no other, it is a legitimate element of consideration that an improvement comparatively small has produced complete commercial success. But a large sale does not alone prove the presence of invention, for the large sale may be attributable to judicious advertising and business energy, or to changes in fashion, or to development of other industries creating a demand for the patented article.

In determining whether or not an alleged improvement involves invention, it is essential to know what was the existing state of knowledge at the date of the patent, and the determination must in every case follow a comparison

between the condition of affairs at the time and that just after the application was made.

From the point of view of invention all disclosures prior to the date of filing the specification must be considered, whether they were successful or not. In this respect the objection of absence of invention differs from that of anticipation.

It is neither an argument against nor in support of the validity of a patent that the use of the improvement protected thereby involves the use of another admitted invention which may or may not be patented, assuming, of course, that the claim is restricted to the improvement. In no case, however, can there be a valid patent for an improvement upon a known process which amounts practically to no more than a working caution and direction, or for merely a rather more skilled use of the same known tool.

The question whether there is present an invention worthy of being patented is a question, the final answer to which must depend on the facts of the particular case in which it arises. So far from there being a general definition of 'invention' which will serve as a sesame by which to arrive at the answer to that question, the truth is, it is impossible to define the word 'invention' in such a manner as to afford any substantial aid in determining whether the devising of a particular improvement involves an exercise of the inventive faculty or not. In a given case it may be possible to say that there is present invention of a very high order: in another it may be apparent that there is lacking that impalpable something which distinguishes invention from simple mechanical skill: but what is the abstract level to which skill can reach without amounting to invention no one can say. Assuming the existence of an ideal boundary line between skill and invention, opinion will differ as to the position of this line. It will differ because of the difference in knowledge and intelligence of those who seek to locate it, and for the reason that what seems analogous to one is remote and dissimilar to another, and

what is obvious to one mind may even be beyond the understanding of another.

The difficulty is not eliminated in the concrete case. The well-read patent agent has at hand a collection of judicial decisions from which he can usually select at least one case fairly analogous to that in issue, and find in this quarter confirmation of his opinion or the reverse; but he can also advise his clients how far from conclusive is any *ex parte* opinion, and how little, indeed, any one case governs another.

The preceding paragraphs represent an attempt to extract and lay down the principles underlying many judgments touching the presence and absence of invention, but in this domain no rule is absolute, nor does it follow from the fact that a particular rule meets or seems to meet a given case that that case is forthwith decided by the application of the rule.

This chapter may be appropriately concluded with a brief reference to the question of the genealogy of an invention.

In the evolution of every invention four different stages can be distinguished: (a) speculation in the presence of a technical problem, (b) the solution of the problem, (c) the mode of carrying the solution into effect, and (d) the reduction to practice.

The first stage can never be patented. The mere recognition of a problem without at the same time tendering a solution is never an invention, although frequently the chief merit of an invention lies in the appreciation of the problem. The second stage may be an invention, but only in case the third stage is already reached, for otherwise an industrial result would be wanting. The third stage can be patented independently if the particular mode of carrying the solution into effect displays ingenuity: in other cases it is protected along with the second. The fourth stage must be presumed to be possible, but it

is never patentable. The invention is a rule, ideal and permanent, while the material substratum in or with which the rule is manifested can be removed without the existence of the invention coming into question, so long as there is a possibility of reproducing it. Moreover, the patent when granted confers no right of property in the actual materials used, but only in respect of the art which is applied to the same in the working or making of the new manufacture.

UTILITY.

Though the Statute of Monopolies contains no express stipulation that the subject of a patent must be useful, the condition of utility is undoubtedly implied in section 6; moreover, from early times the Courts have taken notice of the requirement, authority for which can be found in many decisions of the House of Lords.

Utility, in patent law, does not mean either abstract or competitive utility. It may be defined as implying an invention better than the preceding knowledge of the trade as to a particular object. In this definition the word 'better' should be understood as meaning better in some respects, and not necessarily better in every respect: so that, for instance, an article which is good, though not so good as that previously known, but which can be produced more cheaply by another process, is better in that it is better in point of cost, although not so good in point of quality. Again, another test of utility may be taken, namely, that an invention is useful for the purposes of the patent law when the public are thereby enabled to do something which they could not do before, or to do, in a more advantageous manner, something which they could do before, or to express it in another way, that an invention is useful which offers the public a useful choice.

The element of commercial pecuniary success has no relation to the question of utility in patent law generally,

but where the question is of improvement by reason of cheaper production, such a consideration is of the very essence of the patent itself, and the thing claimed has not really been invented unless that condition is fulfilled.

The utility of certain inventions may be measured by their capacity to please or to amuse. For instance, protection is not denied to articles the use of which is merely ornamental, or to such trifles as children's toys, provided they possess the other qualifications of patentable manufactures. Again, it is sufficient that the invention meets a legitimate demand even though disapproved of by a particular section of the public, *e.g.*, an invention relating to the treatment of fermented liquors.

The test of utility is always applied to the invention described in the specification. 'Useful for what?' is a question which must always be asked, and the answer must be: 'Useful for the objects indicated by the patentee.'

It will thus be noticed that the question of utility involves two distinct issues, *viz.*, whether or not by following the directions given in the specification the results which the patentee professes to produce can in fact be produced, and whether or not these results are worth producing.

Thus, if a patentee claims protection for a process for producing a result, and that result cannot be produced by the process, the consideration fails and the grant is void. Similarly, if the patentee claims a process for producing two results, and only one of these results is in fact produced by the process, there is a partial failure of consideration, just as there is in the case of a patent containing one valid and one invalid claim: and such failure of consideration is sufficient to avoid the patent. Want of utility in this sense must, however, be distinguished from want of utility in the sense of the result itself being useless for any purpose whatever. In such a case the patent is void as mischievous to the State and generally inconvenient within the meaning of the Statute of Monopolies. There may be cases, however, in which the essential utility of the invention remains intact although

the result is not strictly in accordance with the specification, or in which the result which the patentee claims to produce can in fact be produced, but the patentee has gone on to detail the purposes to which the result can be applied when in fact the result produced cannot be usefully applied to one or more of such purposes. In such a case the patent is not necessarily void, provided there are purposes for which the result is useful, unless, indeed, the specification contains a misrepresentation so material that it can be said the Crown has been deceived.

To establish utility it is not necessary that the invention be actually reduced to practice and tested: it is sufficient if there is evidence that the invention, if practised, would be useful or that it is in fact capable of commercial existence as a manufacture.

Utility is to be judged by reference to the state of things at the date of the patent. If the invention was then useful, it is immaterial that owing to circumstances prevailing at a later day the public will not make use of it, though, if they do use it, no better proof of utility can be had.

An invention may be useful as indicating the direction in which further progress is to be expected, and yet may be useless for any other purpose, useless, that is, without further developments and improvements which have not at the time occurred to the patentee. A patent for that invention cannot be sustained. If, however, an invention performs a good function, though imperfectly, it is no objection that the invention is susceptible of improvements which will make it operate much better.

The law does not call for any definite degree of usefulness: it is sufficient if the invention is of any use. Utility may be negatived, however, when the function performed by the patented part of a manufacture though good in itself is injurious to the manufacture as a whole.

Useless inventions are hardly likely to attract infringers or lead to litigation. While it is open to a defendant to

raise any and every plea which the law allows, it scarcely lies in his mouth to allege non-utility in that which he has himself thought it worth while to use. In only a small proportion of cases is the objection of absence of utility successfully taken, while the patents that fail on this ground are usually found also to lack at least one of the other essentials to validity.

PRIOR USER.

The main grievance which the Parliament of King James sought to redress was the hardship imposed upon tradesmen who were, by Royal letters patent, denied the right to continue what they had already been lawfully doing. Accordingly, it was made a statutory requisite to the validity of every grant that the manufacture should be one 'which others shall not use.'

The issue of prior user is not to be confused with that of prior publication. The effect of user very often is to communicate the invention to the public, but there may well be a clear case of user without publication of an article, not only by the inventor, but also by members of the public ignorant how that article is made. For instance, if a manufacturer, having a process for making dyes, keeps the process secret and continues to manufacture and publicly sell dyes made according to the process, the sale of dyes may not amount to publication of the process, but yet the process is being used in such a way as to preclude any person who subsequently and independently invents the same process from obtaining for it valid letters patent.

On the other hand, such user must be beneficial user and not merely experimental. The law on this point is summed up clearly in the following judgment :

"A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; if he makes these experiments and never communicates them to the world, and lays them by as forgotten

things, another person, who has made the same experiments, or has gone a little further, may take out a patent, and it will be no answer to him to say that another person before him made the same experiments, and, therefore, that he was not the first discoverer of it."

The objection of prior user, like that of prior publication, relies on events which preceded the record date claimed as the date of protection of the invention under consideration. It is established only on clear proof that the alleged events did, in fact, take place. The objection, if well founded, is not removed by the discontinuance of such user, nor is its force lessened though the user was of the most limited extent. On the contrary, a single instance of prior user will suffice, even though the circumstances are well nigh forgotten. It is well settled, however, that evidence of prior user, when the thing alleged to have been used is not produced, is of little weight, after a long interval, as to its identity with the subject of a later patent.

An invention abandoned is *prima facie* presumed not to have been completed, but to have rested in experiment and trial: but if it was completed and successfully used, and satisfactory evidence to that effect is forthcoming, it does not signify whether it was completely abandoned or whether the user continued down to the date of the patent.

An anomalous case is that in which the patentee has himself used the invention before applying for a patent.

The law is, as stated by *Buckley L.J.* in the matter of *Poulton's* patent (XXIII. R.P.C., p. 191), "that a patentee is not precluded from setting up a patent taken out after he has made certain use of his invention, if that user was made with a view to ascertaining whether it was desirable to patent the thing or not—user, perhaps, in secret; or user, perhaps, which from the circumstances of the case could not be otherwise than in public, because the user could not possibly be conducted in private."

On the other hand, user not experimental, but for the purpose of making profit is fatal. Whether user is to be

held as experimental or as user for profit depends on the circumstances of the particular case. The question is not finally answered by proof that the inventor derived a profit from his experiments. It is right to expect, however, that the person who puts forward his user as having been experimental will bring forward some evidence to induce a judge to come to the conclusion that he had experiment in his mind when he was doing it. In this connection also a clear distinction is to be made between an experiment to test whether a particular machine is in order and an experiment to find whether the invention is a useful one and can be worked satisfactorily.

It has been held to be no objection that the patentee had, with the aid of workmen in his confidence, constructed a number of the articles subsequently patented which, however, were neither sold nor offered for sale in this country until after the date of the patent: on the other hand, the prior user is complete and incontestable if, before the date of the application, the patentee has sent out travellers with samples, however crude, with a view to taking orders in respect of the invented article, and that whether there has been any delivery or not.

It is not necessary that the thing used before the date of the patent should be identical with that specified in the patent. The question is—is it substantially what is claimed? On the other hand, prior user of what might, if made after the date of the patent, have been held to be a clumsy and worthless infringement will not suffice to invalidate a patent for an admittedly successful and valuable invention.

PRIOR GRANT.

It is true of industrial property as also of other property, that the law will not permit what rightly belongs to one person to-day to be usurped to-morrow by another. The possession of an exclusive privilege is a bar, therefore, to

the subsequent acquisition of a monopoly for the same invention which is not based on a superior or at least an equal right. Again, the public interest demands a time limit for the continuance of the monopoly in a manufacture; even if this were not so, such a limit has been imposed by statute.

Accordingly, in the case where separate patents are granted in this country claiming the same invention, as may occasionally happen in the absence of opposition, that of later date will be invalid, even although there is no anticipating publication or user. As it is usually put, the Crown has exhausted its powers with the first grant.

This objection to the later patent does not raise the issue of 'true and first inventor,' and avails even if both patents are owned by the same person.

On the other hand, an abandoned application is no bar to an application made at any subsequent date, provided, of course, that it was not open to inspection, so as to constitute a prior publication.

The plea of prior grant avails only in the case of substantial identity of the matters claimed or when the claim of a later patent is so extensive as to include the invention claimed in one of earlier date. In support of an objection on this ground equivalence of parts may be relied upon, but it is not sufficient that a claim of an earlier patent is broad enough to include an invention not foreshadowed by the senior patentee and claimed specifically in a later patent. The later patent may, however, be dependent on the first: that is, during the term of the earlier patent, the second invention can only be used with the licence of the senior patentee. Similarly, the senior patentee can only use the subsequent improvement with the licence of the junior patentee. There is no prior grant, however, when the invention claimed in the second patent is merely described, but not claimed, in the earlier specification, although the first specification may, if previously published, be effective as a publication.

Prior grant may sometimes be made out by putting

together claims taken from a number of prior specifications, but it requires a clear case to establish the objection in such circumstances.

Although the question has not yet come before the House of Lords, it has been held by the Courts below that a prior patent proved to be invalid is not a legitimate bar to the maintenance of a later patent. It may be noticed, however, that, in opposition proceedings on the ground that the invention has been previously patented, the validity of the prior patent relied on cannot be questioned.

In the very infrequent case of concurrent applications of the same priority the practice is to grant a separate patent on each application. There is, indeed, nothing in the patent law of this country to support the contention that the application first received at the Patent Office has, *ceteris paribus*, legal preference over one received at a later hour on the same day. Moreover, in view of the many rulings as to the legal meaning of the term 'first inventor,' the date of conception of the invention by either party is an immaterial consideration. Again, the question of publication does not arise: if it did, the same publication would destroy both grants. In the absence of any decision on this point, it is submitted, on the analogy of the practice in trade-mark cases, that each patentee has the same right to use the invention as the other, and that his customers or licensees are safe from attack, but that infringers having no authority from any one of the patentees could be sued by any of them. To hold otherwise would produce a state of affairs which among the patentees would be impossible, and as to the public intolerable.

CONTRARY TO LAW.

Whether the grant of a patent be looked upon as the reward of merit or as the consideration in exchange for benefits enjoyed by the public, in neither case is it possible to recognise the deserts of a case in which for merit is substituted perversity, and for public benefit public injury.

In token of this, the Act confers jurisdiction on the Comptroller to refuse, without right of appeal, to grant patents for inventions of which the use is, in his opinion, contrary to law or morality. Indeed, even if such an application escaped the Comptroller's scrutiny, the law would not support the monopoly since it admits no right of user either by the patentee or by others.

Protection is therefore denied to inventions of which the sole use or intended use is forbidden by the law of this country. For instance, a patent cannot be granted for a lottery. On the other hand, no objection lies against inventions of which only the misuse is contrary to law, *e.g.*, improvements in fire-arms. Similarly, there can be no right to protection of an invention the use of which is opposed to the accepted principles of morality of the day, and is condemned by general public opinion.

The censorship of the Comptroller is limited to questions touching the subject of the alleged invention, irrespective of the status of the patentee. Thus, it is not an objection of which notice will be taken by the Comptroller, or for that matter by the Court, that the patent is taken out to enable the applicant to evade the provisions of an Act of Parliament, *e.g.*, the Pharmacy Act.

As already mentioned, the Statute of Monopolies makes an exception of grants 'mischievous to the State or generally inconvenient.' The weight of an objection relying strictly on this ground necessarily depends upon the ideas of general convenience and political economy prevalent at the time. It would certainly be impossible nowadays to upset a patent on the sole ground that the invention effects a saving in labour, and thus incidentally injures a number of individuals while benefiting the State at large.

As will be noticed below, a patentee may by his own action render his patent open to attack on grounds closely connected with the general objection 'mischievous to the State or generally inconvenient'; for instance, when he works the patented invention mainly or exclusively abroad,

or inserts inequitable conditions in contracts with reference to the use of his invention. The Comptroller and the Court will not of their own initiative condemn a patent on any such ground, but will only do so when such an objection to validity is raised by other interested parties in any legal proceedings relating to the patent in question.

ONE INVENTION.

The Act provides that ' Every patent . . . shall be granted for one invention only, but the specification may contain more than one claim : and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.'

Where an applicant has included in his specification more than one invention, the Comptroller may require or allow him to amend the application and specification and drawings or any of them so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by the amendment.

The statutory requirement does not imply that the inventor acquires no more than a single right in virtue of his patent, but rather that, although he acquires several rights, they must be derived from a common source. Thus, an applicant may protect in the same patent a new process, the product, and apparatus for performing the process. Again, an invention need not coincide with the first materialised form, but may be embodied in various forms that are modifications one of the other : for instance, in alternative processes of producing the same new product, or applications of the same new process to analogous materials, in alternative processes or apparatus performing the same function or designed to operate the same new process, or in equivalent compositions of which either the ingredients themselves or the proportions of the ingredients may be varied. Equally cognate are improvements in an existing manufacture which mutually

contribute to produce a single result. Interdependence of subject matter may also exist between an original invention and improvements therein or additions thereto, or between a complete invention and the novel parts thereof: for example, between a new process, a new sub-process and a new intermediate product, or between a new combination and a new part or subordinate integer of the combination.

The requirement of unity of invention rests on practical considerations—the simplification of the examination proceedings, the classification of inventions, and the pecuniary burden chargeable on every monopoly. In each case, therefore, it is to be ascertained whether, in view of these considerations, it is practicable to permit the rights acquired by an inventor to be embraced in a single patent.

The answer which will be given by the Patent Office examiner to the question whether any particular matters constitute one invention depends upon the location which such matters occupy in the arts. To satisfy the examiner the specification must contain a claim for at least 'an invention.' If there is excess, the question arises 'is this excess a distinct substantive invention, or is there such interdependence between the matters claimed that the excess does not amount to a distinct substantive invention?'

Such interdependence is absent when the objects served by the matters claimed are entirely distinct.

It was suggested in *Jones' Patent* (Griff, P.C. 265) that the question of one invention is to be decided by the general object of the invention. In that case the late *Lord Herschell* intimated that he would allow alternative devices for producing a particular object as one invention, and added:

"You may get in one patent the combination and all subordinate parts of that combination so far as you claim to use them for one main purpose, but if you are going to use a subordinate part or one of the elements of a combination for a purpose independent of the purpose of the combination, then you have got an extra invention."

The substance of this decision is contained in a direction of the Law Officers to the Patent Office :— ‘ There can only be one subject matter included in a patent, but such subject matter may be composed of many parts. If, therefore, an applicant claims a patent for a particular invention, he can proceed to show that such invention is composed of several novelties : still his claim would be for one invention only. But if, in describing his invention and the separate parts, he should claim to apply such parts not only to the invention for which he claims but to other and different purposes, such parts ought not to be protected by one patent.’

It is also a rule that ‘ when a specification comprises several distinct matters, they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus or process.’

In practice the Comptroller does not accept as conclusive the mere argument of ‘ one general object ’ as justifying claims for alternative forms, and only permits claims for alternative solutions of the same problem to be included in one specification when the problem is recognised and solved for the first time. Co-operating elements of a new combination may be claimed separately in one specification, but interdependence is not generally recognised between two arrangements either of which can be used not only with the other, but also with any known equivalent. A complete machine and a subordinate integer, or a complete process and a sub-process cannot be claimed separately in the same specification when the subordinate integer or sub-process is unnecessary to the carrying out of the invention as a whole, and in itself has a character independent of that of the complete machine or process.

Two approximate tests may be submitted by which to answer the question whether any given matters constitute one patentable invention. *Prima facie*, things which would not ordinarily be made by the same manufacturer cannot be claimed independently in the same specification. *Prima*

facie, claims for separate matters can be allowed in one specification if so correlated that the infringement of one claim necessarily involves infringement of one of the other claims.

It is seldom that division is required of a provisional specification on the ground that it contains more than one invention. In case of doubt the decision is usually deferred until the complete specification with claims is filed.

When several matters which might be claimed in one patent are invented at different dates, they may, if desired, be covered in a number of provisional specifications which are followed by a single complete specification: improvements or modifications of the invention not included in the complete specification may be protected by independent patents or by patents of addition.

THE APPLICATION.

To the owner of an invention desirous of turning it to account there are two courses open. He may seek to exploit the invention as a secret manufacture, in which event he incurs the risk of betrayal and is without remedy against imitation. For the secret itself there is no market since no one would buy it in ignorance of what he was buying, while no one would pay for what he already knew. Alternatively, the owner may disclose the invention to the Crown and obtain an exclusive privilege which he can either work as a monopoly for a definite term or transfer to others for a valuable consideration.

This privilege is not granted as a matter of right, but by the exercise of the royal prerogative: in a proper case, however, it is never refused.

While the interest of the Crown in the grant of a patent is by no means theoretical only, in effect the applicant has not to deal with the Crown directly, but addresses his application to the Comptroller-General of the Patent Office. With the exception of the signing of certain documents specified in the Rules all communications to and attendance upon the Comptroller may be made by or through an authorised agent. In practice the great majority of applicants are represented by patent agents, for the reason that professional skill and experience are simply indispensable in the preparation of the various documents and the conduct of oral discussions that form part of the proceedings leading to the grant of a valid patent. The lesson has been taught again and again, and times without number Courts have

refused to uphold patents on account of defects in the specifications which a skilful agent would readily have avoided, but which, owing to initial neglect, have led to the irretrievable loss of valuable rights.

The Patent Office is not intended to give legal advice or opinions on any subject connected with patent law, or to examine specifications or other documents before they are filed.

The application is duly made by leaving at the Patent Office a prescribed form bearing a stamp of £1 (except in the case of a secret patent) and containing, *inter alia*, a declaration by the applicant that he is in possession of an invention and a prayer for the grant of a patent.

In order to define the subject matter in respect of which the application is made, there must be deposited with the application an instrument in writing, termed the specification, which, according to the stage of development of the invention, may be either a general outline or a detailed description of the invention, that is, either a provisional or a complete specification.

Whether or not it will be advisable to file a provisional or a complete specification in the first instance will depend on circumstances.

By filing a complete specification at once the applicant is sooner informed of the result of the official search, and, if the invention proves to be anticipated, he can abandon the matter without wasting further time or labour. An additional advantage is that the issue of the patent is accelerated and infringement can be arrested in its beginnings. On the other hand, the initial outlay is less for a provisional specification, while a breathing space of six months (or, with an extension, seven months) is allowed for developing the original invention and working out improvements, which may be included in the complete specification.

It should be observed that in either case the application is an application for a patent and that provisional protection is conferred by the acceptance of the application whether it was accompanied by a provisional or a complete specification. The meaning and effect of provisional protection are explained in a subsequent chapter.

It will generally be advantageous for clients to submit their inventions to us personally and we shall then be pleased to advise them whether, in our opinion, they would be justified in making an application and, if so, what course should best be adopted in the circumstances. An interview is not necessary, however, since the requisite information can generally be given in a written description which may, when the case permits, be supplemented by a drawing or a sketch. We shall be pleased in any case to forward draft forms with directions as to the nature and extent of the particulars required.

We give our personal attention and care to the drafting of the official specifications, and can point with satisfaction to patents obtained through our agency which have successfully withstood the scrutiny of the highest tribunals in the country.

The date of the application is of the utmost importance both as regards the past and the future. Questions of anticipation and infringement equally hinge around the point of time from which the priority of the patentee's claim is to be reckoned. It is our practice, therefore, to give prompt attention to each case and to use the same despatch in preparing the papers for filing and in conducting the prosecution of the application until the issue of the patent.

THE PROVISIONAL SPECIFICATION.

At the head of the provisional specification stands the title of the invention, which is followed by a lucid description of the nature of the invention.

The title should cover the whole subject matter, and should not be the name under which the invention is to be sold.

The following forms are not allowable:—(a) Fancy names or titles, *e.g.*, 'The Simplex Wheel'; 'The Hercules Braces.' (b) The use of the inventor's name or of the word 'patent.' (c) The abbreviation '*etc.*'

The description of the nature of the invention must be fair and accurate; there is no necessity, however, to enter into minute details as to the manner in which the invention is to be carried into effect. If the written description enables the invention to be identified without the aid of drawings, these will not generally be required at this stage.

Claims should not be appended to the provisional specification. Their proper place is at the end of the complete specification; on the other hand, the priority of the filing date of the provisional specification can only be awarded to claims for matters which in their essence are described therein. A proper provisional specification will, therefore, be capable of being read as fairly foreshadowing the invention subsequently claimed, without, however, tying the applicant's hands to details, by adopting language which would exclude an area that might otherwise be within more general phraseology.

Of many popular fallacies regarding patents, the most disastrous to patentees is that the provisional specification is simply an incomplete specification. As a matter of fact, it is neither more nor less than a legal document open to every form of criticism that those skilled in law can suggest. Being printed in front of the complete specification it is the first to attract a reader's attention, and, as it is the more elementary of the two, its defects are more readily perceived.

It is to be noticed also that after acceptance a provisional specification can only be amended by permission of the Comptroller, such amendment being practically limited to excision: after the document is printed, the only alteration permissible is the correction of clerical errors.

SUPPLEMENTARY PROVISIONAL SPECIFICATIONS.

One invention often leads to another, and it is a matter of every-day experience that after filing a provisional specification an applicant develops further improvements or discovers alternative modes of attaining the end in view. In certain cases the developments and variations are such as might ordinarily be covered in a single application, and it is hardly reasonable to impose on the applicant, who wishes to protect all that he is willing to disclose, the obligation of taking separate patents or of abandoning the priority to which he is entitled for his improvements.

The Act of 1907 provides accordingly that where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has thereby obtained concurrent provisional protection for the same, and the Comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon. In this case the patent will bear the date of the earliest of such applications, but in considering the validity of the grant and for the purpose of opposition proceedings, the Court or the Comptroller, as the case may be, will have regard to the respective dates of the provisional specifications relating to the several matters claimed by the patentee.

THE COMPLETE SPECIFICATION.

The complete specification may, as above mentioned, be filed with the application or at any time within six months, or, with an extension, within seven months, from the date of the application: if the complete specification is not filed within that time the application is deemed to be abandoned. Likewise, when it is sought to include in one complete

specification the subject matter of a number of provisional specifications, the period of six or seven months is to be reckoned from the date of the first application.

The complete specification must be on a prescribed form bearing an impressed stamp of £3 (except in the case of an application for a secret patent). Like the provisional specification, it must commence with the title. It must also 'particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.'

The two last named conditions, although often confused and overlapping, are really distinct, and it is always necessary to keep both clearly in mind and not to commit the mistake of supposing that compliance with one is necessarily compliance with the other. No grant can be validly made unless both conditions are complied with.

The first condition imposes upon the patentee the necessity of stating in clear and intelligible language what his invention really is, so that others may know what addition the patentee has made to what was known before, so that they may know what they are not at liberty to do without his consent during the existence of the patent; in other words, so that they may know what the monopoly is that is granted to the patentee. The nature of the invention must be stated both in the provisional and in the complete specification; but whilst it is sufficient in the provisional specification to state the nature of the invention in general terms, it is necessary in the complete specification to particularly describe and ascertain it.

The second condition imposes upon the patentee the necessity of stating in clear and intelligible language in what manner the invention is to be performed; so that others may learn from the specification how practically to avail themselves of the patented invention when the patent has expired; how they are to do what is necessary to carry out the new invention, the nature of which has been previously described. This condition applies to the complete

specification only; there is no necessity to state in the provisional specification how the invention is to be performed.

With reference to the degree of clearness and distinctness of the language necessary to be used in order to comply with those conditions, it is obvious that no hard and fast rule can be laid down; the degree of clearness can only be stated in language which itself admits of considerable latitude in its application. On the one hand, the patentee must make the nature of his invention, and how to perform it, clear and intelligible; on the other hand, it is not necessary for him to instruct persons wholly ignorant of the subject-matter to which his invention relates in all that they must know before they can understand what he is talking about. The patentee is adding something to what was known before, and he does all that is necessary as regards the language he uses, if he makes the nature of his invention, and how to perform it, clear and intelligible to persons having a reasonably competent knowledge of what was known before on the subject to which his patent relates, and having reasonably competent skill in the practical mode of doing what was then known. In complying with the first condition, *i.e.*, in describing the nature of his invention, the patentee does all that is necessary if he makes the nature of his invention plain to persons having a reasonably competent knowledge of the subject, although from want of skill they could not themselves practically carry out the invention. In complying with the second condition, *i.e.*, in describing in what manner the invention is to be performed, the patentee does all that is necessary if he makes it plain to persons having reasonable skill in doing such things as have to be done in order to work the patent, what they are to do in order to perform his invention. If, as may happen, they are to do something the like of which has never been done before, he must tell them how to do it, if a reasonably competent workman would not himself see how to do it on reading the specification, or on having it read to him. The principle to be applied to the language used to comply with the two

conditions is the same for both; but one class of persons may understand only one part of the specification and another class only the other, and yet the patent may be valid.

It has been held, accordingly, that a patentee is not bound to introduce into his specification knowledge which is elementary to, or is already known by, those who are conversant with the subject-matter with which he is dealing. He must disclose everything which it is necessary to add to the previously existing knowledge of the world to enable the public to carry his invention into effect, but in this sense the existing knowledge of the world does not mean the knowledge of those who have never studied the subject, but the knowledge of those who have done so and are conversant with the existing knowledge with reference to that subject-matter.

When, in describing his invention, the applicant also describes known arrangements care must be taken to distinguish what is new from what is old. Accordingly, the patentee of an improvement upon a manufacture must condescend upon what he has improved; in other words, the specification must assign the *differentia* of the invention. Where, however, the patent is for a mere combination of parts, the combination is, *ex necessitate*, the novelty, and the novelty or antiquity of the parts is an immaterial consideration, unless, indeed, it is left open in the specification for the patentee to claim not merely the combination of all the parts as a whole, but also certain subordinate parts of the combination. In the latter case it may still be necessary to see that he has carefully distinguished these subordinate parts and has not left it in doubt what claim to parts in addition to the claim for the combination he means to assert.

In distinguishing the new from the old, the applicant need not name the documents from which information as to the prior art may be obtained. On the other hand, the applicant should not assume that all pre-existing knowledge of a particular subject is known to readers of the specification.

It will not do to leave to them the task of sifting new from old matter. In fact, a complicated subtraction sum is not to be set to the public, but the applicant himself is obliged to perform that task and place the result in his specification.

While the applicant may point out the defects of previous inventions in the same line, unfounded derogatory remarks regarding the work of other inventors are not only objectionable in themselves, but also invite opposition.

The applicant need not state the effect or the advantage of his invention if he describes his invention so as to produce it. This is not true, however, where he has to rely on the presence or absence of such effect or advantage as a part of the necessary delimitation. The fact that it is a mere consequence cannot be pleaded by him as an excuse for not putting it in, if the omission leaves his invention inadequately defined. On the other hand, the specification is not a medium for advertisement.

Where there are several ways of carrying the invention into effect, it is not necessary that the applicant should specify every way; but he must specify the best way to his knowledge, so that a reasonably well-informed artisan can work out the invention from the directions given without the necessity for experiment or further invention.

The patentee must not merely set a problem, and perhaps even render it not very difficult to solve, but must condescend to practical details, so that, at the expiration of the patent, the rest of the world may be able, without further experiment, to make the patented article. If the patentee does not fulfil this condition, he cannot complain that others should travel by the same road up to the door which he did not unlock, and, having found the key themselves, should unlock the door, go in and shut him out.

There is sometimes a difficulty in distinguishing between an amount of practice, without which failure is probable, but the necessity for which does not destroy a patent, and an amount of experiment and invention, without which failure is certain, and the necessity for which destroys a

patent. The test by which to decide such a question is to be found by asking whether anything new has to be found out by a person of reasonably competent skill, in order to succeed, if he follows the directions contained in the specification. If yes, the patent is bad; if no, it is good so far as this point is concerned.

It is, therefore, incumbent upon the applicant to be explicit in the words he uses and to avoid leaving any ambiguity unexplained that would mislead persons working the invention. It is not open to him to use language which, *prima facie*, covers several things so that he can hold his patent in *terrorem* over the world until it is challenged and then say: 'Oh, I meant only one of these things.'

On the other hand, the language of a specification is often necessarily scientific. This in itself is no drawback so long as the description is also accurate and intelligible to those who will be called upon to practise the invention. For instance, when an astronomer reports that a comet is to be seen with the telescope, in the constellation of Auriga, in so many degrees of declination, and so many hours and minutes of right ascension, it is all Greek to the unskilled in science; but other astronomers will instantly direct their telescopes to the very point in the heavens where the stranger has made his entrance into our system. They understand the language of their brother scientist.

A patentee need not explain in his description, or know in point of fact, what laws of nature those are which cause his invention to work. Even if the applicant has mis-conceived and mistaken his theory the grant may be supported, provided the manufacture *qua* manufacture is correctly presented. Nor is a description necessarily insufficient in the eye of the law on account of any mere errors it may be found to contain, where these errors would at once be detected, and their remedies be known, by any person skilled in the art when practising the invention. The same remarks apply to omissions from the description when the parts omitted would be at once supplied by a competent workman.

On the other hand, the law requires the utmost good faith from the applicant, and false suggestion or deliberate concealment of any kind equally imperils the entire grant.

When the applicant is the communicatee of an invention, his good faith cannot be questioned, if the specification discloses the best manner of performing the invention as known to him. The applicant is not relieved, however, from the necessity of filing a sufficient description of the invention, such as he claims it.

It must be noticed that the requirement to file a proper specification is statutory and that no plea *ad misericordiam* can be set up by the patentee whose right is afterwards contested, if that right was obtained in despite of the conditions imposed by law. In the case of a contract, the Court is bound to find the meaning of a document before it, but in the case of a specification the Court must be satisfied that the patentee has fulfilled the conditions upon which his monopoly is granted; it is not for the Court to read matter into a specification which the patentee has omitted to set down or which is not obviously implied.

If the invention is capable of illustration, the complete specification should be accompanied by drawings, unless these were left with the provisional specification. Drawings must be made in accordance with the Rules, and should be on a scale to show the invention clearly, representing only so much of the apparatus, machine or the like as effects this purpose.

To be as useful as possible, drawings for letters patent ought to show the true positions and proportions of the parts of the inventions which they purport to delineate; but it is not necessary that they be accurate enough to be used as working drawings, from which to construct specimens of those inventions.

A drawing properly prepared may be made to answer, to a large extent, the purposes of a written description. Indeed it is impossible not to recognise that there are difficulties in the use of human language which become aggravated

in dealing with complex structures and machinery: and, unless the applicant were allowed to eke out his description by giving a drawing of what it is he does, in some cases it would be almost hopeless to expect that anyone could, with sufficient precision, mark out the boundaries for that which was intended to be claimed as the subject of the invention.

To a workman of ordinary skill a drawing is at least as instructive as any letterpress description can be. The drawing must needs be supported by a positive statement pointing out what is the invention and how it is to be realised by following the drawing, but if the drawing and the written statement taken together do make the invention clear it would be mere pedantry to say that the specification is not framed in accordance with the statute.

A model of a machine or article of manufacture is not required, and, even if used for the purpose of explaining the invention to the examiner, forms no part of the specification.

Where, however, the invention in respect of which an application is made is a chemical invention, typical samples and specimens must, if in any particular case the Comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification. The applicant who furnishes such samples is not thereby released from the obligation to supply a proper specification. It is, in fact, simply to prevent the grant of patents for fictitious inventions taken out with the sole object of blocking *bona-fide* discovery that the deposit of samples is required. The written document is independent of these, and stands or falls on its own merits.

The Act further prescribes that the complete specification is to end with a distinct statement of the invention claimed.

According to the Rules this statement must be clear and succinct as well as separate and distinct from the body of the specification. The specification may contain more than one claim, but multiplicity of claims and prolixity of language are to be avoided.

The claims should include neither more nor less than

what is sought to be protected. As patents are procured *ex parte*, the public is not bound by them, but the patentees are; and the latter cannot show that their inventions are broader than the terms of their claims, or, if broader, they must be held to have surrendered the surplus to the public. On the other hand, a claim will not be narrowly read for the sake of saving the validity of the patent when the narrower construction is inconsistent with the obvious intention of the patentee as expressed by the language used.

In the case where the description sets forth a manufacture having a number of parts the applicant may lawfully make a claim co-extensive with the description, if the manufacture as a whole is novel; but such a claim ought seldom to be the only one in a patent, because in most cases it can readily be evaded. The proper practice is to fix on the essential elements which the described manufacture contains, and to claim these separately or in the broadest combinations consistent with the requirements of novelty, invention, *etc.*

The claim should mean just what it seems to mean; but it may properly include comprehensive terms and phrases to cover equivalents, if these distinctly express the invention and are warranted by the specification.

It is obvious that in the case of a combination claim the greater the number of elements which must be included the narrower is the claim and the easier it is to escape infringement. A patentee often makes a narrow claim in order to render his patent safe, when a broader claim might have left it open to cavil and question. Very often he does not foresee the effect of limitations imposed by the language he employs. That is one of the risks the patentee runs. On the other hand, any claim which is broader than the described invention is void, even where that invention is valuable and could have supported a valid claim. The difficulty is to hit the medium between those two extremes. This difficulty is not met by drafting the claims in vague phraseology, which may mean anything or nothing, and the presence of which is a standing invitation to litigation.

As will be seen later in the chapter relating to the subject of infringement, a claim will be much more liberally interpreted when the invention protected thereby is in the nature of a new principle of manufacture than when it is simply an improvement in details. If, however, a patentee desires to have his claim read as covering a general principle, it is his duty to make his intention reasonably clear : if he claims simply a combination, and one cannot gather what are the essential parts of the combination, the claim must be construed strictly. The Court will not spell out a patentee's intention to the contrary from the use of ambiguous language.

In many cases it will be found that inside an invented combination, either claimed or capable of being claimed, there is that which itself is a minor invention, and which does not extend to the whole, but forms only a subordinate part or integer of the combination. If it is intended to claim such minor inventions *per se*, then the patentee must make this clear by claiming them separately. In this case, however, he is at the peril of justifying these subordinate integers as themselves matters which ought properly to form the subject of a patent.

Conversely, where a subordinate integer is specified and claimed, and a larger combination, of which this integer is part, is also claimed, the patentee is at the peril of justifying the combination as matter which ought properly to form the subject of a patent, and he does not discharge this burden where there is no novelty or invention in the larger combination, the combination being obvious given the existence of the subordinate integer.

Without neglecting the rule of construction that claims are to be read along with the specification, each substantive claim may be regarded as itself a patent in miniature, having all the incidents of, and being judged by the same rules, as a patent. If, therefore, the subject of any substantive claim is not properly specified or fails to withstand the tests of novelty, invention, utility, *etc.*, that claim is invalid, and with it fails the entire grant.

From its nature the complete specification may be expected to contain further information than that given in the provisional specification. Indeed, if additional particulars to those contained in the provisional specification are necessary for carrying out the invention, the applicant not only may but must disclose them in the complete specification.

On the other hand, any matter described in the provisional specification but not included either explicitly or implicitly in the complete specification is presumed to be abandoned.

The effect of variation between the two specifications is further discussed in the following chapter.

DISCONFORMITY.

It is seldom that an invention is in a perfected state at the first stage of its conception. Study and practical experience suggest alterations and improvements. The applicant who files a provisional specification to-day may find six months hence that what he desires to claim is very different from what he originally described. Indeed, the justification of the provisional specification is that it allows the applicant latitude for developing his original ideas, and, within the limitations of the language used in his provisional specification, including the developments in the particular description of the complete specification. On the other hand, it was never intended that a person who applied for a patent for one invention on a certain date should be able subsequently to make a claim under that application for an invention quite distinct from the first.

There is often difficulty in determining what is a proper development of an invention described in a provisional specification and what is a departure that no longer conforms with the original invention. The difficulty is linguistic as well as technical, and has been a fruitful source of litigation in the past. Between the dates of the Act of 1852 and the Act of 1907 disconformity between the pro-

visional and complete specifications was a fatal objection to the validity of a patent, whether the entire subject matter of the claim was new at the date of filing the complete specification or not, and whether the patentee was the inventor of the whole or not. Under the Act of 1907, however, a patent will not be held invalid on the ground that the complete specification claims a further or different invention than that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the true and first inventor thereof.

The Act of 1907 does not altogether dispose of the question of disconformity. On the contrary, the official comparison of the provisional and complete specifications is made with the object of preventing an applicant from exceeding the rights secured by the provisional specification or specifications; opposition on the fourth ground is substantially an allegation of disconformity; and it is due to disconformity if, after the grant of the patent, priority of the date of the application is not given to all the matter claimed in the complete specification.

Variance such as to constitute disconformity may be in the nature of addition of features distinct from those specified in the provisional, substitution of features not equivalent to those for which they were substituted, or omission of essential features, the effect of which is to make the remainder different from any invention described in the provisional specification.

In every case, in arriving at a conclusion as to whether disconformity exists between a complete specification and a provisional specification, two main points have to be considered, *viz.*, (1) What is the nature of the invention described in the provisional specification? and (2) is what is claimed in the complete specification an invention of different nature from the former? If the answer to the second question is in the affirmative, there is disconformity, and the applicant must take the consequences.

The best safeguard against disconformity is a well drawn provisional specification. If the provisional specification is defective, it requires great care in framing the complete specification and claims to protect what is really valuable without losing the priority which may mean the difference between validity and invalidity.

PROCEDURE ON RECEIPT OF THE APPLICATION.

On deposit of an application for a patent an official receipt is issued on which is stamped the number of the application. An entry is made in the official application book under the name of the applicant and the title, and a notice is published in the *Official Journal*.

The papers are then referred to a clerical staff, any informalities found being noted for the purpose of the examiner's report issued subsequently.

The application is next allotted to one of the statutory examiners according to the class to which the invention relates.

Both in the case when the application is accompanied by a provisional specification and when it is accompanied by a complete specification the examiner has to ascertain and report whether the nature of the invention is fairly described, whether the title sufficiently indicates the subject matter of the invention, and whether the specification comprises one invention only. If the examiner is of opinion that amendment of the documents is required, he transmits the papers to the correspondence department of the Patent Office, where an official letter is written and forwarded to the applicant or his agent.

When the documents are amended by the applicant or his agent, they are again referred to the examiner for investigation and report. In this case the application may be post-dated, so as to bear date as of the time when the requirements are complied with.

If the applicant considers the objections not to be justified, he may submit his views in writing or state them orally at an interview with the examiner, who may then withdraw his objections unconditionally or on the basis of an agreed amendment.

If the applicant and the examiner are unable to arrive at a mutual understanding, the Comptroller may refuse to accept the application failing the compliance with the requirements by the applicant.

The Comptroller cannot exercise his discretionary power adversely to the applicant, however, without giving him an opportunity of being heard. If so required, the Comptroller hears both the applicant and the examiner, and, subject to an appeal by the applicant, his decision is binding on both parties.

When the applicant has included more than one invention in his specification, the Comptroller may require or allow him to amend the application so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by the amendment. The divided application may, if the Comptroller so directs, bear the date of the original application, or such date between the date of the original application and the date of leaving the divided application as the Comptroller directs, and is otherwise proceeded with as a substantive application. Where the Comptroller has required or allowed any application to be so amended, the Comptroller may direct that the application is to bear such date, subsequent to the original date of the application, and not later than the date when the amendment was made, as he considers reasonably necessary to give sufficient time for the subsequent procedure relating to the application.

To receive the priority of the original application, the specification accompanying any divided application must be limited to claim only matter covered by the original specification, and must be provisional or complete, according as the original specification was one or the other.

In the case of an application accompanied by a complete specification a search is also made by the examiner as mentioned below, either at the same time as the investigation regarding the other essentials, or after other objections have been removed.

The examiner does not further consider the patentability of the invention, unless its use is contrary to law or morality, or unless it is of an improper nature, or does not relate to a manner of manufacture.

Reports of examiners are not in any case published or open to public inspection, and are not liable to production or inspection in any legal proceeding, unless the Court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Except in the case of the objection that the use of the invention would be contrary to law or morality, if the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the Law Officer, *i.e.*, the Attorney-General or Solicitor-General for England, who will, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions (if any) the application is to be accepted.

ACCEPTANCE OF THE APPLICATION.

PROVISIONAL PROTECTION.

If the Comptroller (or, in the case of appeal, the Law Officer) is satisfied that no objections exist to the application on any of the grounds indicated, the application is accepted and a certificate of acceptance is delivered to the applicant.

Where an application for a patent in respect of an invention has been accepted, the invention may, during the period between the date of the application and the date of sealing the patent, be used and published without prejudice

to the patent to be thereafter granted. Such protection from the consequences of use and publication is termed 'provisional protection.'

COMPARISON OF PROVISIONAL AND COMPLETE SPECIFICATIONS.

When a complete specification is left after a provisional specification or specifications, the specifications are referred to the examiner for further investigation and report.

If the examiner reports that the complete specification has not been prepared in the prescribed manner, the Comptroller may refuse to accept the complete specification until it has been amended to his satisfaction.

If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that described in the provisional specification or specifications, the Comptroller may either refuse to accept the complete specification until it has been amended to his satisfaction, or (with the consent of the applicant) cancel the provisional specification or specifications and treat the application as having been made on the date at which the complete specification was left, in which case the application will have effect as if made on that date.

Where the complete specification includes an invention not included in any provisional specification, the Comptroller may allow the original application to proceed as far as the invention included in both the provisional and complete specifications is concerned, and treat the claim for the additional invention included in the complete specification as an application for that invention made on the date at which the complete specification was left.

Consideration of the question of unity of invention is frequently deferred until the complete specification is filed. Even if discussed with reference to the provisional specification, the question may be reopened on the investigation of the complete specification.

Where the same applicant has put in two or more provisional specifications for inventions which he believes to be cognate or modifications one of the other, and the Comptroller is of opinion that such inventions are not cognate or modifications one of the other, the applicant may divide the complete specification left in connexion with his application into such number of complete specifications as may be necessary to enable the case to be proceeded with as two or more separate applications for patents for different inventions.

INVESTIGATION OF PREVIOUSLY PUBLISHED SPECIFICATIONS.

When a complete specification has been left, in addition to the other enquiries which he is directed to make, the examiner makes a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification), published before the date of the application, and left pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

If the examiner reports that the nature of the invention is not sufficiently disclosed and defined to enable him to make the investigation, and the Comptroller requires amendment of the specification, the Comptroller may direct that the application is to bear such date subsequent to its original date when the requirement is complied with, as he considers reasonably necessary to give sufficient time for the subsequent procedure relating to the application.

Where, as the result of the investigation, the examiner finds that the invention claimed is wholly or in part claimed or described in any such prior specification, a notice to that effect is sent to the applicant, who may, within two months or such extended term as may be allowed, either

rebut the objections or amend his specification, which is then re-examined.

If the examiner concludes that the invention claimed has been wholly claimed or described in one or more specifications, he makes a provisional report to that effect to the Comptroller. If the provisional report is not reversed or altered, it may be deemed a final report. If, however, the provisional report is reversed or altered, the investigation is continued and a further report made to the Comptroller.

If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed has been wholly or in part claimed or described in a previous specification, then, in the absence of any other lawful ground of objection, he accepts the specification.

When, however, it appears from the investigation that the invention claimed is wholly or partly anticipated, and the applicant has not made a satisfactory amendment within the time allowed, the Comptroller informs the applicant accordingly, and appoints a time for hearing him, giving him at least ten days' notice of the appointment. After hearing the applicant, or without a hearing, if the applicant has not attended a hearing appointed or has notified that he does not desire to be heard, the Comptroller determines whether reference ought to be made in the applicant's specification to any, and, if so, what prior specification or specifications by way of notice to the public.

The Comptroller requires, as a condition of not inserting a reference, that the specification will be a clear statement of what is really the invention, and does not allow an applicant even to appear to claim matter which has been anticipated by previous specifications. This is to the advantage of honest and *bonâ fide* applicants, while tending to discourage the taking out of patents for objects other than the protection of a real invention.

If the Comptroller is satisfied that the invention claimed has been wholly and specifically claimed in any specification

to which the investigation has extended, he may, in lieu of requiring references to be made in the applicant's specification, refuse to grant a patent.

The applicant who seeks to show that his invention is novel, notwithstanding the existence of previous patents, must be able to convince the examiner or the Comptroller, not by general abuse of prior inventions, but by reasoned arguments, supported, if need be, by reference to judicial decisions, that, rightly construed, his claim is clear of the prior specifications quoted. It may happen that amendment is unavoidable, in which case the prior specifications must be carefully looked into and the claims revised so as to cover the invention, the whole invention, and nothing but the invention.

From any decision of the Comptroller refusing to accept the complete specification or directing a reference to be made to previously published specifications, or requiring an amendment on any ground mentioned in this and the preceding chapter an appeal lies to the Law Officer.

If the complete specification is not accepted within twelve months from the date of the application, the applicant may obtain an extension of time, not exceeding three months, within which the specification may be accepted. If the complete specification is not accepted within such time, then, save in the case of an appeal having been lodged, the application becomes void.

An applicant may also at any time during the pendency of the application intimate formally to the Comptroller his abandonment of the case.

Where an application for a patent has been abandoned or become void, the specifications and drawings (if any) accompanying or left in connexion with such application will not (save in the case of convention applications which overrun the period of twelve months from the date of the foreign or colonial application) be open to public inspection or be published by the Comptroller.

EXTENDED OFFICIAL INVESTIGATION.

The Act of 1907 provides for an extended investigation in respect of applications filed after a date to be settled by the Board of Trade.

The further investigation will extend to specifications published after the date of the application and deposited pursuant to prior applications: for the purposes of the extended investigation an application is deemed to be prior to another application, if the patent applied for would, when granted, be of prior date to the patent granted pursuant to that other application.

Where, on the extended investigation, it appears that the invention claimed is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant is so informed, and, whether or not his specification has been accepted, or a patent granted to him, must, within two months from the date of the letter so informing him, apply for leave to amend his specification by way of disclaimer, stating specifically what amendments he is prepared to make in it to remove the objection of anticipation, or, if he considers that no amendments are necessary, inform the Comptroller accordingly.

The Comptroller will consider any amendments submitted by the applicant for this purpose, and may allow the necessary amendments to be made.

If, at the expiration of two months, or such further time as the Comptroller may allow, the Comptroller is not satisfied that the invention claimed by the applicant is not wholly or in part claimed in the specification or specifications cited, he will inform the applicant accordingly, and appoint a time for hearing him. After hearing the applicant, or without a hearing, if the applicant has not attended a hearing appointed, or has notified that he does not desire to be heard, the Comptroller will determine whether reference ought to be made in the applicant's specification to

any, and if so, what prior specification or specifications by way of notice to the public.

ACCEPTANCE OF THE COMPLETE SPECIFICATION.

On the acceptance of the complete specification the Comptroller advertises the acceptance; and the application and specifications with the drawings (if any) are open to public inspection. Printed copies of the specifications are published and on sale fifteen days from the date of the advertisement.

After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant has the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification; but he is not entitled to institute any proceeding for infringement until a patent for the invention has been granted to him.

Any person wishing to be informed as soon as a complete specification is accepted may file a caveat form with a request for such information.

It is our practice to publish weekly in a number of newspapers and trade journals a list of the most interesting specifications accepted for the direction of clients who follow the progress of invention in the more important manufactures. To those desiring fuller information we shall be pleased to supply detailed lists or copies of particular specifications.

OPPOSITION TO THE GRANT OF A PATENT.

Until the publication of the complete specification the contents of the application are treated as secret, and the Patent Office receives and sends communications regarding the application only from or to the applicant or his authorised agent. Upon the acceptance of the complete specification, however, an opportunity is afforded to third parties to participate in the proceedings.

At any time within two months from the date of the advertisement of the acceptance of a complete specification any person interested may give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds :

- (1) That the applicant obtained the invention from him, or from a person of whom he is the legal representative; or
- (2) that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last mentioned patent; or
- (3) that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification; or
- (4) that the complete specification describes or claims an invention other than that described in the provisional

specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification,

but on no other ground.

Opposition may be made by a number of persons, either separately or jointly. In the former case each opponent must by himself or his agent comply with the Rules as to evidence, *etc.*, mentioned below; in the second case one of the opponents or the agent for the opponents can prosecute the opposition on behalf of all the parties after the notice of opposition has been filed at the Patent Office.

The notice of opposition must state the ground or grounds on which the opponent intends to oppose the grant, and must be accompanied by a copy, which is transmitted by the Comptroller to the applicant.

During the term of two months above mentioned an opponent on any of the four grounds may file a further notice of opposition relying on any of the other statutory grounds: after the expiry of these two months no such addition to the grounds of opposition is permitted, although formal corrections in the notice may be made.

Where the opponent does not desire that the patent should be refused, but merely that the specification should be amended by disclaimer or limitation, the notice of opposition should be accompanied or supplemented as soon as may be by a written statement to that effect, indicating so far as can conveniently be done the general nature of the amendments desired and the portions of the earlier specifications, if any, relied upon as necessitating such amendments.

Where the opposition is made on the ground first mentioned, unless evidence in support of the opposition is left at the Office within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's complete specification, or such further time as the Comptroller may in any special case allow, the opposition is deemed to be abandoned.

Where the opposition is made on the third ground mentioned, the notice of opposition should be accompanied by a written statement indicating, so far as can conveniently be done, in what respects the invention is alleged to be insufficiently or unfairly described or ascertained.

Except in the case of opposition on the first ground, statutory declarations need not be left in connexion with an opposition, but the opponent may, within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's complete specification, leave at the Office statutory declarations in support of his opposition, copies of which he must deliver to the applicant. Within fourteen days from the delivery of such copies, the applicant may leave at the Office statutory declarations in answer, copies of which he must deliver to the opponent: within fourteen days from such delivery the opponent may leave at the Office statutory declarations in reply, and on so leaving must deliver copies to the applicant.

If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do) within three months from the date of the advertisement of the acceptance of his complete specification, leave at the Office statutory declarations in support of his application, copies of which he must deliver to the opponent. Within fourteen days from the delivery of such copies, the opponent may leave at the Office statutory declarations in answer, copies of which he must deliver to the applicant: within fourteen days from such delivery the applicant may leave at the Office statutory declarations in reply, copies of which he must deliver to the opponent.

No further evidence may be left on either side except by leave, or on the requisition, of the Comptroller.

On completion of the evidence (if any), the Comptroller appoints a time for the hearing of the case, giving the parties ten days' notice at the least of such appointment. If either party desires to be heard, he must leave a form intimating that the hearing will be attended.

If either party intends to refer at the hearing to any publication, other than a specification mentioned in the notice of opposition, he should, unless the same has been referred to in a statutory declaration already filed, give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he intends to refer.

In any case in which the Comptroller thinks it right so to do, he may take evidence *vivâ voce* in lieu of or in addition to evidence by declaration, or allow any declarant to be cross-examined on his declaration.

In case any part of the evidence is taken *vivâ voce*, the Comptroller is, in respect of requiring the attendance of witnesses and taking evidence on oath, in the same position in all respects as an official referee of the Supreme Court.

In the case of opposition on the first ground the opponent's objection is, in effect, that not the applicant, but the opponent or some person through whom he claims, is the true and first inventor of the subject matter of the application. If it is established that the applicant has no legitimate rights in respect of the invention, the application will be stopped: if it appears, however, that both the applicant and the opponent contributed materially to the invention, terms will usually be imposed giving both parties an interest in the patent.

Like the Law Officer, however, the Comptroller has no jurisdiction to enquire into transactions outside this country. Allegations of fraud committed abroad are therefore irrelevant.

To establish *locus standi* the opponent on the second ground must have an interest in the subject of a prior patent; but, if interested in one prior patent, he may refer to other specifications or publications so long as they are germane to the particular question.

The objection is practically that of 'prior grant' (see pages 39 to 41): to justify the opposition the invention must

be actually claimed in a prior British specification. Hence, there is no right of opposition on the second ground by the author of a provisional specification, but opposition may be based on a pending complete specification; equally the proprietorship of a registered design gives no *locus standi* to oppose on this ground.

Where it is clear that there is no distinguishing difference between the alleged invention and the anticipation relied on, the application will be stopped. In case of doubt, however, the benefit of the doubt is given to the applicant.

It often happens that the opponent's objection can be avoided by amendment of the applicant's specification. In a proper case the applicant may submit his proposals for amendment to the opponent, before the date fixed for a hearing, and, if the latter agrees, the Comptroller may, without a hearing, order the patent to be sealed on the amended specification. Similarly, the applicant who is heard by the Comptroller may be in the position of having to amend his specification, with the alternative of rejection of the application. No amendment will be allowed, however, which practically amounts to the rewriting of the whole specification, and the formation of a claim to an invention which was not in the least the distinctive subject matter which the applicant had in view when he filed his specification.

The object of an opposition is frequently served by the insertion of a disclaiming clause in the applicant's specification. Where the opponent establishes that the prior patent relied on is a 'master-patent' or 'primary patent', and the later application repeats a claim to the invention covered by the prior grant, the disclaimer will usually take the form of a specific reference to the prior patent. In this case the opponent must give notice of his claim to possess a master-patent by filing a statutory declaration, stating that a search has been made with reference to the subject of the patent without disclosing any anticipation. The applicant, on the other hand, may rebut the claim to a master-patent

by pointing out in what respects the prior patent is anticipated.

The opponent on the third ground has only to point out the defects in the applicant's specification; he is not compelled to show in what way the document should be amended, though he may agree to withdraw the opposition on a suitable amendment being made.

Opposition on the fourth ground depends on disconformity. A claim which can be read within the four corners of the applicant's provisional specification will generally be granted; but, if the complete specification palpably includes an invention different from that disclosed in the provisional specification, and covered by an intervening application of the opponent, the grant will be made only on condition that the specification is amended so as not to claim the extra invention.

After hearing the party or parties desirous of being heard, or, if neither party desires to be heard, then, without a hearing, the Comptroller decides the case and notifies his decision to the parties.

The Comptroller has power by order to award to either party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the Court.

If a party giving notice of opposition to the grant of a patent neither resides nor carries on business in the United Kingdom or the Isle of Man, the Comptroller may require him to give security for costs of the proceedings, and in default of such security being given may treat the proceedings as abandoned.

The decision of the Comptroller is subject to appeal to the Law Officer, who will, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and decides the case. The Law Officer may, if he thinks fit, obtain the assistance of an expert.

The decision in opposition proceedings does not have the effect of binding the parties so as to create an estoppel. On the contrary, the effect of an opposition is frequently but to clear the way for litigation on a larger scale.

GRANT AND SEALING OF THE PATENT.

If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the applicant is called on to pay the sealing fee of £1 (except in the case of secret patents), on receipt of which a patent is granted, sealed with the seal of the Patent Office.

The patent is sealed as soon as may be, and not after the expiration of fifteen months from the date of application, provided that—

- (a) Where the Comptroller has allowed an extension of the time within which a complete specification may be left or accepted, a further extension of four months after the said fifteen months is allowed for sealing the patent :
- (b) Where the sealing is delayed by an appeal to the Law Officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the Law Officer may direct :
- (c) Where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death :
- (d) Where, in consequence of the neglect or failure of the applicant to pay the sealing fee, a patent cannot be sealed within the period allowed, the applicant may apply to the Comptroller for an extension not

exceeding three months, and, if the circumstances of the case appear to the Comptroller to warrant the granting of the extension, he may seal the patent within the extended period.

Upon the sealing of the patent the Comptroller causes to be entered in the register of patents the name, address and calling of the patentee, the title of the invention, the date of the patent and the date of grant, together with the address for service.

APPEALS TO THE LAW OFFICER.

When any person intends to appeal to the Law Officer from a decision of the Comptroller in any case in which such appeal is given by the Act, he must file a notice of his intention to appeal at the Patent Office within fourteen days from the date of the decision appealed against. No appeal will be entertained of which notice is not given within such time, or such further time as the Comptroller may allow, except by special leave upon application to the Law Officer. In case of opposition, if the appellant neither resides nor carries on business in the United Kingdom, the Law Officer may require him to give security for the costs of the appeal, and, in default of such security being given, may treat the appeal as abandoned.

The notice of appeal must state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of the decision.

A copy of the notice must be sent by the appellant to the Chief Clerk of the Law Officers' Department, at the Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or applicant, as the case may be.

Upon notice of appeal being filed, the Comptroller forthwith transmits to the Chief Clerk all the papers relating to the application in respect of which the appeal is made.

Seven days' notice, at least, of the time and place appointed for the hearing of any appeal must be given by the Chief Clerk, unless special leave is given by the Law Officer that any shorter notice be given. Such notice is in all cases given to the Comptroller and the appellant;

and, when there has been an opposition before the Comptroller, to the opponent or applicant, as the case may be.

The evidence used on appeal is the same as that used at the hearing before the Comptroller; and no further evidence can be given, except with the leave of the Law Officer upon application for that purpose.

The appeal is taken by way of a rehearing of the case before the Comptroller, and the appellant must show cause why the Comptroller's decision should be varied. The mere withdrawal of an opposition does not entitle an appellant to the grant of a patent which has been refused by the Comptroller.

The Law Officer is entitled to examine witnesses on oath and will, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person who has made a declaration in the matter to which the appeal relates, unless, in the opinion of the Law Officer, there is good ground for not making such order. Any party requiring the attendance of a witness for cross-examination must tender to the witness whose attendance is required a reasonable sum for conduct money.

Where the Law Officer orders costs to be paid by any party to another, he may fix the amount of such costs, and if he does not think fit to fix the amount, he directs by whom and in what manner the amount is to be ascertained. If any costs so ordered to be paid are not paid within fourteen days after the amount has been fixed or ascertained, or such shorter period as may be directed by the Law Officer, the party to whom such costs are to be paid may apply to the Law Officer for an order for payment. Such an order may be made a rule of the Court. In the case of opposition the costs generally follow the event, but if either party files a useless and unnecessary multiplicity of declarations, the Law Officer will, as far as possible, endeavour to fix him with the costs and responsibility for them. The Comptroller neither pays nor receives costs.

The Law Officer's decision is final.

THE LETTERS PATENT.

The present form of letters patent is the outcome of a process of evolution extending over several centuries. Some of the clauses of the deed of grant are now obsolete and meaningless, but the document continues to deserve careful consideration, as not only constituting the patentee's title-deed, but also setting out the intention of the Crown, the effect and conditions of the grant, *etc.*

The patent document commences with the 'address' from the Sovereign " 'To all to whom these presents shall come.' "

Hereupon follow the 'recitals,' consisting of statements to the effect that the patentee has declared that he is in possession of an invention, that he has prayed that a patent may be granted to him, that he has by and in his complete specification particularly described the nature of his invention, and so on. If any one of these statements is materially false, a false suggestion is said to be present, and the patent, on proof thereof, could not be enforced.

Then follows the 'grant,' which may be read together with the 'prohibition.'

By the 'grant' the Crown confers on the patentee especial licence, full power, sole privilege, and authority that the patentee by himself, his agents, or licensees, and *no others*, may at all times during the term of the patent *make, use, exercise, and vend* the invention within the United Kingdom, and Isle of Man, and that the patentee shall have and enjoy the *whole profit and advantage* from time to time accruing by reason of the invention during that term.

To the end that the patentee may have and enjoy the sole use and exercise and the full benefit of the invention, the Crown strictly forbids everyone within the United Kingdom and Isle of Man at any time during the life of the patent either directly or indirectly to make use of or put in practice the invention or any part of the same, or in any wise to imitate the same, or make, or cause to be made any addition thereto or subtraction therefrom, without the consent, licence or agreement of the patentee, on pain of being answerable to the patentee according to law for his damages thereby occasioned.

Following the 'prohibition' are set out the 'conditions' under which the grant is made, *i.e.*, the due payment of official fees, *etc.*

Finally, 'directions' are given to the Courts as to the manner in which the patent is to be construed. These 'directions' are, however, of historical importance only, since patents are now construed on the same principles as every other written instrument.

The patent, when sealed, has the same effect as if it were sealed with the Great Seal of the United Kingdom, throughout the United Kingdom and the Isle of Man. Except in the case of patents of addition, it has a duration of fourteen years, subject to payment of renewal fees, *etc.*

In the normal case the patent is dated and sealed as of the date of application: but no proceedings can be taken in respect of an infringement committed before the publication of the complete specification.

There is no guarantee that the patent will be valid and enforceable, but it may be assumed to be valid until the contrary is proved. For a real invention it is always possible to obtain a valid patent, capable of securing an effective monopoly to the patentee, while, for a questionable invention it is at least possible to obtain a patent in which the invention, such as it is, will be dressed to the best advantage. Such patents are not obtained by accident or good fortune, but by rule—one taught by long practice

and wide experience. The fact that a large percentage of patents are held invalid is mainly accounted for by the want of knowledge or want of care of patentees and those they employ to assist them. It has been our endeavour in preparing this book to point out clearly the usual causes of invalidity and how they may be avoided.

DUPLICATE LETTERS PATENT.

If a patent is lost or destroyed, or its non-production is satisfactorily accounted for, the Comptroller may at any time seal a duplicate of the patent.

An application for a duplicate of the patent must be made on a prescribed form bearing an impressed stamp of £2, and stating in full the circumstances of the case, which must be verified by statutory declaration.

The Comptroller will also, on request, issue a certified copy of the patent deed, which will be admitted in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the original.

RENEWAL FEES.

The grant of a patent is not unconditional.

Except in the case of secret patents and of patents of addition, the maintenance of the patent throughout its term is dependent on the payment of renewal fees.

The first of these fees, amounting to £5, is payable before the expiration of the fourth year from the date of the patent, and the others annually thereafter, with a yearly increase of £1. Alternatively, the patentee may pay all such fees in advance; the total, together with the official fees payable on the application, amounting to £100.

If a patentee fails to pay any fee within the time prescribed, he may, on payment of an additional fee, apply for an enlargement of time, not exceeding three months, for making the payment.

If any proceeding is taken, however, in respect of an infringement of a patent committed after a failure to pay a renewal fee within the prescribed time, and before the enlargement has been allowed, the Court before which the proceeding is proposed to be taken may, if it thinks fit, refuse to award any damages in respect of such infringement.

It is our practice to enter on our records all patents obtained through our agency, as also other patents when we are requested to do so, in order to send timely notices to clients when renewal fees fall due. We do not, however,

hold ourselves under any obligation to send such notices, or incur any liability should any notice miscarry. Still less do we guarantee that any fee will be duly paid unless we are instructed in advance by letter, accompanied by a remittance, to make the required payment.

RESTORATION OF LAPSED PATENTS.

Where a patent has become void owing to the failure to pay any fee within the prescribed time, the patentee may apply to the Comptroller for an order for the restoration of the patent.

The application must be made on a prescribed form, bearing an impressed stamp of £20, and stating in detail the circumstances which have led to the omission of the payment of the fee, and must be accompanied by one or more statutory declarations verifying the statements contained in the application.

If it appears that the omission was unintentional and that no undue delay has occurred in making the application, the application is advertised by the Comptroller. At any time within two months from the first advertisement any person may give notice of opposition at the Patent Office, and a copy of such notice is transmitted by the Comptroller to the applicant. The opponent must, within fourteen days after leaving the notice, leave at the Patent Office one or more statutory declarations verifying any evidence on which he relies in support of the grounds of his opposition, copies of which declarations he must deliver to the applicant. Upon such declarations being left and delivered the provisions as to declarations in the case of oppositions to applications for patents apply to the case. On completion of the evidence (if any), the Comptroller hears the party or parties desirous of being heard, and issues an order either restoring the patent or dismissing the application.

In every order restoring a patent, provisions are inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after it has been announced as void in the *Official Journal*. Such provisions restrain the patentee from commencing or prosecuting any action or other proceeding, and from recovering any damage :

(1) In respect of any infringement which may have taken place after the date on which the patent was announced in the *Journal* to be void and before the date of the order.

(2) In respect of the use or employment at any time thereafter of any mechanism, machine, machinery, process or operation actually made or carried on within the United Kingdom, or of the use, purchase, or sale of any article manufactured or made in infringement of the patent after the date of the announcement and before the date of the order. Provided that such use, purchase, sale or employment is by the person or corporation by or for whom such machine or machinery or article was *bonâ fide* manufactured or made, or such mechanism, machine, machinery, process or operation was *bonâ fide* made or carried on, his or their executors, administrators, successors, or vendees or his or their assigns respectively.

(3) In respect of the use, employment, or sale at any time thereafter by any person or corporation entitled for the time being by virtue of the above provision to use or employ any machine, machinery, mechanism, process, or operation, or any improved or additional machine, *etc.*, or of the use or sale of any article manufactured or made by any of the means aforesaid in infringement of the patent. The use or employment of any such improved or additional machine, *etc.*, is, however, limited to the buildings, works or premises, existing at the time being or afterwards erected, of the person or corporation by or for whom such machine, *etc.*, was made or carried on, his or their executors, administrators, successors or assigns.

The order further provides that if any person within one

year thereafter makes an application to the Board of Trade for compensation in respect of money, time, or labour expended by him upon the subject-matter of the patent in the *bonâ fide* belief that the patent had become and continued to be void, the Board may, after hearing the parties concerned, assess the amount of such compensation, if, in their opinion, the application ought to be granted; and specify the party by whom and the day on which such compensation must be paid. If default is made in payment of the sum awarded, then the patent becomes void, but the sum awarded will not in that case be recoverable as a debt or damages.

From any decision of the Comptroller ordering or refusing the restoration of a patent an appeal may be made to a Judge of the High Court, whose decision is final. As provided by the Rules of the Supreme Court,¹ such appeal must be brought by petition presented to the Court within one month of the decision of the Comptroller or within such further time as the Court may under special circumstances allow. Each such petition must state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision. It must also state concisely the grounds of the appeal, and no grounds other than those so stated, will, except with the leave of the Court to be given on such terms and conditions as seem just, be allowed to be taken by the appellant at the hearing. The evidence used must be the same as that used at the hearing before the Comptroller; and no further evidence may be given except by the leave of the Court on application to be made to the Court at or before the hearing.

In such proceedings the Court has all the powers vested in the Comptroller, and may make any order which might, or ought to, have been made by the Comptroller. The costs of and incident to the proceedings before the Court, including the costs of hearings before the Comptroller or the Board of Trade, are in the discretion of the Court.

¹ At the time of going to press only draft Rules have been published.

PATENTS OF ADDITION.

If the public has an interest in the introduction of an invention, it is equally interested in furthering its rapid development and in securing the full benefit of the patentee's experience. It appears politic, therefore, to encourage the patentee to disclose subsequent improvements in and modifications of the original invention, by rendering lighter the pecuniary burden which the maintenance of separate patents would entail.

Accordingly, the Act provides that where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired. In such a case the application is made on a prescribed form requesting the grant of a patent of addition, which, if conceded, remains in force during the life of the patent for the original invention, but no longer; the renewal fees payable on the original patent also serving to maintain the patent of addition.

An application for a patent of addition is not the sole mode of protecting an improvement in or modification of the original invention. The law gives the applicant a right of choice. In making his choice he has to consider the relative advantages of increased protection on the one hand, and decreased cost on the other.

An application for a patent of additions presumes the existence of a parent invention covered in this country by a prior pending application or by a prior patent still in force; the additional application may be filed at any time after the main application, but the grant cannot precede that of the main patent.

Only the former applicant for a patent, or the registered proprietor of the prior patent can apply for a patent of addition; if the prior application, or the prior patent, is in several names, all the applicants or patentees must join in the application for the patent of addition. A person who was not a party to the prior application, and is not registered as proprietor of the main patent, can only obtain an independent patent, whether he applies alone or jointly with one who would be entitled to receive a patent of addition.

The subject matter of a patent of addition must be a distinct invention, which invention must, however, relate to that claimed in the prior application or the prior patent, i.e., must be an improvement therein or a modification thereof.

While the terms 'improvement' and 'modification' denote general conceptions comprehending many particular orders of invention, the possibility of extending, by means of a patent of addition, the protection afforded by the main patent is limited by the implied requirement that the additional invention together with the main invention must constitute a technical or industrial unit.

Every application for a patent of addition must cover only a single improvement or a single modification; the question of unity of invention being determined by the same rules as apply to independent patents. To justify the inclusion of claims for several matters in one application for a patent of addition it is not sufficient that each separate improvement or modification is subsidiary to the main invention, when these matters are not so correlated that, if presented in an independent application, they could be separately claimed in one patent. On the other hand, the

applicant is not limited to the right to a single patent of addition, but may obtain as many patents of addition as he possesses subsequent improvements or modifications.

The patent of addition is no part of the main patent. Either patent may be infringed alone, or both may be infringed simultaneously. An action may be brought on either patent alone, and, conversely, each patent must itself carry all the requisites of validity: the faults of one cannot be counterbalanced by the merits of the other. Again, each patent has its own priority, by which the questions of novelty, invention, *etc.*, are to be decided, and from which the term for working is reckoned: only the date of expiry is the same for both patents.

Both patents are subject to the same conditions as to revocation, surrender, *etc.*, but with this difference, that, while revocation or surrender of the main patent carries with it the lapse of the patent of addition, just as the death of a tree means the death of the branch, the revocation or surrender of the patent of addition need not affect the main patent.

Subsequent to the grant, the patent of addition, or the main patent, or both, may change hands, so that the patents belong to different proprietors. In this case, however, the dependence of the patent of addition on the main patent is not affected.

The dependence of the later on the prior application is finally determined in the course of examination. If an application is made in error for a patent of addition it may be converted into an ordinary application. Conversely, an independent application may, while pending, be altered into an application for a patent of addition. After the date of grant no such change is possible.

The grant of a patent of addition is conclusive evidence that the invention is proper subject for a patent of addition, and the validity of the patent cannot be questioned on the ground that the invention ought to have been the subject of an independent patent.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

Neither foreign nationality nor residence abroad bars the grant of a patent. On the other hand, a patent is strictly territorial in its effect, and questions of novelty, inventorship, *etc.*, are regarded from a national standpoint only.

A cosmopolitan element has been introduced into patent law, however, by the union of a number of states, including the United Kingdom, to form the International Union for the protection of industrial property.

The principal clauses of the International Convention are reproduced elsewhere. It should be noticed here, however, that the Convention, which is in the nature of a contract between the parties, is not self-executing, and can only be rendered effective in this country by a legislative Act. The text of the Convention is, therefore, no part of the patent law of the United Kingdom, and all Convention applications must be made in the manner prescribed by the Act of 1907 and the Rules thereunder.

The following paragraphs summarise the practice on Convention applications in this country, mainly for the guidance of foreign correspondents. It may be observed, however, that the same benefits are accorded to British subjects and aliens, whether domiciled here or abroad.

Various Orders in Council have been published applying the provisions of the Act corresponding to the Convention in the case of certain foreign states and British possessions. Any person who has applied for protection of any invention

in any state or possession referred to in any such Order which is still in force is entitled to a British patent for his invention in priority to other applicants, and to receive for his British patent the date of the foreign or colonial application, provided priority is claimed within twelve months from the date of the first application in any state of the Union; should the priority not be claimed within this period, no further opportunity is afforded of antedating the patent.

It is immaterial whether the foreign or colonial application corresponding to the application in this country has been allowed or is still pending, or whether the invention is protected abroad otherwise than by a patent, *e.g.*, by registration as a design. Where a foreign or colonial application has proved abortive and no rights have been secured under it, the term of twelve months runs from the date of a second and successful application abroad.

The British application must be filed in the name or names in which the foreign or colonial application was made, and not in the name of an assignee or of a communicatee. If the foreign applicant is a firm or corporate body, then the British application must be filed in the name of the firm or corporate body alone. If the foreign or colonial applicant or any of the applicants be dead, the application must be made by the legal representative of such dead person as well as by the other foreign or colonial applicants, if any.

There being only one priority obtainable, a single patent cannot be granted under the Convention for inventions covered by two foreign or colonial applications in different names or of different dates; but the subject of two or more foreign or colonial applications of the same party, and of the same date, may be presented in a single British application, if the matter is regarded by the Patent Office as one invention. Conversely, although a single application is filed abroad, the British examiner may raise the objection that the British application comprises more than one invention.

A Convention application must be accompanied by a complete specification, which, whether accepted or not, will be open to public inspection after twelve months from the date of the foreign or colonial application, unless the application in this country is abandoned during such period of twelve months.

The British specification need not be identical in form with the foreign or colonial specification, but the invention in each case must be identical—any part of the matter originally claimed may be omitted, but no addition can be allowed, except of merely explanatory statements.

In addition to the complete specification a certified copy of the specification filed in respect of the first foreign or colonial application must be left at the same time as the application, or within such further time thereafter, not exceeding three months, and on payment of a fee of £2 for each extension of a month, as the Comptroller may allow. If any specification or other document relating to the application is in a foreign language, a translation must be annexed and verified by statutory declaration, or otherwise, to the satisfaction of the Comptroller.

Publication of any description of, or the use of, the invention in the United Kingdom during the period within which priority may be claimed will not invalidate the grant, but the examiner will quote anticipating specifications filed in support of applications of earlier date than that claimed under the Convention.

The British patent when granted is sealed as of the date of the first foreign or colonial application, and is entered in the register as of this date; and the payment of renewal fees and the expiration of the patent are reckoned from the date of the first foreign or colonial application.

EXHIBITIONS.

It has been mentioned above that the development of the system of filing applications with provisional specifications has been largely due to the Exhibition of 1851. Another consequence of that undertaking was the incorporation in the patent law of provisions whereby exhibitors received practically the same privileges as applicants who filed provisional specifications.

The practice is continued under the Act of 1907, which provides that the exhibition of an invention at an industrial or international exhibition, certified by the Board of Trade, or the publication of any description of the invention during the holding of the exhibition, or the use of the invention for the purpose of the exhibition where the latter is held, or the use of the invention during the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, will not prejudice the right of the inventor or of his legal representative to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

- (1) the exhibitor, before exhibiting the invention, gives the Comptroller notice of his intention to do so : and
- (2) the application for a patent is made before or within six months from the date of the opening of the exhibition.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made, the exhibitor must lodge with the notice of intended exhibition a brief description of his invention, accompanied, if

necessary, by drawings, and such other information as the Comptroller may in each case require.

His Majesty may by Order in Council apply the above provisions to any exhibition in like manner as if it were an industrial or international exhibition certified by the Board of Trade. In the case of exhibitions held abroad the Order usually provides that the exhibitor will be relieved from the condition of notifying the Comptroller of his intention to exhibit.

It is thus possible, in effect, for the exhibitor of an invention to increase by six months the term of provisional protection. That exhibitors seldom make use of the opportunity so afforded, is due, no doubt, to the circumstance that by the postponement of the application proper the issue of the patent is also delayed, and the risk of interference with other applications increased.

Provisions analogous to the above are found in the patent laws of most foreign states, and the protection of inventions exhibited at official or officially recognised exhibitions is the subject of an article of the International Convention. It should be observed, however, that in this country the Order in Council relating to any particular exhibition is alone decisive as to the conditions to be satisfied by the applicant for a British patent, and that the Convention cannot be invoked in favour of an applicant having no rights recognised by the Act or by any such Order.

DEVOLUTION OF TITLE.

As defined by the Act the 'patentee' means the person for the time being entitled to the benefit of a patent.

The statutory definition thus includes the successful applicant for a patent—which may mean the inventor or his legal representative—and any person or persons in whom the patent may have become vested by operation of law or by assignment.

In the case of an application for a patent by the legal representative of a person who has died possessed of an invention, or of an application to register the representative of a deceased patentee as proprietor of the patent, probate of the will of the deceased, or the letters of administration granted of his estate and effects, or an official copy of the probate or letters, must be produced at the Patent Office in proof of such representative's title.

If the deceased was domiciled abroad, representation to the estate in this country may be granted to the person who under English law would be entitled as next of kin, or to the administrator appointed by the Court where the deceased was domiciled, or to an attorney on behalf of such parties. For this purpose the representative must enter into a bond, with a surety in this country, in a penal sum of double the gross value of the English assets, and must further make the usual oath, and an affidavit for Revenue purposes verifying the particulars of the estate.

The property in a patent passes by operation of law, not only in case of death of the patentee, but also in case of

bankruptcy. In the latter event the property passes to the receiver, trustee or assignee in bankruptcy. Letters patent may also be seized by the sheriff under a writ of *fi. fa.*, and disposed of on behalf of a creditor.

Again, patent rights may be transferred by assignment or by the grant of licences, or may be the subject of a mortgage. The discussion of assignments and licences is reserved for treatment in separate chapters. Of mortgages it may suffice to say that these are as rare as they are unsafe, on account of the uncertain value of the security, and that, in any event, no business man should become a mortgagee to any substantial amount before being assured by a competent agent as to the scope and validity of the patent.

It is customary, in the case of a patent held by several persons, for the patentees to conclude agreements with one another as to their respective rights. In the absence of a contract to the contrary, each co-owner of a patent is entitled to use the invention without accounting to the others. In the case of patents granted before 1st January, 1908, there is some doubt whether one co-owner is entitled to grant a licence without the consent of the others; the right to do so is, however, expressly denied in respect of patents granted after that date.

The Act of 1907 has instituted a further important alteration in the relations between co-patentees. While providing that co-owners of a patent granted on or after 1st January, 1908, will, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, it also provides that if any co-patentee dies his beneficial interest in the patent will, subject to any contract to the contrary, devolve on his personal representatives as part of his personal estate. This last provision reverses the previous practice whereby, unless there was a severance of the joint interest during the lifetime of the parties, the entire interest of a deceased co-patentee passed by survivorship to the others.

In any case in which the applicants have asked to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in the patent as joint tenants, the form of the patent is correspondingly modified.

The rights of a deceased co-patentee having no personal representative accrue to the survivors. If a sole patentee dies without heirs, the patent vests in the Crown as *bona vacantia* and merges. In the case of Taylor's Agreement Trusts, XXI. R.P.C., p. 713, where the petitioner had bought a patent from a company which went into liquidation and dissolved without a legal assignment being obtained, *Buckley L. J.* refused to make a vesting order as against the Crown. After the judgment the Board of Trade directed the Comptroller to register the petitioner as proprietor of the patent, but there is grave doubt whether waiver of its rights by the Crown could save the patent from being merged.

ASSIGNMENTS.

The value of a patent as a commercial asset would be greatly reduced if the owner was unable to transfer it to others, for instance, to interested manufacturers, to capitalists, or to investors taking shares in a company formed to exploit the invention. Such a transfer is possible by virtue of the general power to assign vested in the patentee by the terms of the grant, and the statutory recognition of assignments for any place in or part of the United Kingdom or the Isle of Man.

Broadly speaking, a patent may be transferred in exchange for a valuable consideration, or it may be the object of a gift, and it may be assigned in whole or in part.

In the case of a total assignment the assignor parts with all his interest and is then in the same position as third parties; the assignee, in turn, assumes the position formerly occupied by the assignor.

In the case of a partial assignment the assignor abandons only a more or less considerable part of the property, while reserving the remainder for his own profit. Many instances of partial assignments might be quoted, *e.g.*, an assignment for a limited area, an assignment of rights in respect of part only of the subject matter claimed in the specification, or an assignment carrying with it a claim to a share of royalties paid by licensees, or of damages collected from infringers. In every case the effect of the partial assignment is to make the assignee a co-proprietor of the patent, *i.e.*, a tenant concurrently with the assignor, and having rights equal to his, subject to any conditions introduced into the assignment. It will be evident, therefore, that there is no logic in a form of assignment frequently adopted which purports simply to pass a fraction of a patent.

It is not unusual for an assignor of a patent to agree to assign his rights in respect of future improvements in the invention, or for an assignee taking a partial assignment to come under an obligation to communicate improvements made or acquired by him to the assignor. A covenant to this effect is not void for uncertainty, and may be specifically enforced. If, indeed, any such improvements are protected by patents of addition, then all the registered proprietors of the main patent must be joined in the subsequent applications.

In the case of a patent granted to several persons, each patentee may transfer his individual share, without being able, however, to assign the whole patent or release the rights of other owners.

Similarly, in the absence of any covenant to the contrary, each assignee may reassign his interest, or a share of his interest, in the patent to others.

An assignment of a patent may contain many and various conditions, the observance of which, if in accordance with the law, can be required by any of the parties as in the case of any other contract. Without enumerating all the points to be considered, mention may be made of the advisa-

bility of settling the responsibility of maintaining the patent, the guarantee, if any, offered of the validity of the patent or of its independence of other patents, the possession of the letters patent, and the conditions, if any, to be imposed on either party as to the production and sale of articles made under the patent. What is emphasised, however, is the necessity for deciding all such points at the time when the contract is concluded, and of setting them down definitely in writing in clear and unambiguous language.

A patent cannot be assigned until it is actually granted, *i.e.*, before it has any legal existence. Where it is intended to transfer an inchoate right to a patent which has not yet been sealed, or where a patent is to be assigned subject to certain events taking place, *e.g.*, subject to the flotation of a company, it is desirable that the actual assignment should be preceded by an agreement, which, if occasion arises, can be specifically enforced.

A patent being given under seal, a legal interest in it can only be assigned by a deed, which should be duly stamped in accordance with the provisions of the Stamp Acts. An instrument not under seal, which purports to be an assignment, will, however, effectually pass the immediate equitable interest.

A legal assignee of a patent may sue for infringement, either alone or jointly with his co-patentees, while his position is not liable to be disturbed by any subsequent acts of the assignor. An equitable assignee is in a much less advantageous position. Not only is his equitable title liable to be defeated by a subsequent purchaser taking a legal assignment without notice of the equitable interest, but, being unable to sue infringers without joining the legal owner, he has no defence to an action for threats.

Deeds of assignment are best prepared according to forms which have already been proved to be valid and effective. Needless to say, in every case the preparation of the instrument should be left to a competent conveyancer, and no assignee should be content to dispense with the advice of his own agent, who will best look after his interests.

When the assignment is completed, an application should at once be made to enter the name of the subsequent proprietor on the register of patents. The purpose and effect of registration are explained in a subsequent chapter.

ASSIGNMENT TO THE SECRETARY FOR WAR OR THE ADMIRALTY.

The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for War or the Admiralty, on behalf of His Majesty, all the benefit of the invention and of any patent for the same.

Directions to inventors desirous of so assigning their rights are issued by the War and Admiralty Offices. Attention is drawn to the fact that expenses or loss of time incurred before or after the submission of an invention will give no claim unless authority for such expenses has been officially given, and that no claim for reward for an invention will be held to be established unless the invention is adopted into the service, and all designs, drawings, patterns and particulars required by the department have been supplied.

The communication of an invention to the Secretary of State or the Admiralty, or to any person authorised to investigate the same will not, nor will anything done for the purposes of the investigation, be deemed use or publication of the invention so as to prejudice the grant or validity of any patent for the same.

If the Secretary of State or the Admiralty decides to take out a patent for any invention assigned to him, an application for a secret patent is delivered to the Comptroller in a sealed packet, accompanied by a certificate of the Secretary of State or the Admiralty that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

A special examiner makes the investigations and reports required by the Act to be made in the case of other applications for patents, and the Comptroller is forbidden to communicate the application to any other member of his staff.

Neither the application nor the acceptance of the specification is advertised, and no opportunity is afforded for opposition; but, on the completion of the examination, the Comptroller causes a patent to be sealed without publishing the specification.

Every secret patent is registered in a confidential register at the Patent Office. No details or particulars relating to the patent are published, and no entry of the case is made in the ordinary register of patents. No proceedings, by petition or otherwise, lie for revocation, and the patent, good or bad, remains in force for the full period of fourteen years without the payment of any fees.

When an application for a patent made in the ordinary way is still pending, and a certificate is furnished to the Comptroller by the Secretary of State or the Admiralty, the foregoing provisions will, so far as is practicable, having regard to the date of the certificate, apply to that application.

In the event of any secret patent being reassigned to the inventor by the Secretary of State or the Admiralty, it is removed from the confidential register of secret patents and entered in the ordinary register; all fees that would have been thereafter payable if the same had not been a secret patent must be paid in respect thereof, and the patent remains in force only for the same term, and subject to the same conditions as to payment of fees and otherwise, as an ordinary patent.

LICENCES.

In seeking to turn his invention to profitable account, the patentee may, for a consideration, release others from

the consequences of infringement by granting licences authorising them to do certain things covered by the patent.

Only capitalists and speculators prefer to purchase a patent outright, but many more are ready to adopt promising inventions for use in their own business, making payment usually in the form of royalties, which, with the profits that the patentee may make if he reserves to himself the right to use the invention, represent the value of the patent to its owner.

Licences are of various forms; they may be exclusive or non-exclusive, and either limited or unlimited in point of duration, area, or production.

The grant of a licence is distinguished from the partial assignment of a patent in that the licence confers no right to property, is personal to the licensee, and does not *ipso facto* authorise the licensee to proceed against infringers.

Like an assignment a licence is to be regarded as a legal contract, the terms of which should be settled by one familiar with the intricacies of patent law. Although, for this reason, a mass of particulars will not be required by readers, it may be useful to summarise the chief practical points requiring attention by both parties to a licence.

Since a licensee is willing to pay royalties or incur other obligations only in order to be on a better, or at least no worse a footing than his competitors, the licensor should be prepared to give, and the licensee should require, an undertaking from the patentee to take proceedings against infringement by unlicensed parties, as also the option of licences in respect of future patents or patents of addition, and, except in the case of an exclusive licence, an undertaking to accord to him terms no less favorable than to other licensees.

Unless otherwise agreed, the effect of the licence is independent of the validity of the patent, a guarantee of which ought, therefore, to be required by anyone intending to take a long-term licence.

In the absence of a covenant to the contrary, a licensee is not obliged to use the patented invention in respect of which the licence is granted. Accordingly, a patentee who depends for his profits on royalties paid by the licensee should guard against the latter's inactivity by requiring the payment of a minimum royalty and providing for termination of the licence in default of payment.

A bare licence, whether exclusive or not, is revocable at will; but a licence coupled with an interest, or coupled with obligations, or containing terms which are inconsistent with the right to revoke, is binding on both parties for the full period for which it is granted, or for the remaining term of the patent.

A licence is usually under seal, but a deed is not essential; a licence given by any agreement in writing, or even by parol, if acted upon, will be enforced between the parties. In equity, a mere agreement to grant a licence, where the terms are concluded, is as effective as a formal deed. A licensee should, however, protect himself against any dealings over his head by requiring the terms of the licence to be embodied in a deed duly stamped and entered on the register of patents.

Both the licensor and licensee are presumed to be aware of the effect of a licence to which they are parties; ignorance will not enable them to escape the application of the principles of estoppel, or avert the consequences of inserting in a licence a condition in restraint of trade or contrary to public policy.

ILLEGAL CONDITIONS IN CONTRACTS.

Supported by various judicial decisions, patentees have heretofore been able to attach such conditions to the use of their inventions as to give them monopolies which in some cases proved more oppressive even than those condemned by the Statute of James I.

Representations in favour of an amendment of the law came principally from those engaged in the boot and shoe industry who complained rightly or wrongly that they were practically tied to a machinery trust, in consequence of which a section was incorporated in the Act of 1907 releasing users from inequitable burdens imposed by the owners of patents.

This section declares it to be unlawful, in any contract in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition, the effect of which will be :—

- (a) to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or
- (b) to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent.

Any such condition will now be held to be null and void, as being in restraint of trade and contrary to public policy.

The above provision does not apply, however, if—

- (1) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without the objectionable conditions referred to; and
- (2) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving three months' notice in writing and on payment in compensation for such relief of such sum, or such rent or royalty, as may be fixed by an arbitrator appointed by the Board of Trade.

Any contract relating to the lease of or licence to use or work any patented article or patented process, may at

any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in that or in any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party. Any party giving notice determining any contract made before 28th August, 1907, will be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

Any contract made before 28th August, 1907, and containing any condition which, had the contract been made after that date, would have been null and void, may, at any time before the contract is determinable under the last preceding paragraph, be determined by either party on giving three months' notice in writing to the other party. In the last case the party giving notice will be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

The insertion by the patentee in a contract made after 28th August, 1907, of any condition which on the above grounds is null and void is available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

The above provisions are not to be construed as validating any contract which otherwise would be invalid. Neither do they affect (a) any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or (b) any right of determining a contract or condition in a contract exercisable independently of these provisions; or (c) any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

COMPULSORY LICENCES.

The grant of a patent confers on the patentee the right to the exclusive use of the invention: there is also the possibility of his not using it.

The social character attaching to the patent right requires, however, that it will not be made to serve an anti-social purpose, *i.e.*, corresponding to the exclusive right to use the invention, there is a presumed obligation to use it. Just as in the case of other property the obligation is imposed on the owner of using it in such a way that public interests are not injured or endangered, so also the duty rests on the proprietor of a patent of exploiting it for the benefit of home industries.

The Act of 1907 contains various provisions safeguarding the public interests in this respect.

The first of these provisions to be considered is that relating to the grant of compulsory licences, with the alternative of revocation of the patent.

Any doubt as to what are the interests to be thus safeguarded is dispelled by the explicit phraseology of the Act, which declares that the reasonable requirements of the public will not be deemed to have been satisfied—

- (1) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met; or
- (2) if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the

patentee to the purchase, hire, or use of the patented article or to the using or working of the patented process.

A petition may be presented to the Board of Trade by any person interested, alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.

The petition must show clearly the nature of the petitioner's interest and the ground or grounds upon which he claims to be entitled to relief, and must state in detail the circumstances of the case, and the terms upon which he asks that an order may be made.

The petition must be left at the Patent Office accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition, together with any other documentary evidence in support, and the petitioner must simultaneously with, or as soon as may be after, the leaving of the petition deliver to the patentee and any other person who is alleged to have made default, copies of the petition and of the affidavits or statutory declarations and other documentary evidence.

The persons to whom the copies are delivered may give notice of opposition to the petition and may, after being invited to do so by the Board, leave at the Patent Office their affidavits or declarations in answer, and, if they do so, must deliver copies to the petitioner; the petitioner may then leave at the Patent Office his affidavits or declarations in reply, and, if he does so, must deliver copies to the patentee or any other person alleged to have made default.

No further evidence may be left at the Patent Office by either side, except by leave or on requisition of the Board, and upon such terms, if any, as the Board may think fit.

The Board then consider the petition and the evidence, with a view to satisfying themselves whether a *prima facie*

case has been made out for proceeding further, and if they are not so satisfied the petition is dismissed.

If the Board are so satisfied, however, they consider whether there is any probability of an arrangement being come to between the parties, and may take such steps as they consider desirable to bring it about.

If the Board are not of opinion that there is a reasonable probability of any arrangement being come to between the parties and are satisfied that a *prima facie* case has been made out by the petitioner, the petition is referred to the Court, i.e. to a Judge of the High Court, whose decision is final, or in Scotland to any Lord Ordinary of the Court of Session.

As provided by the Rules of the Supreme Court, in any such petition referred to a Judge of the High Court by the Board of Trade no evidence may be given upon any issues other than those raised in the original petition to the Board of Trade.

The petition must be served by the petitioner upon all persons appearing by the register of patents to be owners or exclusive licensees under or otherwise interested in the patent.

The petition must, if the Court is a Judge of the Chancery Division, and subject to any direction of the Court to the contrary, be set down in the same manner as if it were a witness action assigned to such Judge, but must not be so set down until the expiration of fourteen days after the lodging by the petitioner with the Court of an affidavit that all persons appearing by the register to be interested in the patent have been duly served with the petition.

Where a petition is referred to a Lord Ordinary of the Court of Session, the case is tried in accordance with the forms of process of the Scotch Courts.

Where a petition is referred to the Court, and it is proved to the satisfaction of the Court that the reasonable requirements of the public with reference to the patented invention

have not been satisfied, the patentee may be ordered by the Court to grant licences on such terms as the Court may think just, or, if the Court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the Court.

An order of revocation will not be made, however, before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

On the hearing of any petition the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise are made parties to the proceeding, and the Law Officer, or such other counsel as he may appoint, is entitled to appear and be heard.

An order of the Court directing the grant of a licence will, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.

The reader of the subsequent chapters on revocation of patents will note that more is required of the patentee than that he shall satisfy public requirements in respect of the material objects of the patent. The provisions relating to compulsory licences are not superfluous, however, but meet the case of a patentee who evades the clauses of the Act decreeing forfeiture of patents for inventions worked exclusively or mainly abroad. In short, the Act hits not only the patentee who favours foreign industries at our expense, but also the patentee who simply refuses to use his invention for the benefit of British industries.

The above provision, however, need not affect patentees who are ready and willing to use their inventions and, for a consideration, to extend the use to others. The patentee who is himself unable to cope with the demand for the article will gain and not lose by granting licences to others who offer sufficient remuneration and proper security. More than this he is not required to do, while no one can successfully present a petition who has not in fact already asked

for a licence and failed to receive a satisfactory response from the patentee.

The patentee who himself possesses neither a factory in this country nor the means to establish one is making the best use he can of his invention if he offers it directly to manufacturers or advertises it in suitable journals. In this way he may obtain more favourable terms than might be forced on him at the peril of legal proceedings. In no case, however, need a deserving patentee regard the provisions as to compulsory licences either as a tax on his property or as creating obstacles to his enjoyment of the profits due to him for his invention.

In some cases patentees may have grounds for refusing to grant licences, especially to competitors. As the respondent to a petition for a compulsory licence a patentee may be able to prove that the reasonable requirements of the public have been and are, in fact, being satisfied. Even should he fail to do so, it does not of necessity follow that the Court will order the grant of a licence; the Court will rather consider whether the public interest will be better served by leaving the monopoly intact or by setting up a state of competition. Much will depend on the deserts of the petitioner.

In any case revocation is not likely to be ordered against an inventor who has at least rendered as much service to the public by the introduction of the invention as any possible injury on account of his inability to cope with the demand.

Various reasons for default may be accepted as satisfactory, for instance, objective reasons such as war, strikes, commercial depression, litigation, or prejudice against the invention, or subjective reasons such as poverty, ill health, enforced absence from the country, or imprisonment.

Revocation may be expected, however, where there has been more than a passive failure to satisfy the public requirements—where, in fact, the patentee has taken active steps tending to prejudice the public interests. Satisfactory reasons for default in this case there are none.

REGISTER OF PATENTS.

The register of patents is a book kept at the Patent Office, wherein are entered the names and addresses of grantees of patents, notifications of assignments, transmissions, licences, amendments, extensions, and revocations of patents, payments of renewal fees, and such other matters as affect the validity or proprietorship of patents.

The register is open to public inspection and is *prima facie* evidence of any matters inserted therein. Certified copies of any entry therein, sealed with the seal of the Patent Office, may be obtained by any person on payment of a small fee.

Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to any interest in a patent, as mortgagee, licensee or otherwise, the Comptroller will, on request, register him as proprietor of the patent or cause a notice of the interest to be entered in the register of patents.

Every assignment, and every other document containing, giving effect to, or being evidence of, the transmission of a patent, or affecting the proprietorship of a patent, except such documents as are matters of record must, for the purpose of registration, unless the Comptroller otherwise directs, be produced to the Comptroller, who may also call for other proofs of title. As to a document which is a matter of record, an official or certified copy must in like manner be produced to the Comptroller.

There must also be left with the request an attested copy of the assignment or other document or copy.

When it is desired to enter in the register a notification of any document purporting to affect the proprietorship of a patent, an attested copy of the document must be left at the Patent Office with a request that a notification may be entered in the register. The accuracy of the copy must be certified as directed by the Comptroller, and the original

document must at the same time be produced and left at the Patent Office, if required for further verification.

If any document which it is desired so to enter in the register is in a foreign language, it must be accompanied by a translation notarially certified.

No notice of any trust expressed, implied or constructive is entered on the register; but a notification of a document which creates a trust may be entered.

Subject to any rights vested in any other person, the registered proprietor of a patent has power absolutely to assign, grant licences as to, or otherwise deal with, the patent; but any equities in respect of the patent may be enforced in like manner as in respect of any other personal property.

It behoves any person who contemplates acquiring a patent or an interest in a patent or otherwise dealing with a patent to make a careful scrutiny of the register to ascertain that there are no outstanding incumbrances. The question arises whether an entry in the register of an equitable interest constitutes a 'notice' to any person who subsequently acquires an interest in the same patent which brings him in conflict with the first interested party. Past decisions lead to the view that the entry is not of itself a 'constructive notice,' but circumstances might arise in which the failure to inspect the register, accompanied by other instances of negligence, would suffice to defeat any claim to preference.

The entry of a proprietor's name on the register is desirable for the further reason that only then is he entitled to receive official communications regarding his patent.

The Court may, on the application of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by an error or defect in any entry in the register, make such order for making, expunging or varying such entry as it may think fit.

The persons aggrieved are all persons who are in some way substantially interested in having the register rectified, or persons who would be substantially damaged if the rectification did not take place, but not common informers or individuals interfering from purely sentimental motives. For instance, a refusal by the Comptroller to cause the name of a person who had become entitled to a patent, or an interest in a patent, to be registered as a proprietor or as having such interest would constitute such person as a person aggrieved.

An application for the rectification of the register may be made to the High Court in England or Ireland, and in Scotland to any Lord Ordinary of the Court of Session.

Four clear days' notice of the application must be given to the Comptroller, who has the right to appear and be heard, and must appear if directed to do so by the Court.

When an order or decree has been made for the rectification of the register, a copy of the order, decree or other authority, must be served on the Comptroller who rectifies the register accordingly.

The provisions as to rectification refer, of course, to patents already on the register. Thus, the Court is not empowered to order the entry on the register of a patent the grant of which has been refused by the Comptroller and the Law Officer. Equally, this procedure is inapplicable to any case where it is desired to alter anything actually appearing on the letters patent.

Clerical errors in the name or address of the registered proprietor of a patent or in any other matter which is entered on the register may be corrected, and any change of name or address, or address for service, of the proprietor may be entered in the register by the Comptroller on the request of the party concerned.

ESTOPPEL.

It is a well recognised principle of law that when a man has entered into a solemn engagement, for instance, under his hand and seal, as to certain facts, and anything has been done by virtue thereof, he will not be permitted to deny any matter which he has so asserted.

In accordance with this principle, the assignor of a patent treated as valid for the purpose of the assignment is "estopped" from denying the validity of that patent in any subsequent action for infringement brought against him by the assignee, or any person deriving title through him. He is entitled, however, to plead that on the proper construction of the specification nothing that he is doing is an infringement. Conversely, in an action brought by the assignor to enforce an agreement for the assignment of a patent, in the absence of any agreed condition to the contrary, it is not open to the assignee to repudiate his obligations on the plea that the patent is invalid.

Similarly, unless otherwise agreed, the parties to a licence to use a patented invention are estopped, during the continuance of the licence, from denying the validity of the patent against each other. Accordingly, in an action to recover royalties, a licensee can practically only plead fraud, or show that the patent in question has expired, or that either he has met his obligations or what he has done outside the licence is not an infringement of the patent. On the termination of the licence, however, the estoppel also ceases.

Judgment having been given against the defendant in an action for infringement, that defendant cannot plead the invalidity of the patent as a defence to a subsequent action brought against him; he is estopped by the first judgment, even although the first judgment was entered by consent. Similarly, when, in an action for infringement, the question of validity has been decided against the patentee, and the defects in the patent have not been removed by amendment, the defendant, if again attacked, may simply plead that the

matter is already *res judicata*. But where the defendant in a second action is not the same as in the first, there is no estoppel on either side, although strong additional evidence will be required in order to reverse the previous finding of a Court of equal or superior jurisdiction. There is, however, no estoppel against a petitioner for revocation who was an unsuccessful defendant to an action for infringement of the same patent, since the petitioner appears then as a member of the public, and there is no *res judicata* between him and the patentee in that capacity.

An estoppel must be very certain to every intent, and is not to be taken from argument or inference. The parties directly concerned alone are bound, and even they are only bound when in the position of litigants on opposite sides. Thus, a bankrupt patentee is not estopped from denying the validity of a patent as against the purchaser from the trustee in bankruptcy, if there is nothing to show that the purchaser has bought on the faith of any representation made by the patentee; nor does the fact that one defendant to an action for infringement is estopped from pleading invalidity of the patent prevent a co-defendant from so pleading.

CONSTRUCTION OR INTERPRETATION OF SPECIFICATIONS.

Construction of a specification is notoriously one of the most difficult duties imposed on anyone having to do with patents, whether the object is to ascertain what a patentee claims, or what is an anticipation or what an infringement, or what meaning is to be attributed to any directions in the specification.

Even the most detailed theoretical exposition of the process of construction must be inadequate. For the present purpose it is considered sufficient, however, to state the more important rules to be observed with reference to patents, so as to assist the understanding of remarks already made as to the qualifications of a proper specification, and also of our criticism of defective specifications.

Like all other written instruments a specification must speak for itself. Its meaning cannot be elucidated from subsequent statements or explanations made by its author. On the other hand, the specification must be construed by reference to surrounding circumstances. As in construing a will one must endeavour, figuratively, to put himself in the testator's chair, to know his property, to know his family, and to conclude from such knowledge what the words which he has used must mean; so with a specification, one must put himself in possession of the common knowledge, that is to say, all that was known to the patentee. To put it in another way, the specification must be construed in the light of public knowledge at the date of the patent: consequently, the meanings to be given to special words

and expressions must be those that were current on the day the specification was written.

The specification and claims must be read as a whole; a special meaning is not to be attributed to one part of the specification when that is contradicted at another part. More particularly the errors are to be avoided of reading claims as isolated sentences, and of confusing the statement of the nature of the invention with that of the manner of its performance. Indeed, since effect will be given to every part of the document, a different meaning will be found, if possible, for each claim, so that the presence of one claim may have the effect of broadening another, or the reverse; in some cases with the result of making the patentee claim what was in fact too general or too insignificant to be patentable. On the other hand, when a patentee, having claimed his invention, proceeds to claim something merely subsidiary, the effect of which is neither to enlarge nor alter the scope of the patent, the Court may treat the additional claim as mere surplusage, which neither benefits the patentee nor tells against the validity of the patent.

It is to be observed, however, that what is alleged to be protected by a patent must be found in the claims, indicated either by express words or by plain reference. The idea that a patentee is allowed to use perfectly general language in writing his claims and subsequently to restrict, or expand, or qualify what is therein expressed by borrowing this or that gloss from other parts of the specification is wholly inadmissible.

Unless there is any urgent reason to the contrary, the specification must be interpreted according to its literal meaning, and according to the ordinary rules of grammar and syntax. Similarly, the drawing must be taken to indicate what it shows on the face of it, in the absence of any directions to the contrary in the written description. If a specification can be read in two ways—so as in one case to claim something which is novel and patentable, and calculated to attain a practical success, and in the other case so as to claim something which is so inconsistent with

up-to-date common knowledge that it is unreasonable to suppose the patentee would have used the words in that sense—that construction will be adopted which makes the patent reasonable and sensible, rather than a construction which makes it absurd. Nevertheless, if a patent is found on a fair construction to claim matters that are not new, effect must be given to it. A forced construction cannot be put on the patent as not intending to claim something that is old, simply because it was foolish or suicidal of the patentee to claim it.

Construction is a duty of the Court alone, and not of witnesses. On the other hand, as a specification usually refers to highly technical and scientific matters with which a Judge is not always conversant, the Court is often obliged to depend on the evidence of experts. This is so with regard not only to specifications of patents which form the subject of litigation, but also to other documents cited as anticipations or otherwise referred to.

A patent agent can thus assist his clients by anticipating, more or less approximately, the judicial interpretation of a specification in the event of litigation, and also directing them as to the extent of the claims of a patent with a view to answering non-contentious questions, for instance, as to the scope of a licence, or the working of a patent by alternative modes of operation.

AMENDMENT OF THE SPECIFICATION.

Occasionally an applicant or a patentee finds, even when his specification has been examined, that by reason of the claims being broader than is warranted, or on account of error or ambiguity in the description or drawings, or for some other cause, his patent is likely to prove invalid. Again, it may be that the owner of a patent validly granted is unwilling to jeopardise his claims to what is really valuable by retaining in the specification matter of minor importance. In such cases he may put his patent in order by amendment of the specification.

When no action for infringement or proceeding before the Court for the revocation of the patent is pending, an application may be made for leave to amend a specification by way of disclaimer, correction or explanation. For this purpose the applicant or the patentee, as the case may be, must leave at the Patent Office a form of request bearing an impressed stamp of £1 10s., if the patent is not yet sealed, or of £3 if the patent is already sealed. The request must be accompanied by a statement of the nature of, and the reasons for, the proposed amendment, the alterations desired being marked on a certified copy of the specification. Thereupon, the request and statement are advertised in the *Official Journal*, and the applicant is required to insert a notice in the *Times* and a suitable trade paper.

At any time within one month from the first advertisement any person may file at the Patent Office a notice of opposition to the amendment, whereupon the Comptroller notifies the person making the request; the rules relating to the filing

of evidence and the hearing of the parties in the case of opposition to the grant of a patent being made applicable.

Where no notice of opposition is given, or the opponent does not appear, the Comptroller determines whether and subject to what conditions (if any) the amendment ought to be allowed.

The decision of the Comptroller in either case is subject to an appeal to the Law Officer, who will, if required, hear the person making the request to amend, and, in case of opposition, the opponent, if he is, in the opinion of the Law Officer, entitled to be heard, and, where there is no opposition, the Comptroller; and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.¹

Whether opposition is made or not, in no case is an amendment properly allowable which would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

It follows that an amendment cannot be utilised to import subsequent knowledge into a specification, or for the purpose of rendering sufficient an insufficient description of the invention, or in order to protect any feature not originally claimed. Such explanatory matter as may be added must only put more clearly what is already described in the specification or shown in the drawing. Such correction as is permissible must leave the statement of invention identical, but rectifies inaccuracy of language or of lines constituting a drawing. A permissible disclaimer leaves the statement of claim narrower, or at least not broader than the original form; in no case is an opening given for the substitution of a claim for a different invention from that originally claimed, or for the rewriting of the entire specification, even if nothing less will suffice in order to make the patent good.

¹ The subject of appeals before the Law Officer is discussed more fully at pages 83 and 84.

Greater latitude is allowed in amending a specification when a mistake has been made by some person other than the patentee, as, for instance, by the translator of a specification supplied in a foreign language. In such a case a declaration from the responsible party clearing the patentee of liability is usually required.

Leave to amend is conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and in all Courts and for all purposes the amendment is deemed to form part of the specification. Consequently, when a specification has been amended, the document as it stood before amendment cannot be competently referred to, except, and even this is disputed, as an aid in the construction of its language after amendment.

In any action for infringement of a patent, or proceedings before a Court for the revocation of a patent, the Court may by order allow the patentee to amend his specification by way of disclaimer in such manner, and subject to such terms as to costs, advertisement or otherwise, as the Court may think fit. No amendment will be so allowed, however, that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment.

The Rules of the Supreme Court¹ provide that an application by a patentee for leave to amend his specification by way of disclaimer must be made by motion in the proceedings pending before the Court, and notice of such motion together with a King's printers' copy of the specification showing the proposed amendment must be served on the parties to such proceedings.

On the hearing of the motion the Court decides whether and on what terms as to costs or otherwise the application may be allowed to proceed, and, if the application is allowed to proceed, will give directions as to whether the application is to be heard on oral or affidavit evidence, and, if on

¹ Proceedings in Scotland must be taken in accordance with the forms of process in Scotch Courts.

affidavit evidence, will fix the times within which affidavits must be filed by the parties respectively and by any other person entitled to be heard.

If the application is allowed to proceed, the applicant must forthwith serve the Comptroller with a copy of the notice of motion together with a copy of the amended specification and a copy of the order allowing the application to proceed, and the name and address of the applicant's solicitor. Thereupon the proposed amendment is advertised in the *Official Journal*; the advertisement stating that any person desiring to oppose the amendment must, within fourteen days of the issue of the advertisement, give notice in writing to the applicant's solicitor. Any person giving such notice will be entitled to be heard upon the hearing of the motion.

Within seven days after the receipt of such notice the applicant must serve on the person giving notice a copy of the notice of motion together with a copy of the specification showing the amendment, and also a copy of the order allowing the application to proceed.

In the case of an application directed to be heard on oral evidence the applicant must set the same down for hearing in the witness list, and in the case of an application directed to be heard on affidavit evidence the applicant must, after the times fixed for filing evidence have expired, set the same down for hearing in the non-witness list; the application so set down will be heard and disposed of in due course.

Where the Court allows a specification to be amended, the applicant must forthwith lodge with the Comptroller an office copy of the order allowing the amendment, and the Comptroller will advertise the same in the *Official Journal*. The applicant must also, if required by the Court, or by the Comptroller, leave at the Patent Office a new specification and drawings as amended.

Reference is made elsewhere to the subject of amendments other than by way of disclaimer during the pendency

of proceedings for revocation on appeal from a decision of the Comptroller. It would appear, therefore, that the exception limiting amendments to disclaimers refers only to cases in which proceedings for revocation are originated in the Court.

Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed, no damages will be given in any action in respect of the use of the invention before the amendment, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

The above provisions do not apply to amendments of a specification to avoid objections to which attention is drawn by the examiner, or to meet objections taken in opposition proceedings. On the other hand, an applicant whose specification is not yet accepted may desire to make an amendment which has not been required by the Comptroller: in the case of such a voluntary amendment (unless the amendment is simply the insertion of a disclaiming clause, or the excision of superfluous matter) the applicant is usually required to file a form bearing an impressed stamp of £1 10s., which may be regarded as a fee to meet the costs of the further examination rendered necessary by the amendment.

Similarly, within six months (or, with an extension, seven months) from the date of filing a provisional specification, an applicant who has already filed a complete specification may apply for leave to lodge a substitute complete specification which bears its own date and to which the stamp on the first complete specification may be transferred. In this case also, if the examination of the first complete specification is already in progress, the request must as a rule be made on a form bearing a stamp of £1 10s.

Before the sealing of a patent the application may be amended by adding or withdrawing the name of a co-applicant who is neither the inventor nor a joint inventor.

Unlike the two cases last mentioned, such an amendment is advertised for the purpose of giving an opportunity to interested parties to enter a notice of opposition. An opponent could only expect to succeed, however, who could show a personal right in respect of the patent to be granted which would be prejudicially affected by the inclusion or exclusion of the name of any co-applicant from the letters patent.

Amendment of the substance of a provisional specification is not provided for by the Act. Before the acceptance of the complete specification matter may be excised from the provisional specification, provided the excision does not have the effect of changing the meaning of what remains, and corrections may be made in nomenclature, *etc.*, to correspond with alterations required in the title or in the complete specification.

Even after the sealing of a patent it is permissible to amend the title. Such an amendment may be desirable for the purpose of bringing the title into conformity with the claims, but it leaves a discrepancy between the specification and the patent document which, if not legally objectionable, is apt to lead to confusion.

Mere clerical errors in or in connection with an application for a patent, or in any patent, or any specification, may be corrected at any time on request, and on payment of a fee of 5s., if the application is still pending, or of £1 if the patent is already sealed.

According to the practice before the Act of 1883 clerical errors in a specification could be corrected on application to the Master of the Rolls as keeper of the records, with the consent of the Law Officer. This jurisdiction of the Master of the Rolls, though still intact, has not been exercised for more than twenty years, but it might be revived with success were leave to make a desired correction refused by the Comptroller.

REVOCATION ON THE GROUNDS OF OPPOSITION.

In only a small proportion of cases is opposition made to the grant of a patent.

It may be, for instance, that the attention of a potential opponent is not drawn to an application until too late, or that the time is inauspicious for taking the offensive.

Under the Act of 1907 any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of such a person, may apply to the Comptroller for an order revoking the patent on any one or more of the grounds of opposition.¹

An application for revocation on any of these grounds may be made at any time within two years from the date of the patent; the rules as to the furnishing of evidence, *etc.*, in support of an opposition being applicable, *mutatis mutandis*, to the application for revocation.

When an action for infringement or proceeding for the revocation of the patent is pending in any Court, an application to the Comptroller can only be made with the leave of the Court. It is hardly likely, however, that a party who is already contesting the validity of the same patent will prefer to seek his remedy from the Comptroller, except in the case where only the limited grounds of objection are relied on, and then only after an arrangement is made for preventing duplication of costs. Conversely, if legal proceedings between the same parties are commenced after an applica-

¹ The four grounds of opposition are stated in full at pages 74 and 75.

tion for revocation has been made to the Comptroller, it will usually be more convenient for the parties to stay the proceedings on the application, and settle all the issues involved in a single action.

On receipt of an application for revocation the Comptroller notifies the patentee, and, after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification to be amended by disclaimer, correction or explanation, or dismissing the application. In no case, however, will the Comptroller make an order revoking a patent, unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant. As in the case of an opposition, the Comptroller may award to any party such costs as he considers reasonable, and direct how and by whom costs are to be paid.

Where a patent is revoked on the ground of fraud, the Comptroller may, on the application of the true inventor, grant to him a patent in lieu of and bearing the same date as the patent so revoked; but no action may be brought for any infringement of the later patent committed before the actual date when such patent was granted.

The decision of the Comptroller is subject to appeal to a Judge of the High Court.¹

An appeal to the Court must be brought by petition presented to the Court within one calendar month of the decision of the Comptroller or within such further time as the Comptroller may under special circumstances allow. The petition must state the nature of the decision appealed against, and whether the appeal is from the whole or part only, and if so, what part of the decision: it must also state concisely the grounds of the appeal, and no grounds other than those stated will, except with the leave of the Court to be given on such terms and conditions as may

¹ At the time of going to press a Bill is before Parliament explaining that the usual appeal is to be allowed from the decision of the Judge.

seem just, be allowed to be taken by the appellant at the hearing. The evidence used must be the same as that used at the hearing before the Comptroller, and no further evidence may be given, except by the leave of the Court on application to be made to the Court at or before the hearing.

In any such proceedings the Court will have all the powers vested in the Comptroller, and may make any order which might or ought to have been made by the Comptroller.

The costs of and incident to all proceedings before the Court, including the costs of hearings before the Comptroller, are in the discretion of the Court.

The effect of revocation is not the same as that of a judicial decision that a patent is invalid. In the latter case the decision holds good only between the patentee and the other party concerned; in the former case the decision affects the relations between the patentee and all the subjects.

In the absence of any agreement, however, a decision revoking a patent does not entitle licensees to recover royalties they may have paid to the patentee, nor does it entitle a defendant to an action for infringement that has been settled against him to a refund of damages or profits: the effect of revocation is, however, to dissolve any injunction against such a defendant.

SURRENDER OF LETTERS PATENT.

Heretofore, the owner of an invalid or worthless patent, the possession of which was inconvenient, or exposed him to the risk of litigation, could only disencumber himself of the burden by transferring his rights to a compliant friend or by omitting to pay a renewal fee when due.

The Act of 1907, besides simplifying the procedure for effecting revocation, provides for voluntary revocation on the offer of a patentee to surrender his patent.

The formal offer to surrender the patent is made by leaving at the Patent Office a notice stating the reasons for making the offer, and whether any and if so what action for infringement or proceeding for revocation of the patent is pending; and the offer so made is advertised by the Comptroller in the *Official Journal* and in such other manner, if any, as he deems desirable.

Notice of objection may be given by any person interested, and after hearing all parties who desire to be heard the Comptroller may, if he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

From the decision of the Comptroller appeal may be made to the Court, the appeal being conducted in the same way as an appeal from a decision of the Comptroller in an application for revocation, as referred to in the preceding chapter.

The fact that a patent has been surrendered is not necessarily an admission that the patent was invalid, nor does

it amount to acquiescence in acts of infringement committed while the patent was in force. On the contrary, the patentee may maintain an action for past infringement, and the action may be defended on the ground, *inter alia*, that the patent was invalid at the date of the infringement.

REVOCATION OF PATENTS WORKED OUTSIDE THE UNITED KINGDOM.

It is claimed for the Act of 1907 that it remedies an abuse long practised under the patent system of this country, particularly by foreigners who, instead of introducing new industries into the realm, found in their monopolies a means of shutting them out.

In almost all foreign countries patentees are required to 'work' their patents, that is, to exploit their inventions for the advancement of the industries of these countries within a limited period. In certain cases failure to work a patent automatically entails forfeiture of monopoly rights; in others it establishes a ground of objection which may be raised in revocation proceedings.

While opinion as to the expediency of such provisions is not unanimous, certain it is that to their presence in foreign legislation and the absence of as stringent provisions from our statute book many recognised authorities attribute the transference of British industries to foreign countries, and also the exclusion of foreign industries from this. On the other hand, it is argued that seldom is it the fault of the individual inventor that little or no progress is made in this country in an industry which continues to flourish abroad, and that the obligation to manufacture in all quarters of the world involves the dissipation of energy and retards invention.

The Act of 1907 represents a compromise, providing simple machinery for securing the revocation of obstructive patents, but relaxing the penalties against patentees who,

through no fault of their own, have been unable to work their patents themselves or to induce others to do so for them.

As provided by the Act, an application for revocation of an unworked patent may be made at any time not less than four years after the date of the patent. Such an application is addressed to the Comptroller on a form bearing an impressed stamp of £2, and alleging that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

A copy of such application is to be delivered to the patentee or his agent, who must within fourteen days, or such further time as the Comptroller may allow, leave at the Patent Office evidence, by way of statutory declaration, stating whether or not the allegations contained in the application are correct; and, if they are incorrect, to what extent, and in what place the patented article or process is manufactured or carried on in the United Kingdom; and, in the event of the article or process not being manufactured or carried on in the United Kingdom to an adequate extent, setting out the reasons why. Copies of such evidence are to be delivered to the applicant.

Within fourteen days or such further time as the Comptroller may allow, the applicant must, if he decides to proceed with his application, leave at the Office statutory declarations in answer, copies of which he must deliver to the patentee or his agent.

No further evidence may be left at the Office on either side except by leave, or on the requisition of the Comptroller, and upon such terms, if any, as the Comptroller may think fit.

On completion of the evidence the Comptroller appoints a time for the hearing of the case, and gives the parties ten days' notice at least of such appointment. In the event of his deciding to take evidence *viva voce* in lieu of or in addition to the evidence by declaration, or to allow any declarant to be cross-examined on his declaration, he may

require the attendance of any declarant or other person, whose evidence he considers desirable.

If the Comptroller is satisfied that the allegations contained in the application are correct, and if the patentee fails to prove that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or to give satisfactory reasons why the article or process is not so manufactured or carried on, the Comptroller may make an order revoking the patent either (a) forthwith, or (b) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent.

Authoritative statements made in and out of Parliament expose the policy of the legislature, although the language of the Act is not free from ambiguity. It is evident, however, that the Act does not seek to penalise every patentee whose invention is practised exclusively or mainly outside the United Kingdom as, for instance, when the total of the world's production exceeds that of this country; but is intended to hit the patentee who, practising his invention abroad, neglects to practise it in this country to an extent sufficient to meet a reasonable demand, or, if he does aim at meeting the demand, does so with imported goods.

In short, the Act ensures that the market for an invention in this country will only be reserved to the patentee who supplies that market with British-made goods, thus giving employment to our wage-earners, who will be so far instructed in the use of the invention as to be able to work it for themselves or for others on the expiry of the patent.

The details of the procedure under this part of the Act are of minor importance; the mere presence of such a provision in the Act being practically sufficient in itself to remove the cause of complaint, by inducing foreign patentees to manufacture in this country what it was their former custom to import.

In the absence of any judicial decisions on the point, answers may be suggested to various questions asked particularly by foreign patentees: for instance, as to the time limit within which working must take place, the minimum extent of working that will satisfy the requirements, and the conditions on which failure to comply with the requirements may be excused.

It is not necessary that the effective working of the patent should take place within four years. If the application for revocation is made more than four years from the date of the patent, it will suffice to vindicate the patentee if he can prove that he has, before the application is made, taken the necessary steps to comply with the law. The Comptroller may even take into account the actions of the patentee after the application is made.

Conversely, it is no defence to an application for revocation, that, within the period of four years from the date of the patent or any time thereafter, the patentee commenced the manufacture in this country, when such manufacture has been discontinued afterwards, notwithstanding that the patented article or patented process is manufactured or carried on abroad. In a doubtful case, however, where the patentee adduces reasons for his default, regard may be had to the conduct of the patentee throughout the life of his patent.

What is 'working to an adequate extent' is a question to be answered by the Comptroller on the evidence supplied by the parties concerned. The Comptroller may be expected, however, to regard not so much the interests of the patentee compared with those of the applicant as the interests of the patentee contrasted with those of the public.

Working is certainly adequate if the demand for the invention in this country is met by manufacture here.

It is only necessary to 'work' what is actually patented. Thus, if the patent is for a process, it is immaterial that the apparatus for performing the process is imported, whereas, if the invention consists in a product, it does not

signify that the materials of which it is made are brought here from abroad. Similarly, if the patent is for a part of a machine, it may suffice to manufacture and use that part in this country.

Again, if an invention exists in a number of forms serving the same purpose, whether all these are claimed or not, there is no necessity to manufacture all of them, or indeed any other than that best suited to satisfy the demand. Similarly, if the patentee possesses a number of patents, for instance both a main patent and a patent of addition, working of the later patent will suffice to maintain the prior patent, if the later invention also includes the essential elements of the other. On the other hand, the practice of the prior invention may not of itself constitute working of the later patent.

If an invention is applicable to a number of industries, then, theoretically, the patentee is bound to give the same attention to each. Practically, however, the actions of the patentee should be considered collectively, and if in fact he has rendered substantial service by what he has done, and no one is seriously injured by his omission or failure to do more, there is little likelihood of an order being made for revocation. In any case the objection might be met by the grant of a licence to the applicant, or by amendment of the specification so as to disclaim the matter under dispute.

The postulate that the patentee shall at least give satisfactory reasons for his default renders it possible in certain circumstances to reject the application for revocation, as, for instance, in the case where the patentee has been obliged to install complicated machinery before manufacturing on a commercial scale, or where the patentee has been hampered by difficulties in obtaining skilled labour, by the high cost or absence of raw materials, or by the impossibility of avoiding infringement of previous patents under which no licence was obtainable.

It is for the patentee to see that the manufacture takes

place; if his own resources permit him to carry on the manufacture, he cannot rely solely on the circumstance that he has received no support from others.

Merely to advertise the invention for sale or to offer licences is not 'working' to an adequate extent in any case. However, if British manufacturers decline all offers of licences and the failure to introduce the invention into this country is due to the want of interest in the invention shown by the British industry, despite the efforts of the patentee to arouse such an interest, the patentee might be held to show a sufficient excuse for his inaction in circumstances which would make the establishment of the manufacture an unprofitable burden. In such a case, however, it will be for the patentee who has imported the product of his manufacture into this country to justify his failure to contract with native manufacturers to execute orders on his behalf.

As regards the extent of working, the patentee may plead that the invention has been worked in infringement of his rights by unauthorised parties, provided that he has endeavoured to enforce his rights against these parties and put them in the position of licensees; at the same time the patentee must show that he has himself endeavoured to exploit the invention in this country.

The Act makes an apparent exception in favour of certain patentees in declaring that no order for revocation will be made which is at variance with any treaty, convention, arrangement or engagement with any foreign country or British possession. . No treaty dealing with this question has yet been made with any foreign state other than the International Convention, which provides that the revocation of a patent on account of failure to exploit the same shall take place only when the patentee has no excuse for his default.

Although the Act refers to the relations between this country and other states, nevertheless it must so far harmonise with the Convention that the same conditions will

be applied to the subjects or citizens of foreign states and to British subjects.

In every case, therefore, the precedent to revocation is culpable neglect on the part of the patentee to observe the conditions imposed by the Act.

Where there has been neglect for which the patentee is not personally responsible, such as, for instance, neglect by a former proprietor of the patent, and the patentee satisfies the Comptroller that he is in earnest in his endeavour to start the manufacture in this country, it is probable that the Comptroller will adopt the more generous course of ordering revocation only in case the manufacture is not started within a period specified in the order.

If, within the time limited in the order, the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the Comptroller may extend the period mentioned in the previous order for a term not exceeding twelve months.

Any decision of the Comptroller on an application for revocation on the above grounds is subject to appeal to a Judge of the High Court specially selected by the Lord Chancellor, and on any such appeal the Law Officer or such other counsel as he may appoint will be entitled to appear and be heard.

As provided by the Rules of the Supreme Court, any such appeal must be brought by petition presented to the Court within one calendar month of the decision of the Comptroller or within such further time as the Comptroller may under special circumstances allow. Each such petition must state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision. It must also state concisely the grounds of the appeal, and no grounds other than those so stated will, except with the leave of the Court to be given on such terms and conditions as may seem just, be

allowed to be taken by the appellant at the hearing. The evidence used must be the same as that used at the hearing before the Comptroller, and no further evidence may be given, except by leave of the Court on application to be made to the Court at or before the hearing.

In such proceedings the Court has all the powers vested in the Comptroller, and may make any order which might, or ought to, have been made by the Comptroller. The costs of and incident to the proceedings before the Court, including the costs of hearings before the Comptroller, are in the discretion of the Court.

The decision of the Judge hearing the appeal is final.

INFRINGEMENT.

During the term of a patent the Crown forbids the making, vending, using, exercising, or putting into practice of the patented invention, within the United Kingdom or Isle of Man, without the sanction of the patentee. The illicit doing of any of these things is termed infringement, the right of pursuing which and obtaining a just recompense is the corollary of the privilege awarded to a patentee.

In considering whether there is any ground for an action against a supposed offender there are three questions to be answered, *viz.* (1) whether the doing of that person is one of the acts forbidden by the patent, (2) what is the invention patented, assuming that the patent is a valid one, and (3) whether, in fact, the patented invention has been taken, or some other.

Among the acts forbidden by the patent are :—unauthorised manufacture or use in this country, whether personal or commercial, of a patented article or of the product of a patented process or of a patented machine; importation, sale or offering for sale, or possession with a view to sale, of such an article or product; or breach of a condition known to be attached to the use of, or traffic in, the invention which is not null and void as being in restraint of trade or contrary to public policy. Whether the doing of the defendant has been discontinued or not is immaterial; an injunction may even be obtained against a person threatening and intending, if not prevented, to use a patented invention, although he has not in fact used it,

The following are not actionable:—Resale of an article purchased from the patentee or from one authorised to sell; mere experimental use; manufacture at the instance of the patentee or his agent; manufacture or sale of materials not separately patented, even with the knowledge that they will be used for the purposes of infringement; contracting for delivery abroad; use in a British vessel outside territorial waters; or use in a foreign vessel in British waters when not in connexion with the manufacture or preparation of anything intended to be sold in or exported from this country (except in the case of a vessel of a foreign state which denies corresponding privileges to British vessels).¹

As to repairs of a patented article not covered by any agreement with the patentee, it is always a question of fact whether the act of repair is a renewal of the essential parts: if the result of the repair is a new article, there is infringement. Similarly, the alteration of an old article or machine so as to constitute a newly patented combination is as much an infringement as the construction of a new article or machine.

The patent forbids partial infringement as well as total infringement; it is no more lawful to take part of a man's property than to take the whole. On the other hand, it does not follow that because something has been borrowed from a patent that there has been an usurpation of the subject of the patent itself. Besides the subject matter which constitutes the invention, a patent may contain common elements, unessential details, only referred to in order better to explain the intention of the patentee: moreover patents as now granted refer without exception, it may be said, to combinations of elements which, taken individually, belong to the public domain. In such a case what does the imitation of this or that detail matter, if it is not this that constitutes the private right of the patentee? In judging infringement, therefore, one must ask, not

¹ The statutory exception in respect of user in a foreign vessel does not apply to vehicles passing through this country.

'is the thing said to be infringed in the patent,' but 'is it the subject of the patent, that is, is it claimed as being itself an invention?'

The same rule applies whether the invention be a process, machine, article of manufacture, or composition of matter. Thus, a claim for a process is infringed by practice of the same process even with the aid of different apparatus from that described by the patentee: conversely, a claim for a product may be infringed by making, using or vending the same product made in another way.

A charge of infringement cannot be averted on the pretext that the invention has been more or less modified or transformed, if the essential parts which together constitute the invention, or, rather, the substance of the invention, be taken. As a rule, indeed, the differences which can be distinguished between a patented manufacture and its counterfeit serve no other purpose than to mask the infringement. It is, therefore, a good rule in judging infringement to look at the points of resemblance rather than the points of difference. Conversely, it matters little that an alleged infringement might, by a simple modification, replace the patented invention: if, in fact, it is different, there is no infringement.

To compare the patented invention with the infringing manufacture it is necessary first to construe the patentee's specification, whereupon the reader can also determine the relation of the patented invention to alleged anticipations.

Every specification which is intelligible is capable of being so construed as to permit a count to be taken of the parts or elements comprised in the subject of each claim, whether the claims are drawn to recite combinations or not. The reader, having summed up the features of the defendant's manufacture in the same way, may thereupon test the question of infringement approximately with the aid of the following rules:—

Addition to a patented combination or sum of parts does not avoid infringement, whether the addition improves the

function of the combination or the reverse: but if the patented combination differs from an older combination only in the omission of one element of the latter, the restoration of the older combination by adding that element is quite legitimate.

Changing the relative positions, orders, or proportions of the elements of a combination does not avert infringement, where the parts changed or transposed perform the same respective functions after the change as before: but infringement is averted by a change which so alters the functions of the parts that the combination acquires a substantially different mode of operation.

Omission of an essential part or element of a combination without the substitution of an equivalent averts any charge of infringement of a claim for that combination: the term essential being used in the sense 'material for the success of the combination.' Infringement is not avoided, however, by omitting subsidiary elements, or by uniting two elements into one integral part, if the united part performs the same function in substantially the same way as did the separate elements before the union.

Infringement is not avoided by omitting an optional element of a patented combination and substituting an equivalent, *i.e.*, an element performing the same function in substantially the same way. This statement is true of all patents, it being understood that the latitude allowed in determining the question of equivalence and implied by the word 'substantial' depends on the construction of the specification, and the classification of the subject matter among those that are termed primary inventions and those termed secondary inventions. In the case of a primary invention, *i.e.*, one which performs a function never performed by an earlier invention, and forming the subject of a primary-patent or master-patent, the word 'substantial' condones much more important differences than in the case of a secondary invention, *i.e.*, one which performs a function previously performed by an earlier invention, but in a different way. To use a different illustration, in the

case of a patent narrowed in construction by an extensive state of the prior art, the word 'substantial' gives little elasticity to the application of the doctrine of equivalence; if fewer inventions preceded the one in issue, the word 'substantial' has more carrying power: in the case of an invention that is strictly primary, the word 'substantial' covers differences alike numerous and important. Even in the last case, however, it is important to observe the distinction between essential and subsidiary elements of a combination. For an essential element, *i.e.*, essential from the point of view of construction, there is no equivalent; for a subsidiary element there may be many.

One fundamental rule underlies all the cases, however, and that is:—In order to make out infringement, it must be established, to the satisfaction of the Court, that the alleged infringer dealing with what he is doing as a matter of substance, is taking substantially the invention claimed by the patentee; not the invention which the patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification.

As a rule, what would anticipate if earlier infringes if later. This formula is too general, however, because, according to the amount of previous knowledge attributable to the patentee and his readers, a specification may be capable of either a broad or a narrow interpretation, and because a patentee may insert limiting words in his claims which exclude later employment, but do not exclude earlier employment of the subject matter in other ways, *i.e.*, which negative infringement but do not avert anticipation. Thus, it happens occasionally in an action for infringement, when the defendant quotes prior publications as showing the antiquity of the patented invention, that the patentee finds himself in an awkward dilemma. On the one hand, if he claims for a broad interpretation his invention is anticipated: on the other hand, if he claims for a narrower interpretation the acts of the defendant may not be held an infringement, so that, on

either construction, he must fail in the action, unless he succeeds in making a suitable amendment of his specification.

The onus of proving infringement rests in every case on the patentee: for this reason, if for none other, a patentee will be wise, however satisfied he may be of the extent of his claim, to submit his case to the unbiassed judgment of a third party having experience in weighing and comparing inventions. It is our duty as patent agents to advise clients as to what does or does not constitute infringement of their legal rights, and also, in the other case, to report to clients anxious to avoid litigation whether what they are doing, or propose to do, amounts to an infringement of any patent. It is necessary to add, however, that the circumstances which decide the issue in an infringement suit are often only fully disclosed in the course of the action, whereas opinions are only stated on the facts submitted to or ascertained by us.

THE ACTION FOR INFRINGEMENT.

DEFENCES.

The patentee who considers that his monopoly is being encroached upon or fears that it will be encroached upon will be wise to seek advice before rushing into litigation.

Only when the novelty of his invention has been proved by an exhaustive search, and the sufficiency of his specification confirmed, has the patentee taken ordinary precautions to ensure that an action will not be promptly dismissed with costs. On the other hand, a preliminary investigation of his case by an expert will inform the patentee what likelihood there is of the patent being sustained and of the defendant being held an infringer, or whether amendment is necessary before the patent can be taken into Court.

Similarly, any person threatened with an infringement action should at once take steps to ascertain what openings there are for attack on the validity of the patent, or, alternatively, what grounds lie for requiring a narrow construction to be put on the specification.

If satisfied that his legitimate rights are invaded the patentee should preferably notify the infringer in the first place so as to give him an opportunity of coming to terms, and, if the infringer declines to submit, should thereupon issue the writ.

There is no obligation to notify an infringer before commencing an action, but such a step is desirable, more particularly in the case of a patent granted after 1st January, 1908; the Act of 1907, though not affecting any

proceedings for an injunction, providing that a patentee will not be entitled to recover any damages in respect of a patent granted after that date from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware of the existence of the patent.

The Court before which the action is tried is the High Court of Justice in England or Ireland; or, in Scotland, the Sheriff Court, or the Court of Session. The jurisdiction of the Courts in the Isle of Man in proceedings for infringement is not affected by the Act.

Since the vast majority of patent actions are brought in the High Court of Justice in England, it will be more convenient to follow here the Rules of the Supreme Court.

Preferably, all parties claiming an interest in the patent or patents alleged to be infringed should be made plaintiffs. Any infringer may be made a defendant. The manufacturer should be sued in preference to the retailer, but the manufacturer of an infringing article and purchasers from him may be made defendants in the same action.

The writ is usually endorsed for an injunction, an account of profits or damages, and delivery up or destruction of the infringing articles.

Where a *prima facie* case of infringement is made out, and there is a presumption in favour of the validity of the patent, an interim injunction may be granted. A presumption in favour of the validity of the patent arises when the validity of the patent has been supported in previous litigation, or when the patentee has been in long and undisturbed enjoyment of it. But an interlocutory injunction will be refused if the plaintiff has been guilty of laches, or has acquiesced in the defendant's acts. The convenience or inconvenience to the parties will also be considered, and, though an injunction will not be granted if it would cause serious injury to the defendant and no direct benefit to the plaintiff, the Court will, in such a case, require the defendant to give an undertaking to keep an account.

The plaintiff, in turn, is usually required to give an undertaking to abide by such order as the Court may make as to damages should it turn out that an injunction should not have been granted.

If the defendant submits on the trial of the action proper, and undertakes not to repeat the infringement, the plaintiff may still insist on an injunction being issued.

If the defendant makes default in delivering a defence, the plaintiff may set down the action on motion for judgment.

The defendant may, however, deny infringement, or if not estopped, he may plead that the patent alleged to be infringed is invalid and therefore untenable, or he may avail himself of both grounds of defence. He may also plead that the plaintiff has no title to the patent sued upon, or allege that he was not aware and had no reasonable means of making himself aware of the existence of the patent, or that the infringement was committed prior to amendment of the specification and that the original claim was not framed in good faith or with reasonable skill and knowledge, or again, that the infringement was committed after failure to pay a renewal fee within the prescribed time and before any enlargement thereof, or that he is privileged to use the invention by virtue of rights acquired after the patent was advertised as void in the *Official Journal* and before its restoration.

It is immaterial that the patent may have lapsed before the date of the action; but if the alleged infringement took place more than six years before the date of the suit, the defendant may plead the Statute of Limitations.

It is no defence that the defendant had no intention to infringe or that the defendant himself devised his process or manufacture independently of the patent.

If entitled to present a petition to the Court for revocation of the patent (see pages 163 and 164) the defendant may, without presenting such a petition, apply by way of counterclaim in the action for the revocation of the patent.

The list of objections to a patent may be expanded indefinitely by detailing the various items: the following is a fairly complete list:—

- (1) That the patentee was not the true and first inventor of the invention claimed.
- (2) That the alleged invention was not any manner of manufacture.
- (3) That the alleged invention was not new.
- (4) That the subject of the claims involved no exercise of inventive ingenuity.
- (5) That the alleged invention was not useful.
- (6) That the use of the alleged invention was contrary to law or morality.
- (7) That the alleged invention was used before the date of the patent.
- (8) That there had been a prior grant of the monopoly claimed.
- (9) That the patent was obtained in fraud of the rights of the defendant.
- (10) That the complete specification did not particularly describe and ascertain the nature of the invention.
- (11) That the complete specification did not particularly describe and ascertain the manner in which the invention was to be performed.
- (12) That the complete specification described or claimed an invention other than that described in the provisional specification, and that such other invention formed the subject of an application made by the defendant in the interval between the leaving of the provisional specification and the leaving of the complete specification.
- (13) That the Crown was deceived in its grant.
- (14) That the reasonable requirements of the public with respect to the patented invention have not been satisfied.

- (15) That the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom, and
- (16) That the patentee has inserted a condition in a contract which is still in force in relation to the sale or lease of, or licence to work the patented invention, which, being in restraint of trade or contrary to public policy, is null and void.

To establish the invalidity of the patent it is not necessary to show that every claim, or even that the claim alleged to be infringed is invalid. The consideration for the grant being entire, if even a single claim fails, the patent is void.

During the action, however, the patentee may apply for leave to amend his specification by disclaimer and the Court may grant such leave; terms being usually imposed, however, to protect the defendant from the consequences of infringement prior to the amendment.

The plaintiff must deliver with his statement of claim particulars of the breaches relied upon; such particulars must specify which of the claims in the specification of the patent sued upon are alleged to be infringed, and must give at least one instance of each type of infringement of which complaint is made.

The defendant, if he disputes the validity of the patent, must deliver with his defence particulars of the objections on which he relies in support of such invalidity. A defendant who counterclaims in the action for the revocation of the patent must with his counterclaim deliver particulars of any objection to the validity of the patent on which he relies in support of his counterclaim.

Particulars of objections must state every ground on which the validity of the patent is disputed, and must give such particulars as will clearly define every issue which it is intended to raise. If it is alleged that the invention has been used prior to the patent of the plaintiff, the particulars of objections must be accompanied by a statement in

writing giving the date and place of such prior use and the persons who are alleged to have made such prior use, and stating whether the alleged prior use was continued down to the date of the letters patent, and if not giving the earliest and latest dates on which such prior use is alleged to have taken place. The statement must also furnish a description (accompanied by drawings if necessary) sufficient to clearly identify the alleged prior use; if the alleged prior use relates to any machinery or apparatus, the statement must specify whether the same is in existence and where it can be inspected. No evidence at variance with such statement will be receivable in support of such alleged prior use, and no evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent and which is in existence at the date of the delivery of the particulars of objections will be receivable unless the defendant proves that, if in his own possession he offered inspection of the same, and, if not in his possession, that he used his best endeavours to obtain inspection of the same for the other parties to the proceedings.

If the defendant intends to rely as a defence on the insertion by the patentee in any contract or contracts of any condition which is null and void, he must deliver with his defence full particulars of the dates of and parties to all contracts on which he intends to rely as containing any such condition, and of the particular conditions in any such contract on which he intends to rely as being null and void, and save as appears from such particulars no defence will be available to him on this ground.

Particulars of breaches and particulars of objections may from time to time be amended by leave of the Court upon such terms as may be just.

Further and better particulars of breaches or particulars of objections may also at any time be ordered by the Court.

Either party may seek for further information by means of interrogatories. The Court may also, on the application of either party, make such order for an inspection, and

impose such terms and give such directions respecting the same and the proceedings thereon as the Court may see fit.

At the hearing of the action or counterclaim no evidence will, except by leave of the Court (to be given up on such terms as to the Court may seem just), be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively.

The trial of the infringement action is conducted in much the same manner as any other action without a jury. In exceptional circumstances, however, the Court may direct the action to be tried before a jury. It may also, if it thinks fit, and must on the request of either of the parties, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance.

The testimony of experts generally constitutes the main bulk of the evidence. Expert evidence is admissible to explain technical terms, to show the practical working of machinery described or drawn, to indicate what is old and what is new in the specification, to point out in what respects the invention has been or has not been used by the defendant, and to say what are and what are not equivalents.

But the construction of documents, including specifications, and the determination of the question of infringement are matters for the Court only.

In the event of the Court deciding that there is no infringement or that the patent is invalid the action will be dismissed.

If the plaintiff is successful he will be entitled to a perpetual injunction, delivery up or destruction of the infringing articles and damages or an account of profits.¹

The costs of and incident to all proceedings before the Court are in the discretion of the Court.

¹See pages 151 and 152 as to the exemption of innocent infringers from liability for damages.

On taxation of costs, if the action or counterclaim proceeds to trial on any patent, no costs will be allowed in respect of any issues raised in the particulars of breaches or particulars of objections and relating to that patent to the parties delivering the same respectively, except in so far as such particulars are certified by the Court to have been proven or to have been reasonable and proper without regard to the general costs of the case, but subject as aforesaid the costs of the issues raised by the particulars of breaches and particulars of objections will be in the discretion of the Taxing Master.

Should a defendant commit any breach of the injunction, the plaintiff may move for committal for contempt, and, in the case of a body corporate, for the sequestration of the goods of the defendant company and committal of the directors.

In the infringement action the Court may certify that the validity of the patent came in question, and, if the Court so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, will have his full costs, charges and expenses as between solicitor and client, unless the Court trying the action otherwise directs.

Either party may, within three months, appeal to the Court of Appeal,¹ from the whole or part of any judgment or order, the appeal being taken as a re-hearing.

The Court of Appeal may, if they think fit, call in the aid of an assessor and try the case wholly or partially with his assistance.

Such deposit or other security for costs must be made or given by the appellant as may be directed under special circumstances by the Court of Appeal.

Fresh evidence may be admitted by the Court of Appeal, but leave to give such evidence is seldom granted. In any

¹ Appeals in Scotland follow the usual rules for such cases.

case it must be evidence not known or available to the appellant at the trial below.

From the decision of the Court of Appeal an appeal may be made to the House of Lords within one year. The decision of the House of Lords is final.

REMEDY FOR THREATS.

Until the passing of the Act of 1883 a patentee might issue threats of legal proceedings broadcast, and, so long as the threats were made *bonâ fide*, incurred no liability for any damages which might result. The only remedy available to a person injured by the threats was an application to the Court for an injunction to restrain the continuance of such threats, and in this the plaintiff could only succeed on showing that the statements made by the patentee were untrue, so that the issue of further threats would not be *bonâ fide*. Only in the case of malicious threats damages might be recovered from a patentee, on proof that the threats amounted to a malicious attempt by the patentee to injure the plaintiff by asserting a claim of right against his own knowledge that such a claim was without foundation.

The Act of 1883 provided a surer remedy for the hardship which might befall a man whose business was brought to a standstill by the threats of a patentee without his having a fair opportunity of submitting the question to the test.

Similarly, the Act of 1907 provides that where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making the threats.

The statutory remedy is not available, however, if the person making the threats with due diligence commences and prosecutes an action for infringement of his patent.

The law intends that threats of patent actions shall not hang over a man's head; that the sword of Damocles in such a case should either not be suspended or should fall at once. Accordingly, a patentee must not threaten legal proceedings unless his legal right is infringed, or unless he is about to bring an action forthwith to justify his threats. If he cannot bring himself within one of these two saving clauses, then the law forbids him threatening legal proceedings at all, and it is *nihil ad rem* to say that what he did was *bond fide*.

As a matter of law, anything said or anything written by a person, if it is for the purpose of intimating that his patent is being infringed by some other person and that this is actionable, is in the nature of a threat. A patentee is not prevented, however, from giving a general warning to the public, from saying what the patent itself implies—that anyone who infringes does so at his peril; that is merely saying what everybody knows.

The right of action conferred by the Act is given to any person aggrieved. To constitute a party as a person aggrieved it is not necessary that the threat be addressed to him: the threat may have been addressed to his agents or customers or to his licensees or persons manufacturing for him.

The plaintiff in an action for groundless threats should allege (a) the threats; (b) that he has not infringed; and (c) if he thinks such is the case, that the defendant's patent is invalid.

The defendant may (d) deny the issue of threats, (e) allege that the plaintiff has in fact infringed, and (f) that he has with due diligence commenced and prosecuted or is prosecuting an action for infringement.

If the patentee bases his defence on infringement, he

must prove the infringement either in the action for threats, or in a separate action. For the defence that an action for infringement has been brought it is not necessary that the action should be brought after the action for threats; it may be brought before. Nor need the action be brought against the person aggrieved so long as it is an action in respect of the infringement which gave rise to the threats; it must, however, be a *bonâ fide* action commensurate in scope with the threats and not a collusive action brought for the purpose of evading the terms of the Act under cover of a mere technicality.

What is 'due diligence' in bringing an action for infringement depends entirely on the circumstances of the case. The term is elastic enough to allow a patentee a reasonable time to prepare his case after the issue of threats. The diligence required in prosecuting the action is not such as to oblige the patentee to go on with a hopeless suit; after prosecuting the infringement action to a point at which he recognises its futility he may drop that action, upon the usual terms as to costs and otherwise. He has brought himself within the saving clause of the Act in regard to the statutory remedy and then the law as it stood before the Act of 1883 applies.

The trial of the action for threats proceeds much in the same way as an ordinary action for infringement, and the usual considerations to be taken into account in ordering an injunction, whether interlocutory or perpetual, and in awarding damages and costs are observed.

The latter may well exceed the value of the patent alleged to be infringed, and the result of making rash threats may be such as to overwhelm the patentee. On the other hand, if his patent is valid, and the threatened party has in fact infringed, an action to restrain the threats is bound to fail, while the patentee may sue for infringement or not, as he pleases, biding his own time and finally selecting an infringer worth powder and shot.

REVOCATION BY THE COURT.

Although a patent may be of doubtful validity, it may, in the hands of the patentee, be a powerful lever to extort royalties or to deter peacefully minded traders from competing with his manufacture.

Such a patent may be put an end to by an order for revocation.

Each of the provisions regarding orders for revocation discussed in previous chapters contains a time limit.

The Act also calls for revocation of a patent on a petition to the Court which may be presented at any time after the sealing of the patent.

The petitioner may rely on any of the grounds available by way of defence to an action for infringement enumerated at pages 154 and 155.

A petition for revocation may be presented

- (1) by the Attorney General or any person authorised by him; or
- (2) by any person alleging (a) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or (b) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee; or (c) that he, or any person under or through whom he claims an interest in any trade, business or manufacture, had publicly manufactured, used, or sold, within this realm,

before the date of the patent, anything claimed by the patentee as his invention.

In England the petition is referred to a Judge selected by the Lord Chancellor: and in Ireland to any Judge of the High Court.

Proceedings for revocation of a patent in Scotland are in the form of an action of reduction at the instance of the Lord Advocate, or of a party having interest with his concurrence.

According to the Chancery practice, if the petitioner is not qualified to present his petition under the sub-heads (a), (b), or (c), he must obtain the fiat of the Attorney General authorising the presentation of his petition. A person entitled to present a petition on any one of the grounds (a), (b) or (c) may dispense with the fiat, but if he intends also to rely on other grounds of objection he is advised to obtain the fiat, lest he should fail to make out his case on the special ground relied on to establish *locus standi*.

To obtain the fiat of the Attorney-General it is necessary to lodge the following papers at the Royal Courts of Justice: (1) A memorial to the Attorney-General setting forth all the facts of the case, and ending with a prayer in the usual form. (2) A statutory declaration verifying the allegations in the memorial, and declaring, if such is the fact, that there are no proceedings pending in the United Kingdom in which the validity of the patent in question is or can be raised; if proceedings are pending, the memorial should state what these are, and why it is desired to present the petition. (3) A certificate by counsel that the petition and particulars of objection are proper for the allowance of the Attorney-General. (4) A certificate of a solicitor that the petitioner is a fit person to bring the petition and is competent to answer all the costs of the proposed petition. (5) Two copies of the proposed petition. (6) Two copies of the particulars of objection. (7) One copy of each of the specifications and other documents referred to.

A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for revocation of that patent, may, without presenting such a petition, apply for revocation by way of counterclaim.

The conduct of the proceedings in a petition for revocation is on the same lines as in an action for infringement; all persons beneficially interested in the patent at the date of the presentation of the petition being made respondents.

* As provided by the Rules of the Supreme Court, the petitioner must deliver with his petition particulars of the objections to the validity of the patent on which he means to rely, and no evidence will, except by leave of the Court, be admitted in proof of any objection of which particulars are not so delivered.

The provisions as to such particulars referred to in the chapter relating to proceedings in infringement actions also apply to particulars given in an action for revocation.

On the hearing of the petition the respondent is entitled to begin and give evidence in support of the patent, and if the petitioner gives evidence impeaching the validity of the patent the respondent will be entitled to reply.

When a patent is held invalid on account of partial failure of the consideration, the Court may allow the patentee to amend his specification by way of disclaimer, subject to such terms as to costs, advertisement or otherwise, as the Court may think fit. If the Court is satisfied, however, that no such amendment will make the patent good, the patent will be revoked.

Where a patent has been revoked on the ground of fraud, the Comptroller may, on the application of the true inventor, grant to him a patent in lieu of and bearing the same date as the patent so revoked; but no action may be brought for any infringement of the patent so granted committed before the actual date of the subsequent grant.

Although the Comptroller and the Law Officer have no

jurisdiction to consider allegations of fraud committed abroad, the Court certainly has such jurisdiction and can hardly be expected to countenance an evident fraud wherever committed.

No petition lies for revocation of a secret patent assigned to the Secretary for War or the Admiralty.

THE CROWN.

The letters patent contain a proviso that the grant shall determine and become void if the patentee shall not supply or cause to be supplied at and upon reasonable prices and terms for His Majesty's service all such articles of the patented invention as may be required by the officers or commissioners administering any department of the service of the Crown.

The Act further provides that a patent shall have to all intents the like effect as against His Majesty the King as it has against a subject: but that any Government department may, by themselves, their agents, contractors, or others at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after such use, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested.

The Treasury does not consider itself in a position to determine the validity or invalidity of a patent, and, in case of disagreement between the authorities and a patentee, may arrange with the patentee for an action to be brought against an officer nominated by the department concerned in the alleged infringement, and to make a suitable payment in lieu of royalty to the patentee if he is successful. Failing such an arrangement, the patentee may seek his remedy by a petition of right and so bring the Crown into Court as a defendant to an action for infringement.

As against an officer in the public service or a Government contractor who uses a patented invention for other purposes than for the services of the Crown an action for infringement will lie in the usual way.

EXTENSION OF THE PATENT TERM.

Sometimes it happens that the returns derived from a monopoly during the period of fourteen years provide a very inadequate compensation to the patentee whose invention will become public property at the end of the term. It is not seldom the fate of a patentee that success comes late, too late to leave him time to reap the profits he has deserved. Again, it may be that circumstances beyond his control have lost for him valuable time during which business connected with the invention has slackened.

In such a case the patentee may, at least six months before the time limited for the expiration of the patent, present a petition to the Court praying that his patent may be extended for a further term.

A petition for the extension of the term of a patent is to be presented to a Judge of the High Court, whose decision is final.¹

As provided by the Rules of the Supreme Court, a party intending to apply by petition for an extension of the term of a patent must give public notice by advertising three times in the *London Gazette* and once at least in a London daily newspaper.

If the applicant's principal place of business is situated in the United Kingdom at a distance of 15 miles or more from Charing Cross, he must also advertise once at least in some local newspaper published or circulating in the

¹ In Scotland the proceedings are taken before the Lord Ordinary of the Court of Session, and the proceedings are conducted according to the forms of process of the Scotch Courts.

town or district in which such place of business is situated; or if he has no place of business, then if he carries on the manufacture of anything made under his specification at a distance of 15 miles or more from Charing Cross, he must advertise once at least in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business and carries on no such manufacture, then if he resides at a distance of 50 miles or more from Charing Cross, he must advertise once at least in some newspaper published or circulating in the town or district where he resides.

The advertisements must state the object of his petition and must give notice of the day (which if the Court is for the time being a Judge of the Chancery Division shall be an ordinary petition day) on which he intends to apply to the Court for a day to be fixed before which the petition shall not be in the paper for hearing (called "the appointed day"); such day for applying to the Court must not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. A copy of such advertisement must be forwarded by the applicant to the Solicitor to the Board of Trade at the same time as the first advertisement is sent to the *London Gazette*, and the Board of Trade will thereupon cause the advertisement to be inserted in the three following issues of the *Illustrated Official Journal (Patents)*.

The petition must be presented within one week from the publication of the last of the advertisements required to be published in the *London Gazette*, and a copy of the petition must within the same time be furnished to the Solicitor to the Board of Trade. The petition must be accompanied by an affidavit or affidavits of advertisements having been duly published by the petitioner; the statements contained in such affidavit or affidavits may be disputed upon the hearing.

Upon the day named in the advertisements the petition will appear in the Court list, and the petitioner must apply to the Court to fix the appointed day above referred to,

of which the petitioner must give public notice by advertising once at least in the *London Gazette*.

Not less than three weeks before the date for the hearing of the petition the petitioner must lodge at the Judge's chambers two copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Court at the hearing. He must also at the same time furnish three copies of the specification of his patent and of the balance sheet to the Solicitor to the Board of Trade, and must upon receiving two days' notice give the Solicitor to the Board, or any person deputed by him for the purpose, reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the balance sheet or from which the materials for making up the balance sheet have been taken.

Any person desirous of opposing the prayer of a petition may lodge notice of opposition at the Judge's chambers, and at the same time serve upon the petitioner a copy of the notice. Such notices must be lodged and served before the day named in the petitioner's advertisements as that on which he intends to apply to the Court for the appointed day to be fixed.

The petitioner must forthwith on receipt of such notice serve a copy of his petition upon the opponent.

An opponent must within three weeks after service of the petition upon him lodge at the Judge's chambers two copies and serve upon the petitioner one copy, and lodge with the Solicitor to the Board of Trade three copies in writing of particulars of the objections upon which he intends to rely against the granting of the prayer of the petition, or, if he does not do so, will be deemed to have abandoned his opposition.

No person who has delivered particulars of objections will be entitled to oppose the granting of the prayer of the petition on any grounds not stated in such particulars.

Any person who has lodged notice of opposition will be entitled to be heard on the application to fix the appointed day, and every person who has lodged and served particulars of objection must be served by the petitioner with notice of the appointed day.

The petition will not be entered in the list for trial until the expiration of the time limited for the lodging and service of the particulars of objections, and will only be entered for trial on the lodging of an affidavit on behalf of the petitioner that all persons who have served him with notice of intention to oppose the prayer of his petition have been served with copies of the petition. The petition will, if and so long as the Court is a Judge of the Chancery Division, and subject to any direction of the Court to the contrary, be set down in the same manner as if it had been a witness action assigned to that Judge.

Any persons who have delivered particulars of objections will be entitled, at their own expense, to obtain office copies of the accounts which have been lodged by the petitioner.

The Court may excuse petitioners and opponents from compliance with any of the requirements of the Rules, and may give such directions in matters of procedure and practice as it considers to be just and expedient.

On the hearing of the petition the patentee and any person who has given notice of objection are made parties to the proceeding, and the Comptroller is also entitled to appear and be heard, and must appear if directed to do so by the Court.

The Comptroller if he elects or is directed to appear will not be required to give notice of any grounds of objection he may take, or of any evidence which he may think fit to place before the Court.

The Court, in considering its decision has regard to the nature and merits of the invention in relation to the public, to the profits of the patentee as such, and to all the circumstances of the case.

For the petitioner to succeed, the merit of the invention must be proved. There must be more than would merely support a patent in a petition for revocation; but degrees of merit will not be weighed in "golden scales."

The petitioner should bring his balance sheets and business books before the Court in a manner which will leave no doubt as to what his profits have been; if the accounts do not enable the Court to ascertain whether the patentee has been adequately remunerated or not the petition may be refused on this ground alone. In view, therefore, of the desirability of extending a patent for a valuable invention care should be taken throughout the life of the patent to keep a separate account of receipts and expenditure of the patentee, or his assignees or licensees, in this country and abroad. If the patentee has made additional profits as manufacturer, these profits must be shown; on the other hand, certain deductions from the gross profits may be allowed, such as personal expenses of the patentee for the exclusive devotion of his time in bringing the invention into practical operation, and the expenses of taking out and maintaining the patent.

Where there has been no profit, however, but a considerable loss, the same accuracy in the accounts is hardly necessary.

If it appears to the Court that the patentee has been inadequately remunerated by his patent, the Court may by order extend the term of the patent for a further term not exceeding seven, or, in exceptional cases, fourteen years, or may order the grant of a new patent for such term, and containing such restrictions, conditions, and provisions as the Court may think fit.

When an order has been made by the Court extending the term of a patent, the person in whose favour the order has been made must leave at the Patent Office an office copy of the order together with an application for entry of the same in the register of patents, whereupon the purport of the order is duly entered in the register.

Where the petitioner is an assignee, terms will usually be imposed in favour of the inventor, and an undertaking may be required that the patented article will be sold to the public at a certain price. The circumstance that an exclusive licence has been granted is unfavourable, and, as a rule, an extension will only be granted upon the licensee renouncing all his rights under the licence, or on the condition that the petitioner grants a licence on the same terms to any other person desiring one.

In the case where opposition is made to the granting of an extension the Court may give costs to or against the opponents, but in the event of the extension being refused will not, except under special circumstances, give more than one set of costs amongst all the opponents.

The Comptroller and the Board of Trade will not be entitled to any costs on or in relation to their appearance or on opposition to the granting of the prayer of a petition.

MARKING ARTICLES PATENTED.

As stated above, a patentee is not entitled to recover damages in respect of any infringement of a patent granted after 1st January, 1908, from a defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent. In this connexion, the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, is not deemed to constitute notice of the existence of the patent, unless the word or words are accompanied by the year and the number of the patent.

It does not follow that the marking or non-marking of the patented article will provide the ultimate ground of the decision in any suit in which innocence is pleaded; yet, inasmuch as the benefit of any doubt may be given to the defendant, failure to mark the article might furnish a weighty argument against the patentee's case.

The Act further provides that any person who falsely represents that any article sold by him is a patented article will be liable for every offence, on conviction under the Summary Jurisdiction Acts,¹ to a fine not exceeding £5. This liability attaches to any person who sells an article having stamped, engraved, or impressed thereon, or otherwise applied thereto the word "patent," "patented," or

¹ In Scotland an offence against this provision may be prosecuted in the Sheriff Court.

any other word expressing or implying that the article is patented when it is not so.¹

A false statement as to an article being the subject of an existing patent is also a false trade description, the application of which to goods, or the sale or exposure or possession for sale of such goods, is an offence against the Merchandise Marks Act, 1887, punishable by fine and imprisonment.

It is evident that patentees and others should exercise caution both in marking properly all patented articles or patented parts of articles and in omitting to mark articles or parts which are not covered by an existing patent. There will be, of course, an element of uncertainty in a number of cases, for instance, where the article as placed on the market differs in any respect from that specified. In such a case it is for the party in doubt to seek expert advice as to whether, on the proper construction of the specification, the article as made and sold is covered by a patent or not.

An applicant for a patent is not entitled to mark invented articles with the word "patent," "patented," *etc.*, until his complete specification has been accepted. He may, however, mark such articles with the words "patent applied for," "provisionally protected," or otherwise, according to the case.

¹The offence contemplated is one committed in this country, and the marking of an article as "patented" implies that the article is protected by a British patent; even the mark "patented in the most important countries" is objectionable when there is no subsisting British patent.

ROYAL ARMS.

Only persons holding warrants of appointment to His Majesty have the right to use the Royal Arms: these warrants are now only granted to tradesmen who actually and habitually supply the King. This is an established rule, although many patentees imagine that the possession of a patent confers the right either to use the Royal Arms or to place the Royal Arms on patented articles.

While denying the existence of any such right the Act of 1907 further provides that any person who, without the authority of His Majesty, uses in connexion with any business, trade, calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, will be liable on conviction under the Summary Jurisdiction Acts¹ to a fine not exceeding £20.

Under the Trade Marks Act of 1905 any unauthorised person assuming such arms may also, at the suit of any person who is authorised to use them or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction or interdict from continuing so to use the same.²

The above provisions, however, do not affect the right, if any, of the proprietor of a trade mark containing such arms to continue to use the mark.

The further question of the protection of trade marks containing the Royal Arms is reserved for future discussion.

¹ In Scotland such an offence may be prosecuted in the Sheriff Court.

² See also the Merchandise Marks Acts.

THE LAW OF DESIGN COPYRIGHT.

GENERAL DEFINITIONS OF "DESIGN" AND "COPYRIGHT."

As a precedent to a right understanding of the law of copyright in designs, it is essential to fix for the term 'design' a meaning that will include everything capable of being copyrighted under the statute.

According to the Act of 1907 '*design*' means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined.

'Article' means any article of manufacture and any substance artificial or natural, or partly artificial and partly natural.

'Copyright' means the exclusive right to apply a design to any article in any class in which the design is registered.

The statutory definition of design is not, strictly speaking, a definition at all, repeating merely as it does that 'design' means any design. The statutory definition, in fact, merely amounts to a statement that for the purposes

of the Act the ordinary or dictionary meaning of the word is to be regarded as qualified in the respects enumerated.¹

However, in the Inventions and Designs Act, 1888, of British India a definition is put forward which may be appropriately quoted. According to this Act 'design' means "some peculiar shape, configuration or form given to an article, or arrangement of lines or the like used on or with an article, but not the article itself."

The essential characteristics of a registrable design are discussed more fully in the following pages.

Copyright in designs is the creation of statute law. To secure copyright in a design an application to register the same must be made to the Comptroller in the prescribed form and manner. If the design is considered to be registrable, it is duly registered; the registered proprietor being then entitled to invoke the provisions of the Patents and Designs Act against anyone guilty of piracy.

¹The Oxford English Dictionary defines 'design' as "the outline of a piece of decorative work : a delineation : an artistic idea as executed."

WHAT MAY BE REGISTERED.

The difficulty in framing a general definition of the term design is paralleled by the difficulty in the concrete case of describing a particular design in words so as to present a clear conception to the reader. In fact, all the attributes of a design—pattern, ornament, shape or configuration—are only properly appreciable by the eye: rather, nothing is a design but that of which full knowledge is given when it has been once shown to the eye.

As the term design implies authorship, so the execution of a new design involves individuality, the labour usually of a craftsman exercising his artistic or inventive faculties, whence results a new outline, a new pattern, either plastic or superficial—in short, a new appearance of an article.

The designs protected by the Patents and Designs Act are industrial designs, forms of applied art, the work of practical designers, while the work of other artists falls within the scope of other laws relating to artistic copyright; the distinction between the two being evident, indeed, from the definition already quoted.

On the other hand, the association of patents and design copyrights in the same Act has been a source of frequent confusion. Briefly, the difference between a patentable invention and a registrable design is the difference between 'manner of manufacture' and 'form of manufacture.' It may be, indeed, that an article, by virtue of its form, performs certain functions of sufficient importance to justify the grant of a patent, or it may be that an article is patented while a design applicable to the same article is

registered. In other words, an article may be invented as well as designed. But there remains this fundamental difference, that the patentability of an article depends on what that article does and what it is used for, while the suitability of the design for registration depends merely on how the article looks, all other considerations being for this purpose irrelevant.

The distinction between a design and a trade mark is even more pronounced. Certain trade marks are in the nature of devices, *i.e.*, so-called pictorial marks, which may have been taken from designs, or which contain matter suitable for incorporation in designs. A device used as a trade mark, however, serves but the purpose of identifying the origin of the goods in connexion with which it is used, while the goods may otherwise be undistinguishable from those of other traders, the trade mark going with the article but being no necessary part of it; on the other hand, the design *qua* design is an essential feature of the article to which it is applied, whether it be applied for the sake of increasing its beauty or utility or otherwise.

The first quality of a design is, therefore, that it must appeal to the eye. Secondly, it must possess this feature, that the pictorial representation must not be a mere representation of a single article, but must be a suggestion of something which is capable of being applied to an article of manufacture or to a substance. This may be expressed by saying that a design must be a thing which exists apart from its expression.

The nature of a design may be made more easily comprehensible by citing a few typical examples. For instance, if new to-day, designs suitable for registration would be those of Wedgwood for pottery, of Chippendale or Sheraton for furniture, or of Morris for woven fabrics or book-binding.

So far, however, from a high standard of artistic excellence being required, beauty is no essential of a registered design; the eye to which the design is to appeal is that of the layman and not necessarily that of the artist. For that

matter, the majority of registered designs represent but endeavours to cater for ephemeral fashions, in which the artistic element has little place, *e.g.*, arrangements of checks and stripes applicable to calicoes, and plain geometrical patterns for wall paper and linoleum, or convenient forms of common utensils and instruments.

The author of a design has indeed an almost unlimited choice of subjects; certain exceptions are imposed, however, by the Act and the Rules.

In the statutory definition of design sculptures are expressly declared to be outside the scope of the Act. An article of manufacture may, however, comprise a piece of sculpture combined with another item, *e.g.*, a figure holding a pin-tray, or may serve a specific purpose as well as that of merely exciting admiration, *e.g.*, a sculpture adapted to be used as a paper weight: in either of these cases the design for the article may be registered.

Words, letters or numerals cannot as a rule be shown in a design, but where these are of the essence of the design, *e.g.*, in the case of a design for a ruler or a scale, they may be retained. A word or letter may even be the motive of a design; for instance, a design applicable to an article may be a name worked out with floral ornaments, or an alphabetical character may be so shaped as to constitute a design for a piece of jewellery.

In the practice of the Office a design consisting merely of a portrait is not regarded as a proper subject for registration. A portrait may, however, be associated with other matter, the combination being accepted as a registrable design.

Where the names or representations of living persons appear on a design, the Comptroller may require the applicant to furnish consents from such persons before proceeding to register the design. In the case of persons recently dead, the Comptroller may call for consents from their legal representatives before proceeding with registration of a design on which their names or representations

appear. In the case of a design including a portrait of His Majesty, any exclusive right to the use of the portrait must be disclaimed.

Registration of a design for an article gives no protection for the process by which the article is made. An article not distinguishable from a previously existing article save for the circumstance that it is made by a different process does not present subject matter for registration as a design.

Mechanical inventions cannot be protected as designs; it is possible, however, to register a design for an article comprising moving parts, subject, usually, to a disclaimer of any mechanical action.

The size or colour of an article is not taken into account in considering whether a design is registrable: in every case the right to registration depends on the features of shape or configuration, pattern, or ornament, or two or more of these together.

By the terms 'pattern,' 'shape,' *etc.*, are meant a definite and recognizable pattern or a definite and recognizable shape; not a variable form covered by some general expression, *e.g.*, streaky, granulated, *etc.* A registrable design must indeed be capable of representation by a specimen which can be copied exactly in every reproduction.

The term article, which covers articles of manufacture and substances, and also partly manufactured articles, is general enough to include a part of a composite article: conversely, it may include a structure comprising juxtaposed parts serving diverse purposes. It does not include, however, mere arrangements of separate articles, such as the general grouping of pieces of furniture in a room, or of goods displayed in a shop-window.

The Rules provide for the registration of a design for a set of articles: a 'set' being a number of articles of the same general character ordinarily on sale together, or intended to be used together, all bearing the same design, with or without modifications not sufficient to

alter the character or not substantially affecting the identity of the design.

Instances of sets of articles are a toilet set, a furniture suite, a font of type, a pack of playing cards.

Any doubt as to whether given articles do or do not constitute a set is determined by the Comptroller.

Essential prerequisites of registration of a design are that it shall be new or original and not previously published in the United Kingdom, *i.e.*, not published before the application for registration. This does not mean either that a design must involve a new or original idea, or that unless a design precisely similar, and in fact identical, has been in existence prior to registration, the design will be novel or original. On the contrary, a design is novel or original within the meaning of the Act which may be but the representation of a common object, and which did not require any ingenuity to produce it, but which is substantially novel or substantially original having regard to the nature and character of the subject matter to which it is to be applied.

The test of identity of two designs is sameness of appearance; mere difference of lines in the drawing, a greater or smaller number of lines, or slight variances in configuration, if insufficient to change the effect upon the eye, will not destroy the substantial identity.

For registration purposes goods are arranged in sixteen classes, copyright being conferred only in the class or classes in which registration is effected. The result of classification is to differentiate designs according to the materials of which articles bearing the designs are composed; the nature of the articles being of secondary consideration from the point of view of classification.

The consideration of the class in which a design is registered is alone important in judging infringement, whereas classification and character must both be taken into account in judging novelty.

In connection with the question of novelty, the statements already made as to the distinction in patent law between a combination and a mere aggregation are also applicable to the case of designs. Accordingly, where the features of a design are separately old, it becomes an important question whether in the particular case these are made to constitute one design, or whether in fact they amount to an assembly of independent designs.

The explanation previously given of what constitutes legal publication of an invention also covers the case of designs, apart from the consideration of statutory exceptions—with this difference, namely, that a design is only anticipated by a publication which illustrates the appearance possessed or to be possessed by the article to which it is applied, but is clearly and definitely anticipated by such a publication without the need for any further explanation.

The most important statutory exception from the effect of publication of a design is based on the system of classification.

In the words of the Act, 'where a design has been registered in one or more classes of goods, the application of the proprietor of the design to register it in some one or more other classes shall not be refused nor shall the registration be invalidated—

- (a) on the ground of the design not being a new and original design, by reason only that it was so previously registered; or
- (b) on the ground of the design having been previously published in the United Kingdom by reason only that it has been applied to goods of any class in which it was so previously registered.

It will be observed that the benefit of the above provision is only given to the proprietor of the design, or anyone deriving his title from the proprietor, and only in the case where registration has been previously effected in the class or classes covering articles to which the design has been applied. The clause does not provide a loophole for others

merely to copy a design already applied to goods in one class, and register it for like goods of different material and belonging to another class: nor does it enable the proprietor to register the design in a class in which the registration of a similar design has been effected by another party in the interval.

The Act further provides that the disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, and the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration, will not be deemed to be a publication of the design sufficient to invalidate the copyright, if registration is obtained subsequently to the disclosure or acceptance.

As in the case of patents, provision is made for the protection of designs during the holding of exhibitions, and for enabling persons who have applied for protection abroad to obtain priority in this country; there is, however, no provision in the Act corresponding to the limitation to fifty years of the period of anticipation of an invention by a prior specification.

The utility of a design or of an article to which a design is applied is altogether immaterial. The only use of a design which need be considered at all is the exhibition and the contemplation of it.

As in the case of applications for patents, the Comptroller has authority to refuse protection to designs the use of which is, in his opinion, contrary to law or morality; among such designs may be considered those of a scandalous nature.

THE PROPRIETOR.

A person qualified to register a design is the proprietor as defined by the Act, whether a British subject or not, or any person claiming under the international and colonial arrangements.

The proprietor of a design may be :—

- (a) Any person¹ for whom the author of the design executes the work for good consideration ;
- (b) Any person who has acquired the design or the right to apply the design to any article, either exclusively of any other person or otherwise, in the respect and to the extent in and to which the design or right has been so acquired :
- (c) In any other case, the author of the design.

Where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, the term ' proprietor ' includes that other person.

In every case the applicant must be the person who is the proprietor at the date of application ; an application made by a person who had previously assigned the property in the design would be void.

When a design is executed by an employee, the question arises whether the proprietorship rests with the author or passes to the principal in exchange for the wages paid to the other. If the services covered by such payment include the invention of designs, and the design is applicable to articles made by the principal, then certainly the latter

¹The term ' person ' includes firm, partnership, and body corporate.

is to be regarded as the proprietor by virtue of his having acquired the design for good consideration. On the other hand, if the invention of the design is outside the regular employment of the author, and the author receives no additional payment in respect of the design, then the proprietorship and the right to register the design rest with him.

In the case where a person having preconceived a plan employs another to make a drawing or to assist him in putting his idea in concrete form, it is a question of fact in each case to whom, if not to both, the credit for the design is due, i.e., who is to be regarded as the author. The mere suggestion of a subject, or a suggestion as to the treatment of a subject, does not constitute authorship, which involves execution before the design has any existence; neither does authorship consist simply in manual labour without invention. Rather, authorship involves originating, or producing as the master mind, the thing which is to be protected, and from the circumstances of each case it must be decided which of the two did the designing and which played the subordinate part of assistant.

The question is most important where the person who co-operates in producing the design receives no remuneration for his services; where the services are paid for, then, in the absence of any arrangement to the contrary, the person who pays is entitled to be registered as sole proprietor on the ground that in any event the work was executed on his behalf for good consideration.

Like any other piece of work a design can result from the co-operation of several persons, each following the same general plan, and producing an essential part of the design, although not a part independent of the rest. In such a case the various designers are joint authors, and, in the absence of any arrangement transferring the rights of one to another, an application to register must be made by the authors jointly or by the successor or successors in interest of all the parties.

The sale of a design without reserve gives the assignee the right to register the same in any and every class for which the design is applicable, and to maintain the registration against the assignor. It is a common practice, however, for the proprietor of a new design to transfer to another the right to apply the same to goods in a separate class from that in which he is himself interested, and such a limited assignment entitles the assignee to be registered as the proprietor in the particular class.

A person who has neither executed nor acquired a design, or the right to apply it, for good consideration, but is merely a consignee of, or dealer in, articles to which the design is applied, or a manufacturer who has received an order to supply a number of articles, is not a proprietor as defined by the Act, and is not entitled to be so registered.

In case an application to register is made in error in the name of someone other than the proprietor, the Comptroller may, on request, correct the application by substituting the name of the proprietor. Where a design has been *bonâ fide* registered in the name of the wrong person, the Court may order the register to be rectified by substituting the name of the true proprietor; should the original registration be tainted with fraud, the Court will order that registration to be expunged, and the proprietor may validly register the design in his own name, provided only, however, that it has not yet been published.

After registration, the proprietor of a design may assign his rights or grant licences to third parties who may be entered on the register as assignees, licensees, or mortgagees, as the case may be: neither assignment nor licence can be registered until the original proprietorship has been entered.

Only a party who is registered as a proprietor is entitled to protection against piracy. The mere possession of the certificate of registration is insufficient.

A design is personal property, and on the death or bankruptcy of the proprietor passes to his personal repre-

sentative or to the trustee in bankruptcy, as the case may be.

A licence to apply a design may devolve in the same way, or in any manner provided for in the document granting the licence.

The mutual rights of co-proprietors of a design not being partners have not been fully settled. According to the Patent Office practice an assignment will be registered although executed by one co-owner only, if it is clear what share the assignor possesses and what share is being assigned; but no document purporting to be a general assignment or licence is entered in the register without the consent of all the registered proprietors. In the event of litigation, in all probability the law as to dramatic copyright would be followed, namely, that a licence granted by one only of several co-proprietors does not bind the others or prevent them from recovering their shares of the penalties from infringers, and that one co-proprietor may sue a stranger for an infringement of the entire copyright.

THE APPLICATION TO REGISTER.

An application for the registration of a design must be made on a prescribed form impressed with the proper stamp (the value of which varies according to the class), and must be left at or sent to the Patent Office, London, or, in certain cases, the Manchester Branch of the Patent Office (see pages 202 and 203).

The applicant's full name, address and occupation must be stated; if the applicant resides out of the United Kingdom or Isle of Man, an address for service must also be given.

The class in which the design is to be registered must be stated in the application. If the design is to be registered in more than one class, a separate application must be made in each class, in which case each application is numbered separately, and is treated as a distinct application.

The application must further state the article or articles to which the design is to be applied, and, if required, must specify the purpose for which the article is used and the material or predominating material of which the article is made.

A brief statement of the novelty claimed for the design may, if the applicant so desires, be endorsed on the application, and must be so endorsed if required.

Except as regards applications in the Manchester classes, there must be furnished in connexion with an application for the registration of a design to be applied to a single article three exactly similar drawings, photographs, trac-

ings, or other representations or three specimens; when the design is to be applied to a set, four representations or four specimens are required. For an application in any of the Manchester classes six representations or six specimens must be furnished.

Where representations are supplied, the Comptroller may also require a specimen to be furnished: he may also call for additional representations or specimens if necessary.

Rough sketches cannot be accepted, but if it is inconvenient to supply the proper number of representations when the application is made, and it is desired to secure a date of registration, one sketch (or in the case of an application in one of the Manchester classes, two sketches) of the design (sufficiently definite to identify it) may accompany the application. In such a case the design, if accepted, will eventually be registered as of the date on which the sketch was received, but no certificate is issued until the proper number of correct representations has been supplied.

The application being duly lodged, an acknowledgment is given to the applicant.

PROCEDURE ON RECEIPT OF THE APPLICATION.

Every application filed at the Patent Office is recorded in the order received.

If any informality is found in the documents, the applicant is notified, and may be required or permitted to amend the application.

In case less than the prescribed number of representations or specimens accompanied the request to register the design, the application remains dormant until the proper number of representations or specimens is filed.

Before delivery on sale of any articles to which a registered design has been applied, the proprietor must, if exact representations or specimens were not furnished on the application for registration, furnish to the Comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the Comptroller may erase his name from the register, and thereupon the copyright in the design ceases.¹

Upon the formal requirements being complied with, except in the case of a design for lace or of a printed or woven design in the nature of checks or stripes on textile piece goods, or handkerchiefs or shawls, the Comptroller causes a search to be made amongst the registered designs in force and pending applications for the purpose of ascertaining whether there are on record any designs in the same class identical with or nearly resembling the design of the applicant.

If, after such search and consideration of the design, the Comptroller thinks there is no objection to registration, he may accept the application.

If any objections appear, a statement of these objections is sent to the applicant in writing, and unless within one month, or such extended time as the Comptroller may allow, the applicant applies for a hearing, he is deemed to have withdrawn his application.

If the Comptroller holds that the proposed design is in the nature of an invention or a trade mark and not a fit subject for copyright, the applicant may either apply for a patent or make an application to register the trade mark; such an application is independent of the design application and bears its own date.

If the objection is taken that the design is anticipated by an earlier unexpired registration or pending application,

¹ This provision was originally intended to supersede that part of the old law which conferred 'provisional protection' on designs; according to the existing practice a design is not entered in the register until all the requirements are complied with.

the applicant is permitted to inspect the prior design cited, but may not take a copy of such design or of any part thereof.

In addition to the objection of anticipation by a previous registration or pending application, the Comptroller may object to the application on the ground of absence of proper subject matter, or want of substantial novelty, or on the ground that the use of the design is contrary to law or morality.

The decision of the Comptroller at the hearing is communicated in writing to the applicant, who may, within one month, should he consider it necessary for the purpose of appeal, require the Comptroller to state in writing the grounds of his decision and the materials used by him in arriving at the same.

In some cases the objection may be met by amendment of the application or by cancellation of separable and non-essential parts of the representations, which latter may also be amended by correcting clerical errors, or may be replaced by clearer illustrations if required.

The arguments to be advanced at the hearing may be technical or legal. In the latter case reliance may be placed on judicial decisions under the former Acts, which were even more strict than the present.

With regard to the arguments to be put forward by the applicant, it may be noted that the circumstance that a prior registration ought not to have been effected, or that a prior application pending is unjustified, cannot be relied on.

If two or more applications for the same or substantially the same design are filed on the same day, the Comptroller notifies all the parties of the position, and unless all but one of the applications be withdrawn, the Comptroller refuses all the applications.

It is generally immaterial by what period a design quoted by the searcher anticipates the later application, but when

two applications to register similar designs in the same class are made on different dates by the same proprietor, the Comptroller considers how long the term of copyright would be extended by allowing the second application. If the term would not be appreciably extended, the benefit of any doubt on the subject is usually given to the applicant.

If the Comptroller decides that the application is made in the wrong class, the applicant is called on to amend his application.

If a single application is made in respect of goods which in the Comptroller's opinion belong to different classes, the applicant is required to elect the class in which he wishes the application to be proceeded with, and to remove from the specification of goods any that do not fall within that class. The applicant may file separate applications in other classes: such new applications are not ante-dated, but bear the date on which they are actually filed.

As regards classification, the Comptroller's decision is final.

Alternative forms of a design do not exist. If an applicant desires to register two designs, however similar, he must make a separate application for each. Should two or more designs be included in a single application, the Comptroller requires the removal of all but one before proceeding with the application. A separate application in respect of a design removed from the original application bears the date at which it is left at the Office, and is treated independently of the original application.

In case of the death of any applicant for registration after the date of his application, and before the design applied for has been entered in the register, the Comptroller may, on being satisfied of the applicant's death, enter in the register, in place of the name of the deceased applicant, the name, address and description of the person owning the design, on such ownership being proved to the satisfaction of the Comptroller.

Where an application for registration of a design is not completed within twelve months from the date of the application by reason of default or neglect on the part of the applicant, the Comptroller gives notice to the applicant in writing of the non-completion. If after fourteen days from the date of sending the notice the application is not completed, the application is deemed to be abandoned; but where the applicant lives at such a distance from the Office that he cannot reasonably be expected to do what is necessary within fourteen days, the Comptroller may grant an extension of the time for the completion of the application.

Where an application for a design has been abandoned or refused, the application and any drawings, photographs, tracings, or specimens left in connexion with the application are neither open to inspection nor published by the Comptroller.

When a design is registered, the registration is advertised in the *Official Journal*, the notice stating the name and address of the registered proprietor, the class in which registration is effected, and the date of registration, i.e., the date of application.

APPEAL TO THE BOARD OF TRADE.

In the event of the Comptroller refusing to register any design presented to him for registration, any person aggrieved by such refusal may appeal to the Board of Trade.

When any person intends to appeal to the Board of Trade, he must, before doing so, apply to the Comptroller for a hearing, and may, if he considers it necessary, obtain the grounds of the Comptroller's decision. Within one month from the date of the decision, or from the date of the issue of the grounds of the decision, he must, if he is advised to appeal to the Board of Trade, lodge a notice

of his intention to do so, accompanied *inter alia* by a statement in writing of the grounds of appeal, and of his case in support thereof, *i.e.*, a summary statement, drafted in argumentative form, of the questions raised, and the circumstances on which the appellant relies.

A copy of the notice and of all the accompanying documents must also be forthwith sent by the appellant to the Secretary of the Board of Trade.

The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to parties and evidence, or otherwise, for the purpose of the hearing of the appeal, and will also give to the Comptroller and to the appellant seven days' notice, or such shorter notice as they may in any particular case direct, of the time and place appointed for the hearing.

The oral arguments on the appellant's behalf must be confined to the points taken in the case on appeal, and should be such as to rebut the objections specified in the Comptroller's decision. Neither oral evidence of expert witnesses nor an affidavit for or against the application is called for or considered.

After hearing the applicant and the Comptroller, if so required, the Board may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

No appeal will be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave of the Board of Trade.

The decision of the Board of Trade is final.

The Board makes no order as to the costs of the appeal, and the appellant pays his own costs, whether successful or not.

CERTIFICATE OF REGISTRATION.

When a design is registered, the Comptroller grants a certificate of registration to the proprietor.

The certificate states the date of registration, the class, and the registration number to be marked on articles to which the design is applied, and is accompanied by a representation or specimen of the design.

In case of loss or destruction of the original certificate, the Comptroller may issue a duplicate.

Where a certificate is required for the purpose of any legal proceeding, or other special purpose, as to any entry, matter, or thing which the Comptroller is authorised to make or do, the Comptroller may give such a certificate. A certificate so granted specifies on the face of it the purpose for which it has been issued, and is *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

REGISTER OF DESIGNS.

The register of designs is a book kept at the Patent Office, wherein are entered the names and addresses of proprietors of registered designs, notifications of assignments and transmissions, extensions and cancellations of registered designs, and other matters affecting the proprietorship of designs.

The register of designs is relatively of more importance than the register of patents, the entry of a design or of the name of a person in the register being a prerequisite to the existence of copyright or to the recognition of proprietorship. In other respects, however, practically the same considerations arise in connection with entries in the register of designs as with entries in the register of patents.

Where a person becomes entitled as assignee, mortgagee, licensee, or otherwise to any interest in the copyright of a design, he may, conjointly with the registered proprietor, apply to have an entry of the fact made in the register, and, on receipt of the application, the Comptroller may make a note in the register of such interest.

Alternatively, any person who has become entitled to an interest in the copyright of a design by assignment, mortgage, licence, or otherwise, may apply for the entry of his name in the register as proprietor of such interest, leaving with the application a case stating full particulars of the assignment, mortgage, licence, instrument, or other mode of transfer by virtue of which he claims to be entitled to be entered in the register, so as to show the manner in

which, and the person or persons through whom, such interest has been acquired.

If the Comptroller determines that the case sets out particulars such as entitle the claimant to be entered in the register, he may call upon the claimant to furnish a statutory declaration verifying the statements in the case and declaring that the particulars given comprise every material fact and document affecting the matter.

When the Comptroller is satisfied that the claimant is entitled to the entry of his name, he makes a note in the register of his interest.

A person whose name is entered on the register as mortgagee or licensee, may on request have a note entered in the register that he no longer claims to be mortgagee or licensee, as the case may be.

Subject to any rights vested in any other person, the registered proprietor of a design has power absolutely to assign, grant licences as to, or otherwise deal with, the design, but any equities in respect of the design may be enforced in like manner as in respect of any other personal property.

The Court may, on the application of any person aggrieved by the non-insertion in, or omission from, the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining in the register, make such order for making, expunging or varying such entry as it may think fit.

The persons aggrieved are all persons in some way substantially interested in having the register rectified, or persons who would be substantially damaged if the rectification did not take place, but not such persons as common informers or individuals interfering from merely sentimental motives. For instance, any person claiming to be the true proprietor of the design, or the proprietor of a similar design, or any person sued or liable to be sued for infringement, is a person aggrieved and entitled to move the Court to expunge the entry from the register.

A person having *locus standi* as a person aggrieved may in his application to rectify the register rely on any of the grounds upon which the registration may be expunged, or in respect of which the original registration should properly have been refused. These grounds are enumerated in the list of defences to an action for infringement.

An application for the rectification of the register may be brought before the High Court of Justice in England or Ireland, and in Scotland before any Lord Ordinary of the Court of Session.

Four clear days' notice of an application to rectify the register must be given to the Comptroller, who has the right to appear and be heard, and must appear if directed to do so by the Court.

Where an order has been made by the Court for the rectification of the register, the person in whose favour the order has been made, or such one of them, if more than one, as the Comptroller may direct, must forthwith serve on the Comptroller an office copy of the order. The register may thereupon be rectified or altered by the Comptroller.

From the decision of the Court an appeal lies to the Court of Appeal and thence to the House of Lords.

In case a decision to expunge the entry of a design from the register is reversed on appeal, the design is restored to the register, and the copyright resuscitated. The Court in the first instance may, however, stay proceedings on an order for cancellation pending an appeal.

The provisions as to rectification by the Court refer, of course, to designs already on the register. Thus, the Court is not empowered to order the registration of a design which the Comptroller and the Board of Trade have refused to register.

A clerical error in the representation of a design or in

the name or address of the proprietor of a design or in any other matter which is entered upon the register may be corrected, and any change of name or address or address for service of the proprietor may be entered in the register by the Comptroller.

THE MANCHESTER REGISTER.

On account of the special importance of designs for cotton goods, paralleled in the case of trade marks, exceptional provisions have been made for the Manchester trade.

A branch of the Patent Office is established at Manchester in the charge of the Keeper of cotton marks, and applications for registration of printed or woven designs on cotton piece goods, handkerchiefs and shawls, may be lodged at the Patent Office, London, or at the Manchester Branch Office, at the option of the applicant.

A register is also kept at the Manchester Office, wherein the entries made are duplicates of the entries in the register at the Patent Office relating to designs for the goods above specified.

All applications for registration of designs for the above mentioned goods, and all documents relating to such applications, must be in duplicate. If the application is lodged at the Patent Office, one copy is forthwith sent by the Comptroller to the Keeper of cotton marks; if the application is addressed to the Keeper, a copy is sent by him to the Comptroller.

Where a dispute arises with reference to a design entered in the Manchester register, the parties may notify the Keeper that they have made a joint request to the Manchester Chamber of Commerce to appoint an arbitrator to decide and make an award upon the merits of the dispute, and have consented that such award, when made, shall be final and binding, and that except for the purpose of

enforcing such award they shall have no right to appeal, and that none of them will make any application to any Court of Law or other authority in respect of the subject matter of such award or of anything in it. Thereupon the Keeper makes a note of the request in the Manchester Register and sends a copy to the Comptroller.

INSPECTION OF THE REGISTER.

For the general public an important function of the register of designs is to inform manufacturers and others desirous of adopting strange designs whether or not a given design is registered, and to whom to apply for permission to reproduce the same. On the other hand, a system of open deposit would compel the proprietor of a design to publish his trade secrets, and, before the goods were actually on the market, attract the attention of competitors, who, if not permitted to copy the registered design, would at least be able to produce similar designs in the same style and thus encroach on the proprietor's trade. It would appear desirable, therefore, more especially in the case of modes which endure for little more than a season, to observe a certain amount of secrecy with regard to the subject of registration.

The practice authorised by the Act is a compromise between that of open deposit and that of deposit under the seal of secrecy.

As provided by the Act, during the period of two years from the date of registration of a design, or five years in the case of a printed or woven design for textile piece goods or for handkerchiefs or shawls, the design is not open to inspection except by the proprietor, or a person authorised in writing by him, or a person authorised by the Comptroller or by the Court, and only then in the presence of the Comptroller, or of an officer acting under him, and the person making the inspection is not entitled to take any copy of the design, or of any part of the design.

Where, however, registration of a design is refused on the ground of identity with a design already registered, the applicant for registration is entitled to inspect the prior design, even if it is secret, although he is not entitled to take a copy.

After the expiration of the period of two years or of five years above mentioned, the design is open to inspection, and copies may be taken by any person.

The fee for inspection is 1s. for each quarter of an hour : the person so inspecting the design may 'take' a copy but not 'make it,' i.e., he may obtain an office copy at a cost to be settled by agreement. In the case where a copy cannot be made by the official draughtsman no copy is given.

SEARCHES.

Notwithstanding the secrecy of registration, members of the public have at least a limited opportunity of ascertaining for themselves what has been actually registered or what would be an infringement of any subsisting copyright.

Even while a design is secret, a person apprised of the registration number, although not entitled to inspect the design, can learn by inspection of the register the class and date of registration with particulars of the proprietorship, or, if the copyright has expired, the date of expiry.

The Comptroller will, on request, give the like information to any person furnishing such information as will enable him to identify the design, *i.e.*, stating the registration number, or giving such other information as he is in possession of, or furnishing representations or specimens of the design in question.

The Comptroller may also, on request, cause a search to be made among the registered designs, and state whether, in his opinion, any design accompanying the form of request, and applied to goods in any particular class, is or is not identical with, or an obvious imitation of, any registered design applied to the same goods of which the copyright is still existing.

The Comptroller's opinion does not bind the Court, but it may at least be regarded as the best expert opinion obtainable either by the registered proprietor of a design who contemplates proceeding against a supposed infringer, or by a person desirous of ascertaining whether he incurs any liability by adopting a particular design.

AMENDMENT.

The presence of a clerical error in a design or in an entry on the register of designs, though unlikely to affect the validity of registration, may be attended with considerable inconvenience.

The Act confers jurisdiction on the Comptroller to correct any clerical error in the representation of a design, or in the name or address of the proprietor of a design, or in any other matter which is entered in the register.

The Rules also provide that any document or drawing or other representation of a design may be amended, if the Comptroller thinks fit, and on such terms as he may direct.

Certain amendments are not allowable, even though not expressly forbidden by the Act; it is not permissible to substitute for the representations or specimens filed with an application representations or specimens of a different design, or to supplement or extend the specification of goods.

Corresponding to the case of corrections, any alteration in the name or address or address for service of the proprietor may be entered in the register on a request made in the prescribed form.

DURATION OF COPYRIGHT.

When a design is registered, subject to the registration remaining in force, the registered proprietor has copyright in the design during a term of five years, which may be prolonged to ten or fifteen years, from the date of registration, *i.e.*, from the date of application, or, in a Convention case, the date of the first foreign or colonial application.¹

Whether or not copyright is retrospective, so as to justify a claim in respect of infringement after the date of application and before the date of the actual entry of the design in the register, is a question not yet judicially decided. On the analogy of patent practice it would appear not to be retrospective. Certain it is, however, that copyright depends on registration, and is not acquired by the mere application for registration, for the application might be unsuccessful, or it might be abandoned.

At least one week before the expiration of the original period of five years, an application for the extension of the period of copyright may be made to the Comptroller, who will, on payment of a fee of £1, extend the period of copyright for a second period of five years, and thereupon make an entry of the extension in the register.

At any time not less than six months and not more than twelve months before the expiration of the second period of five years, an application may be made to the Comptroller for a further extension of the period of copyright

¹ The validity of registration in this country is independent of the maintenance of protection abroad, so that the lapse of a foreign registration does not entail loss of copyright in this country.

by lodging a form of request bearing an impressed stamp of ros. If the Comptroller grants the application, he sends a notice to the registered proprietor, who must, at least one week before the expiration of the second period of five years, pay the fee of £1 10s. Thereupon an entry of the further extension of the period of copyright is made in the register.

The time prescribed by the Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller, if he thinks fit, and upon such notice to other parties, and proceedings thereon, and upon such terms as he may direct.

Where a person who is bound to pay any such fee resides at such a distance from the Office that he cannot reasonably be expected to pay the fee within the time allowed, the Comptroller, if satisfied that the omission to pay the fee has not been from any want of diligence on the part of the person whose business it is to pay it, may accept the fee even though the date for payment has passed, and treat it as if received on the correct date, provided that the fee is actually paid with such promptitude as can be expected in the circumstances.

In no case can the period of copyright be prolonged beyond the term of fifteen years.

CESSER OF COPYRIGHT.

ABANDONMENT.

As in the case of registration with which begins the copyright in a design, a formal entry in the register is essential for the purpose of effecting the cesser of copyright.

In the case where the full term of protection comes to an end, or where the proprietor fails to apply for or obtain an extension at the end of any period of five years, the Comptroller as keeper of the register notes the expiration of the copyright without requiring any intimation from the proprietor.

At any other time the proprietor may apply to the Comptroller to cancel the registration either wholly or in respect of any particular goods in connection with which the design is registered.

The application for cancellation must be made on a stamped form, on receipt of which the Comptroller rectifies the register accordingly.

Cancellation may also be effected by the trustee in bankruptcy of the registered proprietor, or, where the registered proprietor is a company in liquidation, by the liquidator, or in any other case where the request is made by a person whom the Comptroller may decide to be entitled to act in the name of the registered proprietor.

Cancellation has no retrospective effect, and an action may be maintained by the past proprietor for infringement committed during the subsistence of copyright, and before

the cancellation : the defendant is entitled, however, to plead the invalidity of the original registration, which would negative the existence of any exclusive right at the date of the alleged infringement.

Constructive abandonment of a design arises from the failure of an applicant for registration to apply for a hearing in the event of objections being made by the Comptroller, or from default or neglect to bring his application to successful completion within the period of twelve months from the date of application, or such extended time as may be allowed by the Comptroller.

Abandonment is not to be presumed, however, from the failure of the proprietor to prosecute infringers, nor is the fact that the registration has been judicially declared invalid sufficient to determine the copyright so as to prevent a suit being brought against third parties who have taken it on themselves to imitate the design.

In the case where the registration is believed to be invalid, any person aggrieved by the entry remaining on the register may move the Court for an order to have the entry expunged, and upon the Comptroller carrying out the order the rights of the proprietor are terminated.

EXHIBITIONS.

Corresponding to the protection afforded to unpatented inventions exhibited at industrial or international exhibitions, provision is made by the Act for validating the registration of a design even after the exhibition of the design, or of any article to which the design is applied, at an industrial or international exhibition certified as such by the Board of Trade, or its exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, or the publication, during the holding of the exhibition, of a description of the design.

Any person desirous of availing himself of this provision, before exhibiting the design or article, or publishing a description of the design, must lodge a form notifying the Comptroller of his intention to do so, and, for the purpose of identifying the design in the event of an application to register the same being subsequently made, must supply a brief description of the nature of the design, accompanied by a sketch, drawing, or specimen, and such other information as the Comptroller may in each case require.

If it is ultimately decided to register the design, the application for registration must be made before or within six months from the date of the opening of the exhibition.

An Order in Council may be issued applying the above provision to any exhibition mentioned in the Order as if

it were an industrial or international exhibition certified by the Board of Trade; any such Order may provide that the exhibitor is to be relieved from the condition of notifying the Comptroller, either absolutely or upon such terms and conditions as may be stated in the Order.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

The international and colonial arrangements to which reference is made elsewhere (see pages 97 to 99) apply also to designs, as provided for in the International Convention.

Any person who has applied for protection for any design in any foreign state or British possession with the government or legislature of which an arrangement with His Majesty is in force is entitled to registration of his design in this country in priority to other applicants, the registration to be dated as of the date of the foreign or colonial application.

An application claiming priority must be made within four months from the application for protection abroad, and must be accompanied or followed by a certified copy of the foreign or colonial registration, or application for registration, and by a translation if the copy is in a foreign language; after the term of four months above mentioned, or after registration in this country, no further opportunity is given of antedating the application.

The representations or specimens accompanying the application must agree in all respects with those submitted for registration in the foreign state or British possession, and the specification of goods must not include any articles missing from the foreign or colonial registration.

If the foreign application covers a series of designs, each or any design of the series may be the subject of a distinct application.

Priority is only granted if the subject matter has been claimed in a foreign or colonial application for registration as a design: a certificate that the same matter has been patented, registered as a trade-mark, or copyrighted as a work of fine art, will not be accepted.

The applicant must be the party in whose name the foreign or colonial application for protection was made, if alive: if any foreign or colonial applicant be dead, his name may be replaced by that of his legal representative.

A Convention application is treated in the same way as an ordinary application, the official search being made through all registrations in force and prior pending applications. When the application is allowed, the design is entered on the register as of the date of the foreign or colonial application, and the term of copyright is reckoned from this date. The proprietor is not entitled, however, to recover damages for infringements happening prior to the actual date on which the design is registered in this country.

The registration so made is not invalidated by reason only of the exhibition or use of, or the publication of a description or representation of the design in the United Kingdom or the Isle of Man during the period that elapsed after the date of the foreign or colonial application and before the date of the application in this country.

The Act omits to state the effect of a prior registration in this country made during this period; in practice, registration effected before the date of a Convention application acts as a bar to the subsequent registration of a similar design, even although the date claimed under the international and colonial arrangements precedes the date of the anticipating registration.

During the pendency of an application the applicant may abandon his claim for priority; after the design is entered on the register, the registration cannot be post-dated in any circumstances.

CANCELLATION OF REGISTRATION OF DESIGNS USED WHOLLY OR MAINLY ABROAD.

The economic reasons discussed at pages 137 to 144 for requiring patentees to exploit their inventions in this country apply, if much less forcibly, in the case of designs.

The Act of 1883 provided for cesser of copyright in designs used in manufacture in any foreign country, and not used in this country within six months of registration. This provision of the Act of 1883 remained a dead letter, however, as regards the register, the Courts, and the public. The Act of 1907 goes further in providing simple procedure for effecting the cancellation of the registration of a design which is used for manufacture mainly or exclusively outside the United Kingdom.

An application for cancellation of the registration of any design on this ground may be made to the Comptroller at any time after the registration; a copy of the application being delivered to the registered proprietor of the design or to his agent.

Within fourteen days from the delivery of the copy, or such further time as the Comptroller may allow, the proprietor of the design must leave at the Patent Office evidence, by way of statutory declaration, stating whether or not the allegations contained in the application are correct; and, if they are incorrect, to what extent, and in what place the design is used for manufacture in the United Kingdom; and setting out, in the event of the design not being used for manufacture in the United Kingdom to an adequate extent, the reasons why it is not so used.

Copies of such evidence having been delivered to the applicant, the applicant must, within fourteen days or within such further time as the Comptroller may allow, if he decides to proceed with his application, leave at the Office statutory declarations in answer, and deliver copies to the proprietor or his agent.

No further evidence may be left at the Office on either side except by leave, or on the requisition of the Comptroller, and upon such terms, if any, as the Comptroller may think fit.

On completion of the evidence, or at such other time as he may see fit, the Comptroller appoints a time for the hearing of the case, giving the parties ten days' notice at least of such appointment; and in the event of his deciding to take evidence *viva voce* in lieu of, or in addition to, the evidence by declaration, or to allow any declarant to be cross-examined on his declaration, he may require the attendance of any declarant, or other person whose evidence he considers desirable.

If the Comptroller is satisfied that the allegations contained in the application are correct, and the proprietor of the design fails to prove that the design is used for manufacture in this country to an adequate extent, or to give satisfactory reasons why it is not so used, the Comptroller may make an order cancelling the registration either:— (a) forthwith; or (b) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the design is used for manufacture within the United Kingdom to an adequate extent.

No order for cancellation will be made, however, which is at variance with any treaty, convention, arrangement or engagement with any foreign country or British possession.

If within the time limited in the order the design is not used within the United Kingdom to an adequate extent, but the proprietor gives satisfactory reasons why it is not so used, the Comptroller may extend the period mentioned in

the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

The Comptroller has power by order to award to any party in these proceedings such costs as he may consider reasonable, and to direct how and by whom they are to be paid, and any such order may be made a rule of the Court.

The decision of the Comptroller is final.

The statements already made with reference to the working of patented inventions, more especially as to the extent of working required, and the admissible reasons for default, are applicable, in the main, to the case of designs, although, without doubt, less stress is to be laid on the consideration of the demands of the general public with respect to the use of a registered design, and more attention is to be given to obstacles to manufacture in this country.

Several difficult questions may, however, be expected to arise in the interpretation of the Act. Meanwhile, it is submitted that "used for manufacture" means "applied to articles;" and that the user to be considered is limited to user in connexion with articles in the class or classes for which copyright subsists in this country.

The ground that a design is used for manufacture mainly or exclusively outside the United Kingdom is available by way of defence to an action for infringement of the copyright in the design.

Even although the proprietor neglects to comply with the statutory provisions, the design remains on the register unless and until an application is made to remove it; in the event of the design eventually coming into use in this country reliance cannot be placed on the circumstance that an application for cancellation, if made earlier, would have been successful.

MARKING OF ARTICLES.

For the purpose of safeguarding the interests of innocent manufacturers and traders the Act requires the proprietor, before delivery on sale of any articles to which a registered design is applied, to cause each such article to be marked with the word REGISTERED or with the abbreviation REGD or with the abbreviation RD, and also (except in the case of articles of lace, and textile piece goods or handkerchiefs and shawls bearing printed or woven designs) with the number appearing on the certificate of registration.

Omission so to mark the articles does not invalidate the registration, but a proprietor who fails to mark any such article will not be entitled to recover any penalty or damages in respect of any infringement of his copyright, unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place after the guilty party knew or had received notice of the existence of the copyright.

The proprietor who fails to mark the articles sold by him does not necessarily lose his right to obtain an injunction against infringers, but, as is evident, the value of the registration is reduced by the amount of penalties or damages which might otherwise be recovered.

The prescribed mark may be stamped, engraved, impressed on or otherwise applied to the articles; or, for instance, in the case of delicate materials, on labels or the like secured to the articles.

In any case each article must be marked before the first delivery on sale, and, if possible, on the actual part to which the design is applied, it being immaterial that the marking is subsequently obliterated; the law is not satisfied by marking a package or receptacle containing a number of articles or by marking a separable part not included in the design.

The proprietor is responsible for the acts of commission or omission of his servants. In case he seeks to excuse his failure to mark the articles, the burden rests on him of proving not only that he instructed the marking to be effected, but that he took precautions to see that his instructions were carried out. Thus, should a proprietor hand his servant a proper die with which to mark the articles, and the servant should inadvertently use a die in which a mistake is made in the number, the proprietor may well be held excused for the error of his servant: on the other hand, where the marking is carelessly made, either incorrectly, or so as to be illegible, and no proper care is taken in examining each article before delivery, the proprietor and not the innocent infringer must suffer.

Penalties are imposed on persons who falsely describe as registered designs applied to articles sold by them; the guilty party being liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding £5. A person is deemed to represent that a design applied to an article is registered, who sells an article having stamped, engraved, or impressed thereon, or otherwise applied thereto the word "registered," or any other word expressing or implying that the design applied to the article is registered.

Any person who, after the copyright in a design has

expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, will be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding £5.¹

¹See also the Merchandise Marks Acts.

REMEDY FOR THREATS.

Artists, like patentees, are prone to rate their own work more highly than others are ready to recognise, and are, perhaps, too quick to find plagiarism of their designs in the work of competitors.

Corresponding to the provisions relating to the remedy for groundless threats made by a patentee (see pages 160 to 162) the Act of 1907 provides that where any person claiming to be the proprietor of a design, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the copyright, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats.

As in the case of threats made by a patentee, an action will not lie if the person making the threats with due diligence commences and prosecutes an action for infringement of his copyright.

Proceedings in any such action are conducted substantially in the same manner as proceedings with reference to a patent, and the advice above given to litigiously-minded patentees is intended equally for proprietors of registered designs.

INFRINGEMENT.

The Act of 1907 is explicit in stating what is actionable infringement of copyright.

In the language of the Act, during the existence of copyright in any design it shall not be lawful for any person—

- (a) For the purposes of sale to apply or cause to be applied to any article in any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or
- (b) Knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor to publish or expose or cause to be published or exposed for sale that article.

The Act does not define the words "apply the design"; according, however, to the definition contained in the Australian Designs Act, 1906, a design is deemed to be applied to an article when the article is made from or in accordance with the design. Thus, if the design is applicable for the shape or configuration of an article, applying the design consists in making an article of that shape or configuration. Where the design is applicable for the ornament or pattern, applying the design consists in ornamenting an article in the manner designed by the author or in reproducing the pattern on an article.

It is immaterial whether the counterfeit design is applied to the article in question by the same process, whether it is applied manually or mechanically, or whether it is intended for the same purpose as the original.

Changes in a design do not in general exclude infringement. A pirate design which is not a facsimile of that registered may be an obvious imitation, *i.e.*, resemble it so closely that the two are liable to be mistaken one for the other; or it may be a fraudulent imitation, not necessarily an obvious imitation, but imitation by someone deliberately copying the registered design, even if not servilely, yet without any sufficient invention or originality on his part, and departing from it only for the purpose of masking the fraud. Thus, infringement is not averted by making a simple addition to, or by transposing some of the elements of, a design, or by omitting non-essential features, when in fact the impression produced on the eye by the altered design in its totality is no other than that produced by the original. It may even be said that in the majority of cases differences in accessory details provide an incontestable proof of intention to imitate: it is indeed a general rule that infringement is to be judged by resemblances and not by differences.

There is no infringement, however, in merely adopting a motive from a registered design and treating it in a different way without reproducing the characteristics of the original, *i.e.*, in using a registered design as a source of inspiration in the creation of what is itself a new and original design.

The doctrine of equivalence is applicable to designs as to patented inventions, that is, aesthetic equivalence, rather than equivalence of function or operation. It is also proper, as in patent cases, to take into account the state of knowledge at the date of registration, and in what respects a design is new or original, when considering whether any variations from the registered design which appear in an alleged infringement are substantial or immaterial.

A design which can always be readily distinguished from

a registered design at all material points of view will not be held to be an obvious or fraudulent imitation so as to amount to infringement.

In no case is consideration to be given to differences of colour or of total dimensions, without a change in the relative proportions of the parts of the design.

Where a design is registered for a set of articles, copyright is infringed by application of a pirate design to any article of the set for purposes of sale or by the publication or exposure of that article for sale.

The same design may be registered in more than one class, and is protected for each class in which registration is effected: but the proprietor of the design cannot maintain an action for infringement in respect of the application of the design to an article in any class for which it is not registered even although the article is identical in appearance with that of the proprietor and differs from it only in respect of the material of which it is composed.

That a design has been registered in the wrong class is immaterial: in every case the design is protected in the class or classes of registration and not in any other.

It will be observed that the Act differentiates between the infringer who applies the design to an article or causes it to be applied, or does anything to enable the design to be so applied for purposes of sale, and the retailer who publishes or exposes that article for sale, or causes it to be so published or exposed. -

In the former case it is not necessary to bring home to the infringer knowledge of the existence of copyright (save when the defence is raised that the proprietor has failed to mark properly articles sold by him); in the second case complicity is of the essence of the infringement. It is advisable, therefore, before proceeding against a dealer to serve him with a notice which will distinctly show that the design has been applied without the proprietor's consent.

The general prohibition "to do anything with a view

to enable the design to be so applied" hits aiders and abettors, for instance the artist who copies a registered design on paper to enable a manufacturer to commit an act of piracy, or a die-stamper who supplies dies expressly for the purpose of enabling the design to be applied to articles; but does not affect a man who in the course of his business manufactures ordinary articles of commerce to which any design can be applied, or sells a tool having general uses, without intending that it should be used for unlawful purposes in other hands.

The Act only forbids unauthorised reproduction for purposes of sale or dealing with a view to sale. Thus, it is no infringement to make an article from or according to the design when not for the purpose of sale, or to use that article in any way, provided that the article, if made while the copyright is in force, is not afterwards published or exposed for sale. In this respect there is an important difference between a design copyright and a patent.

Only piracy within the United Kingdom and the Isle of Man is actionable under the law of this country; but infringement is not averted by the circumstance that articles, the publication or exposure for sale of which is complained of, were imported from abroad.

The fact that subsequent to the registration a patent has been granted to an alleged infringer for the manufacture of the article to which the design is applied is immaterial to the question of piracy, even although the patentee may be able to maintain the patent as against the proprietor of the design.

REMEDIES FOR INFRINGEMENT.

DEFENCES.

Any person infringing the copyright in a design is liable for each offence to pay to the registered proprietor a sum not exceeding £50, recoverable as a simple contract debt; the total sum recoverable in respect of one design may not, however, exceed £100.

Alternatively, if the proprietor elects to bring an action for the recovery of damages for such infringement, and for an injunction against a repetition of the offence, the infringer will be liable to pay such damages as may be awarded and to be restrained by injunction accordingly.

The proprietor cannot recover both penalties and damages, but must decide which to claim at the time of bringing the suit. As a rule, however, proceedings for penalties are to be recommended, on account of the difficulty likely to be met in proving damages; this, again, is partly balanced by the drawback that when penalties are claimed the defendant cannot be ordered to answer interrogatories tending to incriminate himself.

Where the alleged infringer is only a dealer, it is advisable to notify him in advance that the sale of the articles in which he is dealing is regarded as an infringement of the copyright, and to call for discontinuance of the sale on pain of proceedings being brought against him for piracy: otherwise it is necessary to show that the alleged infringer knew of the piracy.

Where, however, the infringer is accused of having

applied the pirate design or having caused the same to be applied, guilty knowledge need not be proved and there is no obligation to give notice.

Even in the case where the infringer pleads innocence, the proprietor may press for an injunction if there is any likelihood of the infringement being repeated. A trivial action, however, is liable to be dismissed with costs.

In a proper case the proprietor may make a manufacturer of, and a dealer in, pirated articles joint defendants to an action, or he may sue both parties separately.

The right to sue is given only to the registered proprietor, who should in his pleading allege that prior to publication he caused a proper entry of the design to be made in the register, that at the date of registration the design was new or original and had not been previously published in the United Kingdom, and that the defendant has applied the design or caused the same to be applied without the licence or written consent of the registered proprietor, or has done something with a view to enable the design to be so applied, or has published or exposed the article for sale knowing of the piracy, as the case may be.

The defendant may deny the plaintiff's title to sue, and may plead that he has not committed any offence within the meaning of the Act, or that the registration is invalid, and that therefore there is no copyright to be infringed; in the last case he should, as a party aggrieved, move the Court to expunge the entry of the design from the register.

Where a defendant calls in question the right of the plaintiff to be on the register, the burden of proof is on the person impeaching the title of the registered proprietor.

A defendant who pleads that he has committed no offence may rely on the fact that the design used by him is not the registered design or a fraudulent or obvious imitation: that he did not apply the design or cause the same to be applied or do anything with a view to enable the same to be applied, or in any event that he did not do

so for purposes of sale; that he did not expose or publish for sale articles to which the design was applied, or, if he did so, did not know that the design was applied without the consent of the registered proprietor; that the articles in respect of which infringement is alleged do not belong to the class or classes in which the plaintiff's design is registered; or that the alleged infringement took place before the actual registration or after the copyright had expired.

If the defendant pleads that the registration is invalid, he may allege that the design was not proper subject matter for registration; that it was published prior to the date of registration; that it was not new or original; that the person in whose name registration was effected was not the proprietor; that the proprietor delivered articles for sale before filing the proper number of representations or specimens; and that the design is used for manufacture mainly or exclusively outside the United Kingdom.

The defendant may further allege that the proprietor had not caused articles to be properly marked, and may rely on the defence that he did not know and had no notice of the existence of the copyright: he may also plead the statute of limitations.

In the case where penalties are claimed the defendant may also plead extenuating circumstances with a view to inducing the Court to impose only a nominal penalty.

The trial of the action is conducted in much the same manner as in a patent infringement suit.

The law does not impose on the plaintiff any particular mode of proving his case, but permits him to rely on whatever evidence may be available, both documentary evidence and the oral testimony of witnesses.

Experts may be called upon to testify as to features of resemblance between the designs of the plaintiff and the defendant, but the decision whether there is infringement or not is determined by the Court, and by the Court alone.

If the plaintiff is successful, he will, in addition to penalties, or damages, be entitled to his costs from the defendant, or, if unsuccessful, he may be ordered to pay costs, subject in either case to a set-off on account of issues improperly raised.

Should the Court certify that the validity of the copyright came in question, then in any subsequent action for infringement of the copyright, the plaintiff in that action on obtaining a final order or judgment in his favour will, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client.

Where judgment is given against him, the defendant will also be ordered to deliver up, to be destroyed, all articles in his possession bearing the infringing design, and any patterns, dies, moulds or other things used by him in making the same.

From the judgment of the Court in the first instance either party has the right to appeal to the next Court above, and finally to the House of Lords.

THE LAW OF TRADE MARKS.

INTRODUCTORY.

The practice of affixing trade marks to goods for the purpose of identifying their trade source dates back to times of the most primitive culture. Of equal antiquity is the art of counterfeiting the marks used on well-favoured goods with a view to getting the custom meant for the person whose mark is copied.

The idea, however, that trade marks deserve the same legal protection that is given to other property has been slow in gaining ground, and in fact it can hardly be said that property in trade marks was recognised in this country prior to the last century.

Before the introduction of any statute relating to trade marks, however, certain fundamental principles had been definitely established, and conforming as these do with the general sense of commercial honesty it is not likely that they will be hereafter departed from.

It is now universally recognised that a person may appropriate for his trade a trade mark, and that, having made an honest reputation in connexion with the trade mark, he shall not be deprived of it by the action of another who, instead of relying on the merits of his goods and choosing an independent mark of his own, selects a mark sufficiently like that of his successful rival to deceive the customers of the former into purchasing goods which they had not intended to take.

As is frequently stated, no man has a right to pass off

his goods as those of another, whether by copying his trade mark or otherwise, and the Court will interfere to protect the trader whose mark is thus copied, not only as a matter of justice to him, but to prevent imposition upon the public.

It might appear at first sight that a charge of passing-off should be readily capable of proof; as a matter of fact, few legal questions involve as much difficulty. This is due not only to the multitudinous and divergent methods adopted by those who practise the art of passing-off, but largely also to the difficulty of ascertaining the legal rights of the parties who consider themselves injured. It is often found that the same mark is honestly used by several traders in different parts of the country, making it impossible to determine whose goods are known to the public by the mark in question; or it may be that a trader claims as his trade mark what is simply a description of the goods he deals in, the only name perhaps which the goods bear, and which indicates to the public not his goods but a particular kind of goods.

Various rules have been formulated for ascertaining with whom rests the property in a trade mark. In general, priority of adoption is taken to give the least disputable right, but this may be lost, if, before the mark has come to be recognised as denoting the goods of the first user, it is publicly used by others for the same description of goods. In the extreme case the first to use a mark may find himself threatened by a powerful rival, who, having advertised the mark widely, claims that it denotes his goods in the market and his only.

The establishment of the register of trade marks has gone far to reduce confusion while also facilitating the suppression of many forms of unfair competition.

The registration of a trade mark is, in fact, an official confirmation that a mark has been appropriated by a particular trader, and a warning to others to refrain from copying it.

A technical definition of a registrable trade mark has been enunciated, and subject to conditions enumerated in the Act any trade mark conforming with the definition may be registered in respect of particular goods; the registration, if valid, giving the registered proprietor the exclusive right to the use of that mark upon or in connexion with such goods.

The definition of a registrable trade mark has been made as wide as possible, but at the same time it has been sought to minimise the confusion that occurs too often in the case of unregistered marks, by imposing restrictions which will exclude more particularly marks calculated to deceive, and marks bound to deceive.

The purity of the register is also maintained by provisions for cancelling marks improperly registered or in respect of which the right to maintain the same on the register has been forfeited.

Allowance has been made for the fact that the same or similar marks are frequently used by a number of people in different trades, by assorting goods into fifty different classes, so that registration in one class will not necessarily prevent registration in another class: it is open, however, for any trader to register in as many classes as are necessary to cover all the goods for which his mark is used.

The proprietor of a trade mark entered in the register is not limited to the protection afforded by the Trade Marks Act, 1905. He has the further right to institute criminal proceedings for infringement under the Merchandise Marks Acts, and he has also the remedy possessed by the owner of an unregistered mark, trade name, *etc.*, that of an action for passing-off.

Registration has other advantages. It gives a definite date for the appropriation of a trade mark, which cannot afterwards be denied by competitors of the proprietor. It also entitles the proprietor to use the word 'registered' in connexion with his trade mark, which is in itself an effective guarantee against infringement.

It may further be pointed out that the trader who applies for registration as soon as he selects a mark that he proposes to appropriate will learn immediately, before incurring expenditure in advertisements, *etc.*, whether his mark is likely to receive any legal protection at all, or whether user of the mark would constitute infringement of the rights of another. Still another consideration, often overlooked, is that unless and until he registers his mark in this country it is practically impossible for a British trader to obtain any protection for it abroad.

The following pages contain a summary of the practice in connexion with the registration of trade marks and its consequences, supplemented by a short note regarding actions for passing-off and prosecutions under the Merchandise Marks Acts. We trust that the information given will be found useful not only by persons having registered or intending to register trade marks but also by manufacturers and merchants dealing in goods in respect of which rights under trade marks, trade names, *etc.*, are claimed.

REGISTER OF TRADE MARKS.

The register of trade marks is a book kept at the Patent Office wherein are entered all registered trade marks with the names, addresses and descriptions of their proprietors, the date of application of every mark with the list of goods for which it is registered and the class of registration, and notifications of assignments and transmissions, disclaimers, conditions, limitations, renewals and orders of the Court with reference to trade marks.

The register is kept under the control and management of the Registrar, who is the Comptroller-General of Patents, Designs and Trade Marks.

There is also kept at Manchester a copy of the register in so far as it relates to cotton marks, and a branch register is kept at Sheffield of trade marks for metal goods belonging to persons carrying on business in Hallamshire or within six miles thereof.

The register is open to the inspection of the public, and certified copies, sealed with the seal of the Patent Office, of any entry in the register will be given to any person requiring the same.

Printed or written copies or extracts of or from the register, purporting to be certified by the Registrar and sealed with the seal of the Patent Office, are admitted in evidence in all courts in His Majesty's dominions, and in all proceedings without further proof or production of the originals.

A certificate purporting to be under the hand of the

Registrar as to any entry, matter, or thing which he is authorised to make or do, is *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register or in the Manchester register a certificate under the hand of the Master of the Cutlers' Company or under the hand of the Keeper of cotton marks has the same effect as the certificate of the Registrar.

REGISTRABLE TRADE MARKS.

The Trade Marks Act defines the terms ' mark,' ' trade mark ' and ' registrable trade mark.'

A ' mark ' includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.

A ' trade mark ' means a mark used upon or in connexion with goods¹ for the purpose of indicating that they are the goods of the proprietor of the trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale.

A registrable trade mark must contain or consist of at least one of the following essential particulars :—

- (1) The name of a company, individual, or firm represented in a special or particular manner :
- (2) The signature of the applicant for registration or some predecessor in his business :
- (3) An invented word or invented words :
- (4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname :

¹ User upon or in connexion with goods is an indispensable qualification of a trade mark ; mere trading names or names given to business premises are not trade marks and are not registrable as such.

- (5) Any other distinctive mark; but a name, signature, or word or words, other than any of those mentioned in the preceding paragraphs will not, except by order of the Board of Trade or the Court, be deemed a distinctive mark.

Provided that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the 13th August, 1875, which has continued to be used (either in its original form or with additions or alterations not substantially affecting its identity) down to the date of the application for registration may be registered as a trade mark.

For the purposes of the above definition 'distinctive' means adapted to distinguish the goods of the proprietor of the trade mark from those of other persons. In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered the trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

Passing from the general definition to particular cases, it may be noted that practically no representation of the name of a company, individual or firm, which consists of letter-press alone, is considered special or particular so as to be acceptable as a new mark, nor does such a mark usually possess the qualification of distinctiveness, which is an indispensable precedent to valid registration.

On the other hand, facsimiles of signatures have always been accepted for registration; it should be borne in mind, however, that registration of the signature of one person does not necessarily debar registration or use of the signature of another person of the same name who is using his signature honestly.

A signature, to be registrable, must be that of the trading style under which the applicant has a *bonâ fide* right to

trade and which consists of a personal name or names, and does not include mere descriptive trading styles.

Invented words are perhaps the most popular of trade marks.

For such a mark invention is the sole qualification required for registration: if a word is invented, if it is new and freshly coined, it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character and quality of the goods. Such a word must, however, be one which did not exist before: it must not be an old word used for the first time in a new sense. For the purpose of the Act it must be invented for use as a trade mark, substantially at the date of the application for registration, or, at least, invented at the time of its adoption as a trade mark, and still distinctive at the date of registration.

The person seeking to register an invented word as a trade mark need not be the actual inventor of the word: conversely, if the word has already a definite meaning, for instance in a foreign language, ignorance of such meaning on the part of the applicant will not import the quality of invention into the trade mark.

The junction of two English words is not necessarily an invented word, even although the combination may not have been in use before: nor is a mere variation of the orthography or termination of a word necessarily sufficient to constitute an invented word, if to the eye or ear the same idea is conveyed as by the word in its ordinary form.

There is, in fact, a certain analogy between the patent practice and that of trade marks as regards the interpretation of 'invention'; but this analogy cannot be stretched too far.

A word which has already found a place in English or in other languages can only be accepted by the Registrar provided it has no direct reference to the character or

quality of the goods, and is not according to its ordinary signification a geographical name or a surname.

Thus, purely descriptive words are refused registration : otherwise, liberty of the public to the use of the English language would be unduly abridged. A word is not necessarily non-descriptive merely because from the description alone no one could possibly make the article denoted thereby, or form an absolute and definite conclusion as to what character or shape the article would take; or in the case of a trade mark for a chemical product, the word does not give sufficient information to enable anyone to make the product in question, when it is in reality a specification, more or less complete, of its ingredients. Where, however, the connexion between a word and the character or quality of the goods is purely fanciful, and no one would be injured by registration, this limitation does not apply.

Many words have a double meaning. For instance, 'Magnolia' is the name of a flower, and also the name of a town: 'Swan' is the name of a bird, and also a surname. Where in its primary meaning any such word is either a geographical name or a surname, an application for registration will be rejected by the Registrar; but where the geographical or surnominal meaning is merely secondary, and the word has also a distinct meaning which is not generic or descriptive, the objection to registration no longer exists.

The objection to geographical names is not confined to the substantive, but extends to the adjectival form. Similarly, a surname held to be a generic name is not rendered distinctive by being put in the possessive case. Names of characters in fiction and names of celebrities are on a different footing from ordinary surnames. The first of these, if not also surnames, are capable of registration as words having no direct reference to the character or quality of the goods; names of historical personages are also accepted for registration, but only when associated with portraits of the personages in question, or along with other distinctive matter.

Cases often arise in which a trader thinks he has adopted a proper trade mark, and yet on investigation it is found that the word he has chosen is outside the definition of a registrable mark. Again, though a given word may, after argument, be decided to be capable of protection, yet the matter is so much on the border-line that much discussion can be raised before a final decision is reached.

It is very greatly to the advantage of a person adopting a new word mark—it being immaterial to him what word he adopts—to choose a word open to little or no discussion and which clearly falls within the numbered paragraphs (3) and (4) of the definition. In case of doubt, any such word mark may be submitted in advance to the Registrar for his opinion as to its suitability for registration.

“Any other distinctive mark” included in the above numbered paragraph (5) may be a distinctive device, a distinctive brand, a distinctive heading, a distinctive label, a distinctive ticket, a distinctive letter, a distinctive numeral, or a distinctive combination of any of these particulars; any such mark may be accepted by the Registrar.

Devices have long been used as trade marks, and are still largely used on account of the pictorial aid they lend to advertisements and of their independence of language which renders them equally intelligible to customers of all nations.

The term ‘device’ includes a geometrical symbol, a real or conventional representation of some animate or inanimate object, *e.g.*, of a flower, an animal, *etc.*, a portrait, a crest, or a picture or drawing.

To constitute a registrable trade mark a device must be distinctive, and not common to the particular trade. A combination of devices none of which is distinctive alone may constitute a single trade mark; within limits, however, the simpler the device the better is it adapted for use as a trade mark. A device which consists of a pictorial representation of the articles to be covered by the registration will not be accepted, unless the picture is distinctive independently of the articles it is supposed to represent.

Labels usually consist of letter-press alone or of letter-press and a device. In practice a label is considered distinctive if distinctive as a whole, irrespective of the distinctiveness of its parts.

The same is true of brands and tickets, the difference between which and labels is but a variation in the mode of application to the goods or the case containing the goods.

The chief use of headings is in connexion with piece goods: as will be seen later, however, no exclusive right is conferred by the Act in respect of line headings for cotton piece goods.

In the cotton trade more particularly it is not uncommon to use at once a label or several labels and a ticket with or without a heading; the combination being the trade mark. Such a combination may be validly registered as a single mark; it being immaterial that part only of the trade mark is visible at one time. If any part of such a combination mark is distinctive in itself, it will usually be desirable also to register such part separately.

A combination of letters not forming a word may constitute a distinctive mark within the meaning of the above numbered paragraph (5) in which case it may be accepted by the Registrar. As a rule the Registrar calls for evidence that the mark is distinctive and decides the question on such evidence.

Some of the most valuable marks consist of names or words which have 'caught on' with the public, but which do not fall within the categories of arbitrary or invented words, or besides distinguishing the goods of the proprietor also distinguish the goods irrespective of the proprietor; such words are not excluded from registration, but if first used as trade marks after the 13th August, 1875, can only be registered alone by order of the Board of Trade or the Court, as provided for in the above numbered paragraph (5).

An apparent exception is made in the case of a name given to a patented or monopolized article; in such a case

it becomes a question whether the name is simply the name of the article, or whether it denotes also the trade source of the article. In the former case the name ceases to be distinctive when the patent or monopoly expires: in the latter case the name may remain a trade mark.

Special provision is made for trade marks which were in use before the passing of the first Trade Marks Act in 1875, but which cannot now be registered as new marks.

The first requirement for registration as an old mark is that the mark shall be special or distinctive, that is, special or distinctive at the date of registration. There is no definition in the Act of the term 'special' but from decisions in cases under former Acts it appears that 'special' means of such a character that the mark separates the article to which it is applied from all others of the same class or character: the term 'distinctive' is defined above as meaning adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

To be registrable as an old mark, the mark must have been used before the 13th August, 1875, as a trade mark in this country, i.e., actually applied to or accompanying the goods to the market. It is not sufficient that the mark may have been used on invoices, or in catalogues or advertisements, or even on packages used in transporting the goods.

A mark claimed to be an old mark must have been used by itself, without the addition of other matter, and must have continued to be used in the form in which it was used before the 13th August, 1875, or with additions or alterations not substantially affecting its identity.

A trade mark may be limited in whole or in part to one or more specified colours, and in that case the fact that it is so limited is taken into consideration in deciding on the distinctive character of the trade mark. A trade mark, if registered without limitation of colour, is deemed to be registered for all colours.

RESTRICTIONS ON REGISTRATION.

The Registrar cannot enter upon the register a mark which does not conform with the definition of a registrable trade mark contained in the preceding chapter, nor can he register every mark covered by the definition; on the contrary, various provisions forbid expressly the registration of certain kinds of trade marks.

In the words of the Act, 'it shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would, by reason of its being calculated to deceive, or otherwise, be disentitled to protection in a Court of Justice, or would be contrary to law or morality, or any scandalous design.'

It is a general rule that a trade mark to be capable of protection must be truthful. Honest competition is the requirement of the law, and the Court is as ready to dismiss the suit of a plaintiff whose trade mark is calculated to deceive the public into a belief that his goods are something other than they actually are as it is to enjoin a defendant who has infringed an honest trade mark.

The exception from the benefits of registration of trade marks the use of which is calculated to deceive is not confined to those which are in themselves inherently deceptive, but also applies to cases in which by reason of the resemblance of the mark to the recognised mark of another person, whether registered or not, the public of this country would be liable to confuse the goods of one person with those of the other.

In making a comparison of two marks with the object of deciding whether one has a deceptive resemblance to the other, it must be considered not only how far similarity is suggested to the eye or the ear, but how the marks will be known on the market—not only in this country, but also abroad.

For this purpose the marks must be compared as fairly used in practice, attention being given to the appearance of the marks as applied to the goods rather than to their appearance side by side on paper, and, if need be, to resemblances shown by coloured impressions not observable in black and white. Regard must also be had to all the circumstances of the trade in connexion with which the marks are used, to the ideas suggested by the marks under comparison, and to the number of other marks having a resemblance to the marks in question.

In certain cases representations artistically distinct may be held to show a deceptive resemblance to each other, when in the market the goods will be called by the same name; the same is true of words having the same meaning in different languages. Similarity may also exist between a picture-mark and a word-mark, when the word is the name of the object represented in the picture. On the other hand, a mark is not calculated to deceive merely because it contains some common or non-distinctive feature also contained in the mark of another person.

It is evident that in any case confusion can only arise when the marks of the two traders refer to the same or similar goods, or at least to goods which have some connexion with each other. In deciding whether goods are of the same description consideration must be given not only to the uses of the goods in question, but also to the circumstance whether they are usually sold by the same dealers or bought by the same customers. The system of classification affords only a confirmatory test.

In the case where one of two interfering marks is already on the register, the existing registration is made an

express ground of rejecting a later application on an inferior title, even in the case where the second mark is not necessarily disentitled to protection in a Court of Justice; on the other hand, provision is made for admitting to the benefits of registration the mark of a trader having an equal right to that of the owner of the mark already registered.

As provided by the Act, except by order of the Court or in the case of trade marks in use before the 13th August, 1875, no trade mark may be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor which is already on the register with respect to such goods or description of goods or so nearly resembling such a trade mark as to be calculated to deceive.

A person wishing to adopt a trade mark which will not interfere with any existing registration, may make application to the Registrar to cause a search to be made to ascertain if any marks are on record at the date of the search which may resemble the proposed mark: a private search may also be made amongst the classified representations of trade marks at the Patent Office.

Where each of several applicants for registration claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or description of goods, and to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or (on appeal) by the Board of Trade.

In case of honest concurrent user, or of other special circumstances which, in the opinion of the Court, make it proper so to do, the Court may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one proprietor, subject to such conditions and limitations, if any, as to mode or place of user or otherwise, as it may think it right to impose.

Other restrictions on registration are imposed by the Patent Office :

Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a mark unless such groundwork is included within the mark by a border or lines.

Applications may be refused in cases where the following appear upon the representations of trade marks forming part of an application :—

- (a) The words "Patent," "Patented," "By Royal Letters Patent," "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is Forgery," or words to like effect.
- (b) Representations of Their Majesties or of any member of the Royal Family.

The following also may not appear on trade marks, the registration of which is applied for, unless the marks have been used since before 13th August, 1875 :—

- (a) The Royal Arms or Royal Crests, or arms or crests so nearly resembling them as to lead to mistake.
- (b) British Royal Crowns.
- (c) British National Flags.
- (d) The word "Royal" or any other words, letters or devices calculated to lead persons to think that the applicant has Royal patronage or authorisation.

In cases where representations of the arms of a foreign state or place appear on a mark, the Registrar may call for such justification as he may deem necessary for their use.

In cases where the following appear on a mark, the Registrar may require to be furnished with consents from

such officials, persons, or their legal representatives, as he may consider necessary :—

- (a) Representations of the arms or emblems of any city, borough, town, place, society, body corporate, or institution.
- (b) Names or representations of living persons or persons recently dead.

There is an unwritten rule to refuse to register in respect of chemical products, surgical appliances, and the like, marks containing representations of the Red Cross.

A representation of one medal cannot be registered as a distinctive device; but a combination of medals may be registered, subject to the applicant justifying his use of the medals.

Where there appears on the face of a trade mark the name or a description of the goods to which the mark is applied, the Registrar may refuse to register the mark in respect of any goods other than those so named or described. Where the name or description of any goods appearing on a trade mark varies in use, the applicant may state in his application that the name or description varies.

THE APPLICANT FOR REGISTRATION.

Any person claiming to be the proprietor of a trade mark, whether a British subject or not, may make an application for the registration of the same in the United Kingdom.

The proprietor is the person who has acquired rights by public user of the trade mark in respect of the goods for which registration is sought, either by himself or by his predecessor in business, or who has invented or designed or selected or caused to be invented or designed or selected a mark which is new in respect of the goods for which it is proposed to be used by him.

In the case of goods imported into this country there are often found on the same article the mark of a foreign house and the mark of the importer; similarly, an article comprising several parts may bear the marks of the manufacturers of the various parts and also the mark of the maker who has assembled the parts to form the complete article. Each of such parties is entitled to register his own mark for the goods produced or supplied by him.

Property in a trade mark can be possessed not only by an individual but also by a firm or partnership, or a body corporate, by an association, or a state department. It is not essential that the proprietor be a trader pure and simple—the extreme instances may be cited of a foreign sovereign and of a religious body owning trade marks. In every case, however, the proprietor must be the person whose goods are denoted by the trade mark, whether the goods are his by virtue of manufacture, selection, certifi-

cation, dealing with or offering for sale; no proprietary right is acquired by one who is merely an agent or consignee of goods which are distinguished in the market only by the trade mark of the producer.

A trader is not confined to the registration of a single trade mark. He may register as many trade marks as he uses or a less number than he uses; only, he cannot validly register marks which he does not use or intend to use.

In practice the majority of applicants for registration are represented by authorised agents who act in their name, not only in lodging the applications but also in attending to the various formalities up to and after registration. For this purpose our services are available to clients who contemplate registering trade marks, or who have lodged applications to register or are already the registered proprietors of trade marks.

THE APPLICATION TO REGISTER.

Every application to register a trade mark other than a cotton mark, or a Sheffield mark, must be left at the Patent Office, addressed to the Registrar.

The application to the Registrar is made in writing, on a form bearing an impressed stamp of 10s., to which is affixed a representation of the mark, and which must be accompanied by four additional representations agreeing in every respect with that on the application form.

In exceptional cases there may be deposited specimens or copies of trade marks which cannot conveniently be shown by representations.

When an application is made for the registration of a series of trade marks, a representation of each trade mark of the series must be affixed to the application form and to each of the accompanying sheets on which the representations are mounted.

The applicant must state the class in which registration is required, and must specify the goods for which the mark is used or proposed to be used: where the goods in question belong to different classes, a separate and distinct application is necessary in each class in which protection is desired.

Where an application is made to register a trade mark which was used by the applicant or his predecessors in business before the 13th August, 1875, the application must also contain a statement of the time during which and by whom it has been used in respect of the goods mentioned

in the application. The Registrar may require a statutory declaration verifying such user with exhibits showing the mark as used.

The case of applications to register marks consisting of distinctive names, signatures, or words which are only registrable by order of the Board of Trade or the Court is discussed in a separate chapter.

PROCEDURE ON RECEIPT OF THE APPLICATION.

Upon receipt of an application to register a trade mark an acknowledgment, stamped with the registration number, is given to the applicant, and an entry is made in the official application book.

The documents are then referred to an official searcher, who searches amongst the registered marks and pending applications for the purpose of ascertaining whether there are on record any marks for the same goods or description of goods identical with the mark applied for or so nearly resembling it as to be calculated to deceive.

The application is further considered with reference to the question whether the proposed mark contains or consists of one of the essential features of a registrable trade mark, and whether it consists of or contains matter calculated to deceive, or the use of which would be contrary to law or morality, or any scandalous design.

With this object, dictionaries in various languages are consulted to ascertain whether a word put forward is invented, or, if it is already in existence, whether it has a descriptive meaning; gazetteers are searched to ascertain whether a word is geographical; and directories are examined to ascertain whether a word is an existing surname.

If, after the search and a consideration of the application, the Registrar thinks there is no objection to the mark being registered, he may accept it absolutely or subject to

conditions, amendments and modifications which he communicates to the applicant. Conditions frequently imposed are the insertion of a disclaimer in the application, limitation of the list of goods, and the association of the registration with another registration of the same proprietor.

If, after the search and consideration of the application, any objections appear, a statement of these objections is sent to the applicant.

If the applicant does not agree to the proposed conditions, amendments or modifications, or differs in opinion from the Registrar, he may reply to the statement in writing or apply for a hearing, and, unless he does so or complies with the requirements within one month, is deemed to have withdrawn his application.

If the objection to the application is based on the registration of marks of other persons which are not substantially identical with that applied for, or do not refer to the same goods, the application may be permitted to proceed, subject to the applicant producing letters of consent from the owners of the other marks.

In the event of the case coming to a hearing, the applicant is not confined to any written statement he may have made, but may advance every and any available argument in support of his application. In a large proportion of the cases that are heard by the Registrar the applications are eventually accepted, if need be, with slight modifications.

The final decision of the Registrar, if unfavourable, is communicated to the applicant in writing, and if the applicant objects to the decision, he may, within one month, require the Registrar to state in writing the grounds of the decision and the materials used by him in arriving at it. Thereupon the Registrar sends him a statement of the grounds of his decision; and the date when the statement is sent is deemed to be the date of the Registrar's decision for the purpose of appeal.

Where, by reason of default on the part of the applicant, the registration of a trade mark is not completed within twelve months from the date of the application, the Registrar gives notice of the non-completion to the applicant. If after fourteen days from the date when the notice was sent the registration is not completed, the application is deemed to be abandoned: where the applicant lives at a distance, however, the Registrar may give a further time for the completion of the application.

APPEALS.

The decision of the Registrar refusing to accept an application, or imposing any condition on the acceptance is subject to appeal to the Board of Trade or to the Court¹ at the option of the applicant.

An appeal to the Court must be made by motion in the usual way; no appeal will be entertained unless notice of motion be given within one month from the date of the decision appealed against, or within such further time as the Registrar may allow. On appeal the Court will, if required, hear the applicant and the Registrar and make an order determining whether and subject to what conditions, if any, registration is to be permitted.

Notice of motion must be served on the Registrar in all cases, and where the Registrar has objected to the application on the ground that it resembles trade marks already registered, the applicant may be directed to give notice of the appeal to the proprietors of such marks, who may be made parties to the proceeding. The costs of the individual parties and of the Registrar are in the discretion of the Court, but the Registrar will not be ordered to pay the costs of any other of the parties.

As regards the Registrar's costs the general rule in the case of persons occupying a fiduciary position is applicable, *i.e.*, the Registrar receives his costs even if the

¹ *i.e.*, the Chancery Division of the High Court of Justice in England, or, in the case of cotton marks, the Court of Chancery of the County Palatine of Lancaster.

applicant is successful, unless he has done anything to disentitle him to costs.

Where an order has been made by the Court in favour of an application, the applicant must leave at the Office an office copy of the order.

From the decision of the Court in the first instance an appeal may be taken to the Court of Appeal and thence to the House of Lords.

When any person intends to appeal to the Board of Trade, he must, before doing so, apply to the Registrar for a hearing and obtain a decision from him upon the point raised. Within one month from the date of such decision he must, if he is advised to appeal to the Board of Trade, leave at the Patent Office a notice of such his intention, accompanied by a statement in writing of the grounds of appeal, and of his case in support thereof.

A copy of the notice and all the accompanying documents must also be forthwith sent by the appellant to the Secretary of the Board of Trade.

The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to parties and evidence, or otherwise, for the purpose of the hearing of the appeal.

Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, is given to the Registrar and to the appellant of the time and place appointed for the hearing.

No appeal will be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Registrar may allow, except by special leave of the Board of Trade.

The Board may either hear the appellant and the Registrar and decide the case, or may, if they think fit, refer the appeal to the Court in lieu of hearing and deciding it

themselves, but, unless the appeal is so referred, it is finally decided by the Board.

Appeals are heard on the materials stated by the Registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application will be allowed to be taken by the Registrar, other than those stated by him, except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken, the applicant will be entitled to withdraw his application without payment of costs on giving notice within seven days to the Registrar and to the other parties concerned.

The Board of Trade or the Court may at any time, whether before or after acceptance, correct any error in or in connexion with an application, or may permit the applicant to amend his application upon such terms as they may think fit.

SPECIAL APPLICATIONS.

Where the mark propounded consists of a distinctive name, signature, word or words which can only be registered by order of the Board of Trade or the Court, the application must be made to the Registrar on a special form intimating the applicant's desire for an order directing registration.

Upon receipt of the application the Registrar causes a search to be made amongst the registered marks and pending applications for the purpose of ascertaining whether there are on record any marks for the same goods or description of goods identical with the mark applied for or so nearly resembling it as to be calculated to deceive.

If after the search the Registrar thinks there are no such marks, he notifies the applicant accordingly, but if any such marks appear, he notifies to the applicant the numbers of these marks and the Journals (if any) in which they have been advertised.

Within one month from the receipt of the notification the applicant must send to the Registrar in writing a case in duplicate stating at length the grounds upon which he relies in support of his application, and whether he desires to be heard by the Board of Trade or by the Court; if he fails to do so, his application is deemed to be withdrawn.

If the applicant desires to be heard by the Board of Trade, he must send with his case a form of application to the Board. Thereupon the Registrar sends the case to the Board of Trade, together with a copy of all communications that have passed between him and the applicant.

Upon receipt of the case the Board of Trade will, if the applicant desires to be heard by them, fix a day for the hearing at which the applicant and the Registrar may attend and be heard, and the Board will make an order determining whether and subject to what conditions, amendments, or modifications, if any, the application is to be accepted, or may require the applicant to apply to the Court within a time fixed by the Board.

Prior to acceptance of a special application, the Board of Trade require, as a rule, to be furnished with evidence, by way of statutory declaration, of the distinctive nature of the mark.

If the applicant desires to obtain an order of the Court, he must, within one month from sending his case to the Registrar, bring the matter before the Court by motion, and if he does not do so he is deemed to have withdrawn his application.

If the application is accepted either by the Board of Trade or the Court, it is advertised, and proceedings thereafter are had in respect of it as if it had been accepted by the Registrar in the ordinary course.

ADVERTISEMENT.

When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions, it is advertised in the *Trade Marks Journal*; the advertisement setting forth all conditions subject to which the application has been accepted.

For the purposes of the advertisement the applicant is required, except in the case of certain cotton marks, to furnish a wood-block or electrotpe (or more than one, if necessary) of the trade mark, or any such other information or means of advertising the trade mark as may be required by the Registrar. In the case of an application to register a 'series' of trade marks the applicant may be required to furnish a wood-block or electrotpe of any or of each of the trade marks constituting the series; or the Registrar may insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.

The wood blocks or electrotypes must correspond exactly with the representations, except in size, must afford perfectly distinct impressions, and must be upon a scale sufficiently large to reproduce the marks faithfully. The largest space available for the insertion of any single block or electrotpe is $5\frac{1}{2}$ inches broad by $7\frac{1}{2}$ inches deep. When a block or electrotpe exceeds 2 inches in breadth or depth, or in breadth and depth, a charge is made for additional space.

If no representation of the trade mark is inserted in connexion with the advertisement, the Registrar refers in the advertisement to the place or places where a specimen

or representation of the trade mark is deposited for exhibition.

After the advertisement of a trade mark the block or electrotype cannot in any case be returned to the applicant, even for temporary use.

OPPOSITION.

Within one month from the date of the advertisement in the *Trade Marks Journal* of an application for registration of a trade mark, or such further time before the entry of the mark on the register as the Registrar may allow, any person interested may give notice at the Patent Office of opposition to the registration.

The notice of opposition must contain a statement of the grounds upon which the opponent objects to the registration and must be accompanied by a duplicate which the Registrar transmits to the applicant.

The following are the usual grounds of opposition : (1) that the mark is identical with or resembles a mark already on the register, in the name of the opponent, in respect of the same goods or description of goods; (2) that the mark does not consist of or contain any of the essential particulars required of a registrable trade mark; (3) that the mark is calculated to deceive or otherwise disentitled to protection; (4) that the registration of the mark would interfere with the use of a mark which the opponent is using; or (5) that the opponent has himself rights in the mark applied for.

Within one month from the receipt of the duplicate of the notice of opposition, the applicant must send to the Registrar a counterstatement in writing setting out the grounds on which he relies as supporting his application, and also setting out what facts, if any, alleged in the notice of opposition he admits. The counterstatement must further be accompanied by a duplicate, which the Registrar transmits to the opponent.

Within one month from the receipt of the duplicate, the opponent must leave at the Office such evidence by way of statutory declaration as he may desire to adduce in support of his opposition, copies of which he must deliver to the applicant.

If an opponent leaves no evidence, he is deemed to have abandoned his opposition; but if he does, then within one month from the receipt of the copies of the declarations, the applicant must leave at the Office such evidence by way of statutory declaration as he desires to adduce in support of his application, copies of which he must deliver to the opponent.

Within fourteen days from the receipt of the copies of the applicant's declarations, the opponent may leave at the Office evidence by way of statutory declaration in reply, and deliver copies to the applicant.

The Registrar may at any time give leave to either the applicant or the opponent to file further evidence upon such terms as to costs or otherwise as the Registrar may think fit.

Where any extension of time is granted to any party, the Registrar may thereafter, if he thinks fit, without giving that party a hearing, grant any reasonable extension of time to the other party in which to take any subsequent step.

Upon completion of the evidence, the Registrar gives notice to the parties of a date when he will hear the arguments in the case. Such appointment must be for a date at least fourteen days after the date of the notice, unless the parties consent to a shorter notice. Within seven days from the receipt of such notice, both parties must file a form of application for a hearing. A party who receives a notice and who does not, within seven days, apply for a hearing, may be treated as not desiring to be heard, and the Registrar may act accordingly.

The Registrar may in any case in which he thinks he

ought so to do (with the consent of the parties) take evidence *viva voce* in lieu of or in addition to evidence by declaration. In this case the Registrar will, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.

After hearing the parties and considering the evidence, the Registrar decides whether, and subject to what conditions, registration is to be permitted.

The decision of the Registrar is subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.

In the case of an appeal to the Court the statutory declarations filed at the Office may be used before the Court in lieu of evidence by affidavit; but, if so used, will have all the incidents and consequences of evidence by affidavit.

An appeal to the Court must be made by motion in the usual way; no appeal will be entertained unless notice of motion be given within one month from the date of the decision appealed against, or within such further time as the Registrar may allow.

The Court will then hear the parties and the Registrar, and make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

From the decision of the Court in the first instance an appeal may be taken to the Court of Appeal and thence to the House of Lords.

When an order has been made by the Court, the person in whose favour the order has been made, or such one of them, if more than one, as the Registrar may direct, must forthwith leave at the Patent Office an office copy of the order.

An appeal to the Board of Trade must be made within one month from the date of the Registrar's decision, or such further time as the Registrar may allow, or as the

Board of Trade may permit by special leave, and must be notified by leaving at the Patent Office a form intimating the appeal, accompanied by a statement of the grounds of appeal, and of the appellant's case in support thereof.

A copy of the notice and all the accompanying documents must also be forthwith sent by the appellant to the Secretary of the Board of Trade, and to the opponent or applicant as the case may be.

The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to parties and evidence, or otherwise, for the purpose of the hearing of the appeal; or the Board may refer the appeal to the Court, in which case they may give directions for the purpose of the reference.

Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, is given to the Registrar and to the appellant, and to the opponent or applicant as the case may be.

The decision of the Board of Trade is final.

On the hearing of the appeal, whether by the Court or the Board of Trade, any party may by special leave bring forward further material for the consideration of the tribunal: but no further grounds of objection to registration will be allowed to be taken by the opponent or the Registrar other than those stated in the notice of opposition, except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken, the applicant will be entitled to withdraw his application without payment of the costs of the opponent on giving notice to the Registrar and to the other parties within seven days after the grant of leave to file further evidence.

Evidence to be brought before the Board of Trade is to be given by statutory declaration, but in any case in which the Board think it right so to do, the Board may (with the

consent of the parties) take evidence *viva voce* in lieu of or in addition to evidence by declaration.

The tribunal hearing the appeal may, after hearing the Registrar, permit the applicant to modify the trade mark in any manner not substantially affecting its identity, but in such case the trade mark as modified must be re-advertised before being registered.

The Registrar, and in the case of an appeal to the Board of Trade the Board of Trade, have power to award to any party such costs as they may consider reasonable, and to direct how and by what parties they are to be paid; the Court has the usual discretion as to costs, which, in the absence of special circumstances, will follow the event.

If an opponent or appellant neither resides nor carries on business in the United Kingdom, the tribunal may require him to give security for costs of the proceedings before it relative to such opposition or appeal, and in default of such security being given may treat the opposition or appeal as abandoned.

In proceedings before the Court the costs of the Registrar are in the discretion of the Court, but the Registrar cannot be ordered to pay the costs of any other of the parties.

ENTRY ON THE REGISTER.

After the expiration of one month from the date of the advertisement of an application in the *Trade Marks Journal*, the Registrar enters the trade mark on the register, subject to the determination of any opposition, and on payment of the registration fee. The entry of a trade mark on the register gives the date of the registration, a note of disclaimers, conditions and limitations, a statement of the goods in respect of which the mark is registered, and particulars of the trade, business, profession, or occupation, if any, of the proprietor, and such other matters as the Registrar may deem necessary.

Where a mark is registered as associated with any other mark or marks, the Registrar notes upon the register the numbers of the marks with which it is associated, and also notes in connexion with each of the registered marks the number of the last registered mark as being associated therewith.

Where a mark has been accepted by error, the Registrar need not register the mark, but may withdraw his acceptance and refuse to register, in which event the applicant will have the same right of being heard, and of appealing, as he would have had if the mark had been refused immediately upon its receipt.

In case of the death of any applicant for registration after the date of his application, and before the trade mark has been entered on the register, the Registrar may, after the expiration of the period of advertisement, on being satisfied of the applicant's death, enter on the register, in

place of the name of the deceased applicant, the name of the person owning the goodwill of the business, on such ownership being proved to his satisfaction.

On the registration of the trade mark a certificate of registration is issued to the applicant under the hand of the Registrar, and sealed with the seal of the Patent Office.

ASSOCIATED TRADE MARKS.

Trade marks belonging to the same person may without any inconvenience have the closest resemblance one to another, but it is evidently impossible in the case where the trade marks are used for the same goods or description of goods to treat such trade marks as if they had all the same liberty of transmission that would exist in the case of trade marks wholly different. Accordingly, such trade marks are dealt with in groups or as 'associated trade marks,' which cannot afterwards be disassociated by any transmission by assignment or otherwise.

As provided by the Act, if an application is made for the registration of a trade mark so closely resembling a trade mark of the applicant already on the register for the same goods or description of goods as to be calculated to deceive or cause confusion if used by a person other than the applicant, the Registrar, or the Board of Trade, or the Court may require as a condition of registration that the marks be entered on the register as associated trade marks.

If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately, he may apply to register the same as separate trade marks. Each such separate trade mark must satisfy all the conditions and will have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms a part are deemed to be associated trade marks; but the user of the whole trade mark is deemed to be also a user of such registered trade marks belonging to the same proprietor as it contains.

The effect of registering separately the whole and a distinctive part of a trade mark is, therefore, to prevent a competitor from borrowing a valuable part of the mark with or without adding other matter : the separate registration of part of a trade mark being analogous to a claim in a patent specification for a subordinate integer of a combination which is also claimed independently.

When a person claiming to be the proprietor of several trade marks for the same description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of,

- (a) statements of the goods for which they are respectively used or proposed to be used ; or
- (b) statements of number, price, quality, or names of places ; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark ; or
- (d) colour ;

seeks to register such trade marks, they may be registered as a series in one registration. All the trade marks in a series are deemed to be, and are registered as, associated trade marks.

Associated trade marks are assignable or transmissible only as a whole and not separately, but for all other purposes are deemed to have been registered as separate trade marks. Where, however, user of a trade mark is required to be proved for any purpose, the tribunal may, if and so far as it thinks right, accept as an equivalent for such user, the user of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity.

In certain cases the proprietor of trade marks which the tribunal proposes to treat as 'associated' may object to such association. It is for him to satisfy the Registrar, or, on appeal, the Board of Trade or the Court, that the

association is unnecessary, by reason of the marks not being used for the same goods or description of goods, or by reason of their being so unlike as to negative any risk of deception or confusion. Such an argument is double-edged, however, and may be used against a proprietor who seeks to stop registration of a similar mark by a competitor.

SHEFFIELD MARKS.

Long before the institution of a general register of trade marks a record of corporate marks was kept by the Company of Cutlers, who have, since the 1st January, 1884, taken care of a new register, termed the Sheffield register, in which are entered marks or devices assigned or registered by the Cutlers' Company, and other trade marks used in respect of metal goods¹ by persons carrying on business in Hallamshire or within six miles thereof.

An application to register an old corporate mark assigned by the Cutlers' Company and actually used before the 1st January, 1884, must be made on a form bearing an impressed stamp of £5 and addressed to the Cutlers' Company.

An application for registration of any other trade mark used on metal goods by a person carrying on business in Hallamshire, or within six miles thereof, is made in the same way as an application to the Registrar, but must be addressed to the Cutlers' Company, and must be in duplicate.

Within seven days of the receipt of an application to register a trade mark, the Cutlers' Company sends a copy to the Registrar together with two representations of the mark for each class for which the applicant seeks registration.

¹The expression 'metal goods' means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

Within one month the Registrar may give notice to the Cutlers' Company of objection to the acceptance of the application.

If the Registrar gives notice of an objection, the application is not proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court.

If no objection is made by the Registrar, the Cutlers' Company require the applicant to send the Registrar a wood-block or electrotpe, whereupon the Registrar advertises the application in the *Trade Marks Journal*.

The application is then open to opposition in the same way as an application to register any other trade mark, and unless the application is successfully opposed, the mark is entered in the Sheffield register in due course.

Upon the registration of a trade mark in the Sheffield register, the Cutlers' Company give notice to the Registrar, who enters the mark in the register of trade marks; such registration bears date as of the day of application to the Cutlers' Company, and has the same effect as if the application had been made to the Registrar on that day.

Notice of every entry, cancellation, or correction made in the Sheffield register is given to the Registrar by the Cutlers' Company.

When the Registrar receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used on metal goods, he notifies the application to the Cutlers' Company.

Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted in connexion with an application or with an entry on the register, may appeal to the Court.

COTTON MARKS.

Since the establishment at Manchester in 1876 of a branch of the trade marks registry of the Patent Office trade marks for cotton goods have received exceptional treatment.

When the Trade Marks Act of 1875 became law, and all trade marks then in use were called in, deposits were made in Manchester and London of many thousands of trade marks upon cotton piece goods and yarn, when it was discovered that, on account of circumstances peculiar to the Manchester trade, marks had been used by several traders unknown to each other, who were therefore unable to claim such marks as their exclusive property.

Under the "three mark rule" three, or fewer, owners of the same or very similar marks were allowed to register marks which had been in use prior to 13th August, 1875. Where there were more than three claimants for the same or similar marks, actual registration was withheld, but all such marks received quasi-registration by being placed in a separate list called the "B list," in which also most of the word marks are entered, and the owners received certificates of refusal to register in case they had occasion to take legal proceedings against infringers.

Under the Act of 1883 the Manchester branch was maintained without direct statutory authority, but by the Act of 1905, as the result of representations from Manchester and elsewhere, the Manchester branch was established on a statutory basis and the practice of the officials with respect to cotton marks was explicitly sanctioned.

As before, a duplicate of the Manchester register is kept by the Keeper of cotton marks, who acts under the directions of the Registrar, with the advice of a committee appointed by the Manchester Chamber of Commerce.

In view of the peculiar nature of the Manchester trade, which is almost wholly conducted with foreigners, different requisites are demanded for the registration of a trade mark for cotton goods than in the case of a mark in any of the other classes.

As provided by the Act, in respect of cotton piece goods and cotton yarn no mark consisting of a word or words alone (whether invented or otherwise) can be registered, and no word or words is deemed to be distinctive in respect of such goods: in respect of cotton piece goods no mark consisting of a line heading alone can be registered, and no line heading is deemed to be distinctive in respect of such goods: no registration of a cotton mark will give any exclusive right to the use of any word, letter, numeral, line heading, or any combination thereof.¹

All applications for registration of trade marks for cotton goods, *i.e.*, for cotton yarn, sewing cotton, cotton piece goods and other cotton goods, excepting articles of clothing, must be made to the Manchester branch and must be in duplicate.

If the mark has been used by the applicant or his predecessors in business prior to the date of application, the length of time of user must be stated. The applicant is also obliged in his application, in the case of a trade mark for cotton yarn, sewing cotton or cotton piece goods, to

¹ In the Trade Marks Bill as amended by the Select Committee of the House of Commons, it was proposed to enter in the Manchester register marks for cotton yarn, sewing cotton, and cotton piece goods only, in respect of which word marks were held not to be distinctive; subsequently it was arranged to enter in the Manchester register marks for all other cotton goods excepting articles of clothing, and the result has been a certain amount of confusion. At present word marks are accepted for such other cotton goods, that is, in class 25, though the validity of such registration appears doubtful.

disclaim any exclusive right to any letter-press appearing on the trade mark except in so far as it consists of his own name and address, or the foreign equivalent thereof.

On receipt of an application the Keeper forthwith sends to the Registrar one representation of the mark applied for.

As soon as may be the Keeper makes a search amongst the marks on the Manchester register, in the " B " list, and those which have been refused and those which are pending, and notifies to the Registrar the application and the marks, if any, which he has found so nearly resembling the mark applied for as to be calculated to deceive, and together with such notification sends a report upon the application.

After considering such report, if the Registrar thinks it will be necessary to object to the acceptance of the application, he gives notice to the applicant of a time when he can be heard, and, within one month after hearing the applicant, may give notice to the Keeper of objection to the acceptance of the application, or that he has no objection.

If no notice of objection is received from the Registrar, the application is advertised in the *Journal*.

If an applicant, being notified of a time for hearing, does not attend, his application is deemed to be refused.

If, after the hearing, the Registrar still objects to the application, the application is not proceeded with, but any person aggrieved may appeal to the Court or the Board of Trade, at the option of the applicant.

If the mark is advertised by the Manchester branch and is not opposed, the Keeper may call upon the applicant for the registration fee, and upon receipt of the fee reports to the Registrar who will then register the mark.

Upon the registration of a trade mark in the Manchester

register the Keeper enters the mark in the duplicate of the Manchester register kept by him, and the registration bears date as of the day of application to the Manchester branch, and has the same effect as if the application had been made to the Registrar on that day.

When any mark is removed from, or any cancellation or correction made in, the Manchester register, notice is given by the Registrar to the Keeper, who alters the duplicate register accordingly.

The right of inspection of the Manchester register extends to and includes the right to inspect all applications that have been made since the passing of the Trade Marks Registration Act, 1875, and hereafter shall have been made to the Manchester branch in respect of any of the cotton goods above mentioned, whether registered, refused, lapsed, expired, withdrawn, abandoned, cancelled, or pending.

A complete search amongst classified collections of cotton marks can only be made at Manchester.

CERTIFICATION OR STANDARDIZATION MARKS.

A trade mark in the ordinary sense is always associated with the goodwill in the business in the goods in connexion with which it is used. There are, however, certain marks, which, if they do not connote the existence of a goodwill, yet indicate to the public that the goods for which they are used conform with a recognised standard and may be purchased with confidence on that account. Such marks are the standard hall-marks for plate, the counterfeiting of which is certainly no less reprehensible than the imitation of the marks of private traders. On the same footing may be considered collective trade marks used by firms carrying on business in the same locality, all being members of one association, and also trade union labels used in connexion with goods made by union labour.

As provided by the Act, "where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by mark used upon or in connexion with such goods, the Board of Trade may, if they judge it to be to the public advantage, permit such association or person to register the mark as a trade mark in respect of such goods, whether or not the association or person be a trading association or trader or possessed of a goodwill in connexion with such examination and certifying."

By virtue of the above quoted provision there have already been registered as 'special trade marks' the mark of a foreign state department, and the marks of national and district associations.

An application to register a 'special trade mark' must be made to the Registrar who notifies the same to the Board of Trade together with his report upon the application. A copy of the Registrar's report is sent to the applicants who must, within one month from the receipt of the report, send the Board, in duplicate, a case setting out the grounds upon which they rely in support of their application, and if they fail to do so the application is deemed to be abandoned.

Upon receipt of the case the Board may call for such evidence, if any, as they think fit, and will, if necessary, hear the applicants and the Registrar, and make an order determining whether and subject to what conditions, amendments, or modifications, if any, the application may be permitted to proceed.

If the application is permitted to proceed, the mark is advertised, and the application is open to opposition in the same way, and all such proceedings are had thereon, as if it were an ordinary application.

When registered the mark is treated in all respects like any other registered trade mark, and the registrant is deemed to be the proprietor; but the mark is transmissible or assignable only by permission of the Board of Trade.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

The international and colonial arrangements to which reference has been made in the discussion of the law of patents and designs apply also to trade marks, as provided by the International Convention.

Any person who has applied for protection for any trade mark in a foreign state or British possession with the government or legislature of which an arrangement with His Majesty for the mutual protection of trade marks is in force, is entitled to registration of his trade mark in this country in priority to other applicants, and to claim for such registration the date of the foreign or colonial application.

In order to receive priority the application must be made in this country within four months from the application for protection abroad, and must be accompanied or followed by a certified copy of the foreign or colonial registration, or application for registration, along with a translation if the copy is written in a foreign language. The priority must be claimed within the term of four months above mentioned, and before the registration in this country, as no further opportunity is given of antedating the application.

The representations accompanying the application should agree in all respects with those submitted for registration in the foreign state or British possession, and the list of goods should not include any which are not covered in the foreign or colonial application.

The applicant must be the person who applied for protection abroad or his successor in interest.

The application must conform with the system of classification adopted in this country, a separate application being required for each class in which protection is desired, notwithstanding that the mark may be protected abroad by a single registration. In other respects the application is treated like an ordinary application.

When the application is accepted, the trade mark is entered on the register as of the date of the foreign or colonial application, and the duration of registration is reckoned from this date; but the proprietor of the trade mark is not thereby entitled to recover damages for infringements happening prior to the actual date on which the trade mark is registered in this country.

The registration so effected is not invalidated by reason only of the use of the trade mark in the United Kingdom or the Isle of Man during the period that elapsed between the date of the foreign or colonial application and the application in this country.

The provision that the applicant under the international and colonial arrangements shall be entitled to registration in priority to other applicants merely implies that registration will not be finally barred by a prior application to register a new mark for the same goods or the same description of goods filed after the date of the foreign or colonial application, notwithstanding that the marks of the two applicants are the same or nearly identical. In this case, as in the case of two or more interfering applications made in the ordinary way, the persons claiming proprietorship may be required to have their rights determined by the Court, or to settle their rights by agreement in a manner approved by the Registrar or (on appeal) by the Board of Trade.

The Act is silent as to the effect of another registration effected before the later application is made but at a date subsequent to that claimed under the international and

colonial arrangements. According to the present practice, notwithstanding the claim for priority, the mark of the later applicant, if identical with the registered mark or so closely resembling it as to be calculated to deceive, can only be registered for the same goods or description of goods by order of the Court.

It is further provided, in apparent conformity with the International Convention,¹ that any trade mark the registration of which has been applied for in the country of origin may be registered under the Trade Marks Act, 1905. In practice, however, it is imposed as a condition of registration in every case that the mark submitted shall be registrable under the law of this country, whether it is registered abroad or not. So far, therefore, from the International Convention benefiting an applicant in this direction, the Convention is, in reality, wholly inoperative in this country.²

¹ Art. VI. 'Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans tous les autres pays de l'Union.'

² See also the chapters relating to applications for patents and applications to register designs under the international and colonial arrangements.

EFFECT OF REGISTRATION.

Subject to any rights appearing from the register to be vested in any other person, the person for the time being entered in the register as proprietor of a trade mark has power absolutely to assign the same, and to give effectual receipts for any consideration for such assignment; but any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

Subject to any rights acquired by a concurrent user, and to any limitations and conditions entered upon the register, the registration of a person as proprietor of a trade mark will, if valid, give to the registered proprietor the exclusive right to the use of the trade mark upon or in connexion with the goods in respect of which it is registered: provided that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods no rights of exclusive user of the trade mark will (except so far as the respective rights have been defined by the Court) be acquired by any one of such persons as against any other by the registration of his mark, but each will otherwise have the same rights as if he were the sole registered proprietor of the trade mark.

In any legal proceedings relating to a registered trade mark the fact that a person is registered as proprietor of the trade mark is *primâ facie* evidence of the validity of the original registration and of all subsequent assignments and transmissions of the trade mark. After the expiration of seven years from the date of the original registration

(or seven years from 11th August, 1905, whichever happens last) the original registration will be taken to be valid in all respects, unless the original registration was obtained by fraud, or unless the mark consists of or contains matter the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a Court of Justice, or would be contrary to law or morality, or any scandalous design.

Registration of a trade mark does not entitle the registered proprietor to interfere with or restrain the user by any person of a similar mark upon or in connexion with goods for which he has, by himself or his predecessors in business, continuously used the trade mark from a date anterior to the use of the first mark by the proprietor or his predecessors in business, or to object (on the user being proved) to such person being put upon the register for his trade mark in respect of such goods by permission of the Court.

No registration will interfere with any *bond fide* use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any *bond fide* description of the character or quality of his goods.

DISCLAIMERS.

A new trade mark to be registrable must consist of, or contain, one at least of the essential particulars above enumerated in the statutory definition. A trade mark is not necessarily limited to such essential particulars, but may include other matter in respect of which no exclusive right is secured by registration, or, in the case of an invented word, may be derived from a common root which is a generic term incapable of protection.

It is certainly not desirable that a person entitled to a narrow claim only should have even the semblance of a right to interfere with others conducting their business honestly. Accordingly, the Act provides that if a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the Board of Trade or the Court, in deciding whether the trade mark is to be entered or remain upon the register, may require the proprietor, as a condition of its being upon the register, to disclaim any right to the exclusive use of any part or parts of the trade mark, or of all or any portion of such matter to the exclusive use of which they hold him not to be entitled, or to make such other disclaimer as may be considered needful for the purpose of defining his rights under the registration.

A disclaimer upon the register does not affect any rights of the proprietor other than those arising out of the registration of the trade mark in respect of which the disclaimer is made; consequently, the proprietor of the trade mark

will not forfeit any common law rights he may possess in respect of the matter disclaimed.

In issuing a certificate for obtaining registration abroad the Registrar may omit reference to any disclaimer appearing on the register.

CORRECTION OF THE REGISTER.

The Registrar may, on request made by the registered proprietor, or by some person entitled by law to act in his name ¹

- (1) Correct any error in the name or address of the registered proprietor of a trade mark; or
- (2) Enter any change in the name or address of the person who is registered as proprietor of a trade mark; or
- (3) Cancel the entry of a trade mark on the register; or
- (4) Strike out any goods or classes of goods from those for which a trade mark is registered; or
- (5) Enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.

In the event of such an application being made, the Registrar may require such evidence by statutory declaration or otherwise as he may think fit as to the circumstances in which the application is made.

Where an application is made to enter a disclaimer or memorandum relating to a trade mark, the Registrar, before coming to a decision, advertises the application in the *Trade Marks Journal* for one month, in order to enable

¹ *e.g.* by the trustee in bankruptcy of the registered proprietor, or where the registered proprietor is a company in liquidation, by the liquidator.

any person desiring so to do to state any reasons against the applicant being allowed to make the disclaimer or enter the memorandum.

The decision of the Registrar with respect to any correction of the register is subject to appeal to the Board of Trade, who may, if they think fit, refer the appeal to the Court.

ALTERATION OF A REGISTERED TRADE MARK.

The registered proprietor of any trade mark may apply to the Registrar for leave to add to it or alter it in any manner that does not substantially affect its identity.

Various alterations of a trade mark may be required or expedient; *e.g.*, the change of a name or address, the addition of the word 'limited' on the incorporation of a firm, *etc.* Such changes will not, as a rule, affect any of the essential particulars of the trade mark as registered.

The Registrar may refuse or may grant leave to make any alteration on such terms as he may think fit, but any such refusal or conditional permission is subject to appeal to the Board of Trade, who may, if they think fit, refer the appeal to the Court.

The alteration is advertised in the *Trade Marks Journal*, and, if the Registrar so requires, before leave is granted. For this purpose the Registrar may call on the applicant to furnish a block showing the trade mark as altered, or may insert an advertisement describing the proposed alteration in words so that it can be considered by persons interested in the matter.

RECTIFICATION OF THE REGISTER.

The Court may on the application of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, make such order for making, expunging or varying such entry, as it may think fit.

The Court means the High Court of Justice in England and the Court of Session in Scotland: the Court of Chancery of the County Palatine of Lancaster has in respect of cotton marks the same jurisdiction as the High Court of Justice in England. The Court in Ireland has assumed that under a former Act it had no jurisdiction to order the rectification of the register; and the Act of 1905 does not appear to alter the situation in this respect.

Any person substantially inconvenienced in his business by the registration if it is wrong is a person aggrieved, and has *locus standi* to apply to the Court for rectification of the register; the apprehended injury or damage must, however, be of a legal nature and not a sentimental one.

A motion to expunge a trade mark from the register may be based on any of the grounds on which the Comptroller might have refused the original application to register or on which the application might have been opposed, or on the ground that the trade mark even if properly registered when applied for is no longer distinctive, or that the proprietor of the trade mark has forfeited his right to protection, or that it has been acquired by

assignment or transmission separate from the goodwill of the business.

Again, application may be made to the Court for the purpose of obtaining an order for the removal of part only of the trade mark or for the entry of a disclaimer, or the imposition of conditions as to the user of the trade mark, or by way of appeal from a decision of the Registrar refusing to register the applicant as assignee of the trade mark.

In the case of a trade mark registered under a previous Act the validity of the original entry on the register is determined in accordance with the statutes in force at the date of the entry; but no trade mark which is registrable under the Trade Marks Act, 1905, will be removed from the register on the ground that it was not registrable under the Acts in force at the date of its registration.

The fact that a person is registered as proprietor of a trade mark is *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions. After the expiration of seven years from the date of the original registration (or seven years from the 11th August, 1905, whichever happens last) the original registration will be taken to be valid in all respects unless it was obtained by fraud, or unless the mark consists of or contains matter the use of which would, by reason of its being calculated to deceive or otherwise, be disentitled to protection in a Court of Justice, or would be contrary to law or morality, or any scandalous design.

The Court may, in any proceedings in connexion with an application to rectify the register, decide any question that it may be necessary or expedient to decide, and has power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

In case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply

to the Court for an order directing him to rectify the register.

In any legal proceeding for the rectification of the register, the Registrar has the right to appear and be heard, and must appear if so directed by the Court. Unless otherwise directed by the Court, the Registrar, in lieu of appearing and being heard, may submit to the Court a statement in writing, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the matter, or of the practice of the Office in like cases, or of such other matters relevant to the issues, and within his knowledge as Registrar, as he may think fit, and the Registrar's statement will be deemed to form part of the evidence in the proceeding.

The costs of the Registrar are in the discretion of the Court, but the Registrar will not be ordered to pay the costs of any other of the parties.

In any proceeding in which the validity of the registration of a trade mark comes into question and is decided in favour of the proprietor of the trade mark, the Court may certify the validity, and if it so certifies, then in any subsequent legal proceeding in which the validity of the registration comes into question the proprietor of the trade mark, on obtaining a final order or judgment in his favour, will have his full costs, charges, and expenses as between solicitor and client, unless in the subsequent proceeding the Court certifies that he ought not to have the same.

Where an order has been made by the Court for the rectification of the register, the person in whose favour the order has been made, or such one of them, if more than one, as the Registrar may direct, must forthwith leave at the Office an office copy of the order: the register will thereupon be rectified by the Registrar.

The rectification of the register by order of the Court determines the position of the trade mark as regards the

Trade Marks Act, but it leaves open questions as to the rights of the proprietor apart from the Act.

Even when a mark has been removed from the register, the same mark may be upheld in an action for passing-off, or it may be entered on the register again under different conditions.

From the decision of the Court in the first instance there is the usual appeal to the Court of Appeal and thence to the House of Lords.

NON-USER OF A TRADE MARK.

A trade mark cannot exist in gross but only in appendage to the goodwill of the business in connexion with which it is used; in every case the existence of a trade mark presumes the existence of goods in connexion with which it is to be used.

The Trade Marks Act only contemplates the protection of trade, and does not recognise any right of a man to register a mark for goods in which he does not deal, or intend to deal—that is, in which at the time of registration he has not some definite and present intention to deal, as distinguished from a mere general intention of extending his business at some future time to anything which he may consider desirable. Similarly, when a trade mark is abandoned, that is, when the trade mark no longer distinguishes the goods of the proprietor from others on the market, the rights acquired by the first appropriation of the mark come to an end, and the proprietor cannot avail himself of the provisions of the Act for the purpose, not of protecting his own trade, but of interfering with the trade of others.

As provided by the Act, a registered trade mark may, on the application to the Court of any person aggrieved, be taken off the register in respect of any of the goods for which it is registered, on the ground that it was registered by the proprietor or a predecessor in title without any *bond fide* intention to use the same in connexion with such goods, or that there has been no *bond fide* user of the trade mark in connexion with such goods during the five years immediately preceding the application, unless

in either case such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon the trade mark in respect of such goods.

Absence of a *bonâ fide* intention to use a trade mark will be presumed if the proprietor makes no use of the mark for a considerable time after registering it. There is no rule, however, as to the length of time which must elapse after registration of a mark that is not used before an application can be made to rectify the register: the facts of each particular case will provide the considerations for determining whether the mark is to be held to be abandoned or not.

Intention to abandon a trade mark will, as a rule, be presumed when the proprietor has not only discontinued the use of the trade mark in question but has adopted a different mark for the trade in connexion with which the first mark was used, or when the proprietor has offered to sell the trade mark.

There is no obligation, however, on the part of the proprietor to limit himself to the use of one mark on the same goods, or to use a trade mark in connexion with each separate package of goods sold or dealt in by him. Even when a trade mark has not been used during the period of five years, discontinuance may be justified in cases where there is only a limited market for the goods in question, and repeat orders are received at long intervals.

According as the trade mark is used or is intended to be used for some only of the goods in connexion with which it is registered, or is not or was not used or intended to be used, the registration may be restricted to those goods or be removed from the register altogether.

In every case the Court has ample discretion to allow the mark to remain on the register or remove it: a trade mark may, therefore, be allowed to remain on the register even in respect of goods for which it is not used, if it is in fact used for goods of similar nature.

ASSIGNMENT AND TRANSMISSION.

A trade mark is capable of being assigned during the life of the proprietor and of being transmitted at his death; but it can be assigned and transmitted only in connexion with the goodwill of the business concerned in the goods for which it has been registered, and an assignee or transferee acquires the exclusive right to a trade mark only in so far as the registration is co-extensive with the business assigned or transmitted.

The interdependence of goodwill and trade mark rights is present in the case of registered and also unregistered trade marks. Either of these trade marks is an indication of origin, and a transference of the indication of origin, without a transference of the origin itself, is but a transference of a right, if any right at all, to commit a fraud upon the public, a right which is not recognised by the law of this country.

The Registrar may, on request made jointly by a registered proprietor of a trade mark and the person to whom he has assigned the trade mark together with the goodwill of the business concerned in the goods for which it has been registered, register the assignee as proprietor. If the Registrar so requires, the assignee must furnish a declaration to the effect that the trade mark has been assigned to him together with the goodwill.

Where no joint request is made, any person who has become entitled to a registered trade mark by assignment, transmission, or other operation of law, may leave a

request at the Office for the entry of his name in the register as proprietor of the trade mark.

Together with the request the claimant must leave a case stating full particulars of the assignment, transmission, or other operation of law by virtue of which he claims to be entitled to be entered in the register as proprietor, so as to show the manner in which and the person or persons to whom the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connexion with the goodwill of the business concerned in the goods for which the mark has been registered.

If the Registrar determines that the case sets out particulars such as entitle the claimant to be registered as proprietor of the trade mark, he calls upon the claimant to furnish a statutory declaration verifying the statements in the case and declaring that the particulars given comprise every material fact and document affecting the proprietorship of the trade mark claimed by the request.

In any case, the Registrar may call on any person who desires to be registered as proprietor of a trade mark for such proof or additional proof of title and of the existence and ownership of the goodwill as the Registrar may require for his satisfaction.

In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ¹ ceases to carry on business, and the goodwill of that person does not pass to one successor but is divided, the Registrar may (subject to the limitations as to associated trade marks), on the application of the parties interested, permit an apportionment of the registered trade marks of that person among those actually continuing the business, subject to such conditions and modifications, if any, as he may think necessary in the public interest. The decision of the Registrar is subject to appeal to the Board of Trade, who may, if they think fit, refer the appeal to the Court.

¹ i.e. an individual, firm, or corporation.

In the absence of any agreement or arrangement to the contrary, on the dissolution of a partnership each of the partners is at liberty to use the trade marks of the firm provided he can and does do so in such a way as to avoid deceiving the public, or casting any risk or liability upon his late partners under the doctrine of 'holding out.'

With the determination of the goodwill in the business in connexion with which a trade mark has been used the trade mark rights cease.

Certain trade marks are by their nature incapable of assignment or transmission, as for instance where the trade mark imports of necessity that the goods sold under it are manufactured by or under the directions of a particular individual, so that the trade mark would be deceptive if used by an assignee or transmittee. In such a case the trade mark must be altered if it is to remain protected.

The circumstance, however, that a trade mark consists of or contains the name or initials of the former proprietor is not of itself sufficient to disentitle an assignee to continue the user of the mark, since the mere name or initials so used will usually denote simply the business in connexion with which the mark is used rather than the individual proprietor.

Similarly, the right to a trade mark for a secret product cannot be transferred without the secret of its production, and the transfer of a mark used for articles for the supply of which a monopoly exists is inoperative unless the transferee has a right to deal in the articles.

The Act does not affect the right of the proprietor of a registered trade mark to assign the right to use the mark in any British possession or protectorate or foreign country in connexion with any goods for which it is registered, together with the goodwill of the business therein in such goods.

RENEWAL.

So long as the goodwill in a business subsists, the trade mark associated with the goodwill may endure in perpetuity, and, in fact, the older the mark the more secure is the right of the proprietor.

On the other hand, an abandoned trade mark confers no right on the originator, and, with a view to keeping the register fresh, a time limit of fourteen years is imposed on registration; the registration being renewable at the termination of each period of fourteen years.

At any time not less than two months and not more than three months before the expiration of the last registration of a trade mark, any person authorised by the registered proprietor may apply for its renewal by leaving at the Patent Office a form of request with a fee stamp of £1. Thereupon the Registrar renews the registration for a period of fourteen years from the expiration of the original registration or of the last renewal, as the case may be, and advertises the renewal in the *Trade Marks Journal*.

At a date not less than one month and not more than two months before the expiration of the last registration of a mark, if the renewal fee has not been paid, the Registrar sends a notice to the registered proprietor calling his attention to the fact that the fee remains unpaid.

At a time not less than fourteen days and not more than twenty-eight days before the expiration of the last registration of a mark, the Registrar sends a second notice to the registered proprietor in case the fee has not yet been paid.

If at the date of the expiration of the last registration of a trade mark the renewal fee has not been paid, the Registrar advertises the fact in the *Journal*, and if within one month of such advertisement the renewal fee of £1 together with an additional fee of 10s. is received, he may renew the registration without removing the mark from the register.

Where after one month from the advertisement these fees have not been paid, the Registrar may remove the mark from the register as of the date of the expiration of the last registration, but may, upon payment of the renewal fee of £1 together with the additional fee of £1, restore the mark to the register, if satisfied that it is just so to do, and upon such conditions as he may think fit to impose.

For the purpose of any application for registration during one year next after the date of the removal of a trade mark from the register for non-payment of the renewal fee, the mark so removed is deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that there had been no *bond fide* trade user of the trade mark during the two years immediately preceding the removal.

INFRINGEMENT.

Infringement of a registered trade mark is the unauthorised use in this country for trading purposes, in connexion with goods other than those of the proprietor, but similar to the kind covered by the registration, of a mark identical with the registered trade mark or so nearly resembling it as to be calculated to lead others to take the goods for those of the proprietor.

It is not necessary to constitute infringement of a trade mark that the user by a defendant should be user as a trade mark, but the absence of such user is an element to be considered.

The forms which infringement may take are without number: infringers may be manufacturers, middlemen or retail dealers, or may be printers of labels, *etc.*, who supply dealers.

A flagrant instance of infringement is the use of the actual wrappers, packages, or bottles of the registered proprietor of the trade mark in connexion with spurious goods, or the use of fac-similes of the registered mark in this way or on show cards attached to the goods or on circulars or advertisements offering them for sale.

Of a like character is the use of a registered trade mark in its entirety, but with additions; for instance, with the addition of the word 'genuine.'

More often the infringement consists in the use of only a prominent part of a trade mark, with or without differences in detail; the sole object of the variation being,

as a rule, the masking of the fraud. In such a case the doctrine of equivalence may be invoked as in the case of infringement of patents and designs.

Again, an infringer may choose a mark seemingly different from that registered, but such that his goods will bear the same name in the market.

In the various cases the tests to be applied in comparing an alleged infringement with a registered mark are substantially the same as those adopted in considering whether one mark so closely resembles another as to be incapable of registration.

In no case is there infringement in using a part of a mark which is common to the trade or which is simply descriptive of the defendant's goods as well as those of the plaintiff.

To prove infringement it is not necessary to prove that any person was actually deceived by the defendant's action or even that the immediate purchasers from the defendant might have been deceived: it is sufficient if there is reasonable probability that the ultimate purchasers, being people of ordinary intelligence and exercising ordinary caution, could be deceived: on the other hand, a defendant is conducting an uphill fight who tries to prove that his mark is not calculated to deceive, when in fact it appears from the evidence that some people have been deceived.

The absence of fraudulent intention does not avert a charge of infringement; nevertheless in the case where the defendant's action has been attended with fraud, the Court will look very closely into the question of infringement, and rather assume that the defendant who has intended and endeavoured to deceive, has succeeded in doing what he intended, and has rendered himself liable for the consequences.

In default of actual proof of fraudulent intention, there are various circumstances which serve to point to the conclusion that such intention has existed; for instance, the

use of the mark after objection has been made to an application for registration: the exact imitation of special features of the registered mark, *e.g.*, the close imitation of the colour of the registered mark, the arrangement of similar matter in the same positions, the use of large type for a part of the mark resembling that of the plaintiff and of small type for the remainder: or the use by the defendant of a name not his own, but the same as, or similar to, that of the plaintiff.

In any such case, where resemblances are found between two marks, the natural enquiry for the Court is, why do they exist? If no sufficient answer appears, the inference is that they exist for the purpose of misleading.

In a doubtful case the benefit of the doubt will be given to a defendant who marks his own name clearly and prominently on the goods. It is a serious error, however, to suppose that infringement is necessarily averted by the mere circumstance that the defendant's name appears along with the mark which he is using, for a large part of the public may know the goods simply by the mark without even knowing the name of the proprietor.

When infringement of a registered trade mark is complained of, the point is not whether the defendant has copied the mark used by the plaintiff, but whether he has copied the mark as actually registered. The fact, however, that features of the plaintiff's mark as used have been copied may suffice to rebut any declaration of innocence on the part of the defendant.

Be it said, however, that it is not the proprietor of the trade mark who determines the limits of the protection he has secured, but the Courts.

Whether an alleged infringer is using the mark on inferior goods is immaterial to the question of infringement: it may, however, be a very material point in assessing damages, once infringement is proved.

A trader is liable for the acts of his agents, even though

committed against his express instructions; and directors of a limited company are responsible for the acts of employees.

A single case of infringement is sufficient to establish liability; but when infringement is inadvertent and not likely to be repeated, a plaintiff who presses for an injunction takes the risk of being refused his costs.

ACTION FOR INFRINGEMENT. DEFENCES.

The owner of a trade mark cannot permit infringement to be openly carried on without losing the commercial advantages represented by the possession of a distinctive trade mark. Acquiescence in continued infringement leads, in fact, to the same consequences as deliberate abandonment of the mark.

It is for the proprietor of a trade mark, therefore, to assert his rights without delay; as to the mode of doing so, he has a choice of ways.

He may bring a suit under the Trade Marks Act, 1905, in which case he may, if successful, obtain an injunction or interdict, damages or an account of profits, and the costs of the action, together with the destruction of the labels or other materials used by the defendant in carrying on the infringement: or he may bring an action for passing-off either alone or along with the action for infringement of the registered mark; or he may institute criminal proceedings under the Merchandise Marks Acts.

It is with proceedings under the Trade Marks Act that the present chapter is concerned.

No person is entitled to institute such proceedings to prevent or to recover damages for the infringement of an unregistered mark unless the trade mark was in use before the 13th of August, 1875, and has been refused registration: the Registrar may, on request, grant a certificate that registration has been refused.

The procedure in bringing the action is substantially the same as in a patent case.

It is unnecessary for the plaintiff to give any preliminary warning to the defendant; and in practice it is usually disadvantageous for him to give any such warning since it may enable the defendant to dispose of the spurious goods before the plaintiff can interfere. Where, however, it is intended to rely on the evidence of witnesses trapping the defendant, it is only proper, when the defendant has fallen into a trap which has been set for him, to inform him then that that is the occasion of which evidence will be given in the Court, so that he may be able to recall the circumstances and be ready to give his account in Court. To avoid the difficulty that arises when there is a conflict of evidence as to the defendant's actions, trap orders should, by preference, be given in writing.

If the defendant is advised that he has no case, he will do well to make a complete submission: in this event, the plaintiff may succeed in obtaining an injunction, but will probably fail to obtain his costs if the defendant is otherwise innocent.

The defendant may, however, deny the commission of the acts complained of, or plead that the mark he is using is not the same as the registered mark and does not so closely resemble it as to be calculated to deceive, or that he is simply making *bond fide* use of his own name or place of business or of that of his predecessors in business, or that he is using merely a *bond fide* description of the character or quality of his goods.

Again, the defendant may set up the plea that the part of the mark he is alleged to have taken is disclaimed by the plaintiff or that the user by him is outside conditions entered on the register limiting the rights of the registered proprietor.

The defendant may also plead that he is using his mark by right, and that, having used his own mark before the plaintiff's user of his, he has entered it on the register.

The defendant may also dispute the plaintiff's title, for instance, on the ground that he was not the owner of the mark at the time he registered it or on the ground that he acquired the mark without the goodwill of the business concerned in the goods for which it is registered; or he may plead that the plaintiff's mark is deceptive, or that the plaintiff is using it for the purposes of a fraudulent trade and is therefore not entitled to relief; or he may set up a case of estoppel or of acquiescence on the part of the plaintiff.

Where the defendant disputes the validity of the plaintiff's registration, he may move the Court to expunge the plaintiff's mark from the register on any of the grounds already mentioned: in case the application to rectify the register is successful, the infringement action falls to the ground—without necessarily affecting the result of any action for passing-off occasioned by the defendant's conduct.

The question of infringement is one to be determined by the Judge by comparison of the marks of the plaintiff and the defendant: but the Court will admit the evidence of witnesses as to the likelihood of deception, and must admit evidence of the usages of the trade in respect of the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connexion with such goods by other persons.

From the decision of the Judge in the first instance an appeal may be taken to the Court of Appeal and thence to the House of Lords.

If the validity of the registration comes into question and is decided in favour of the proprietor, the Court may certify the same, and if it so certifies then in any subsequent legal proceeding in which the validity comes into question the proprietor, on obtaining a final order or judgment in his favour, will have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceeding the Court certifies that he ought not to have the same.

OFFENCES.

If any person makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he will be guilty of a misdemeanor.¹

Any person who represents a trade mark as registered which is not so, is liable for every offence on summary conviction ² to a fine not exceeding £5.

A person is deemed to represent that a trade mark is registered, if he uses in connexion with the trade mark the word 'registered,' or any words expressing or implying that registration has been obtained for the trade mark.

The mere use of the words 'trade mark' in reference to an unregistered mark is not a representation that the mark is registered. On the other hand, even when a trade mark is registered, it may constitute an offence to use the word 'registered' in connexion with a part only of the mark in such a way as to suggest that an exclusive right has been acquired in respect of that part *per se*.

'Registered' means registered in this country; it is no defence to a charge of making a false representation that the mark is registered in another country from which the

¹ Such a misdemeanor is punishable in the Isle of Man by imprisonment for any term not exceeding two years, with or without hard labor, and with or without a fine not exceeding £100, at the direction of the Court.

² In Scotland such an offence may be prosecuted in the Sheriff Court.

goods are imported, or that the mark has been registered in this country when in fact it is no longer on the register.

If any person, without the authority of His Majesty, uses in connexion with any trade, business, calling, or profession, the Royal Arms, or arms so nearly resembling them as to be calculated to deceive, in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person without the authority of His Majesty or of a member of the Royal Family, uses in connexion with any trade, business, calling, or profession, any device, emblem, or title in such manner as to be calculated to lead to the belief that he is employed by or supplies goods to His Majesty or such member of the Royal Family, he may, at the suit of any person who is authorised to use such arms or such device, emblem, or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction or interdict from continuing so to use the same.

The above provision does not affect the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem, or title to continue to use such trade mark.

PASSING OFF.

No man has a right to pass off his goods as those of another, or to substitute any other goods for those ordered by a customer.

This is a well established rule of law, if almost as much honoured in the breach as in the observance. It is readily understood but often extremely difficult of application, the difficulty being increased by the inconsistency of judicial decisions which, during the last decade or so, have swayed from undue severity to what may appear undue leniency towards defendants.

The jurisdiction of the Court to interfere for the purpose of preventing the goods of one person being passed off as those of another is not conferred by any statute, but dates back to the practice of the former Courts of Equity which sought to keep competition within the limits of fairness even before the introduction of legislation concerning trade marks.

The references already made to the subject of infringement in connexion with registered trade marks are generally applicable to cases of passing-off. The defendant to an action for infringement and the defendant to a passing-off action are both charged with having falsely represented goods supplied by them to be those of the plaintiff; the misrepresentation in the case of passing-off being effected either by imitating a trade mark of reputation, registered or not, or by copying the general get-up or adopting a prominent part of another person's label, by unlawfully using the trade name which denotes the goods of another

trader in the market, or by making a false representation as to the connexion of one business with another.

To succeed in an action for passing-off, the plaintiff must establish that what he relies on denotes his goods in the market, *i.e.*, distinguishes them from the goods of other traders, and that because of his goods being so denoted or distinguished the defendant's conduct amounts to a representation that his goods are the plaintiff's. This cannot be established by producing a certificate of registration, but must be proved by the evidence of witnesses. In turn, the defendant may bring forward witnesses to testify that each and all of the features relied on by the plaintiff are common to the trade, and that the confusion, if any, produced between the plaintiff's and the defendant's goods is occasioned by the plaintiff's failure to adopt a distinctive name, or get-up or label.

When a trade name is on its face distinctive, *e.g.*, in the case of an arbitrary word or words, the natural inference will be that a defendant who adopts that name, which has no meaning apart from the plaintiff's goods, does so for the purpose of deception.

In the case of a trade name which is also a geographical or topographical name, the onus is on the plaintiff to show that to the public the name, used for the class of goods he deals in, denotes his goods and nothing more. Where a defendant uses that name in such a way as to suggest that he carries on business at a place known by that name, when in fact his business is located elsewhere, the fraud will be manifest, and will usually be sufficient in itself to decide the case against him.

When a trade name is *prima facie* descriptive, it is for the plaintiff to prove beyond doubt that the word or words comprising the name have in his trade acquired a secondary meaning which has displaced the primary meaning, in fact, that the name denotes his goods and not a description or class of goods; if the primary meaning of a word is a simple and easy primary meaning, known to everybody,

it is extremely difficult to establish that in any particular trade this word has lost its well-known and original meaning and in that trade acquired a secondary meaning to the exclusion of the natural and original meaning of the word. Of course, this difficulty is not nearly so strong or so difficult to get over in a case where the word which is claimed as a trade name is not one of which the meaning would be known to everyone who came in contact with it.

The greatest difficulty arises in connexion with the use of personal names, where a plaintiff claims that his name has gained a reputation for certain goods and the defendant is using his own name or a name that he claims to be entitled to use. Everyone has the absolute right to use his own name honestly in his own business, even although he may thereby incidentally interfere with and injure the business of another having the same name. In such a case the inconvenience or loss to which those having a common right are subjected is *damnum sine injuria*. But, although a man is free to use his own name, he cannot resort to any artifice or to any act calculated to mislead the public as to the identity of the business firms so established, or of the articles produced by them, and thus cause injury to the other beyond that which results from the similarity of name. Where the name in question is one which has previously come to indicate the source of production of particular articles, the use of that name by another, unaccompanied by any precaution or indication, may in itself amount to an artifice calculated to produce deception.

A new company¹ with a title of which a name, which is also that of a trader of reputation, forms part, has none of the natural rights that an individual born with that name would have. An individual of the same name, not transferring to a company a genuine business and a good-

¹ The Companies Acts also forbid the registration of any company under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where the subsisting company is in process of being dissolved, and testifies its consent.

will, cannot confer upon the company a title to use his name, when such use will interfere with the business of another.

The assignor of a trade name will be enjoined from using that name in the same trade, in competition with his assignee, for such competition would be unfair and fraudulent. Equally, the promoter of a company whose name has been used as part of the company name cannot be permitted to use his name in connection with, and as the name of, a rival company.

The establishment of a trade name requires time, not necessarily a long time, but sufficient to enable the name to grow on the public memory. What is a sufficient time will depend on the amount of the sales, the extent of advertising, *etc.*; but, undoubtedly, the longer the goods are known by that name, the stronger is the plaintiff's case in a passing-off action. Conversely, while a defendant cannot justify the continued user of a trade name merely because he has used it fraudulently in the past without detection, yet if he has in fact honestly used the name in question in his own district, where the plaintiff's name was not known, so that his goods and not the plaintiff's are known to his customers by the mark, he cannot be held liable for any confusion that may arise when the plaintiff extends his trade to the defendant's district.

The remedies for passing-off are the same as those in an action for infringement of a registered mark, namely, damages or an account of profits, costs,¹ and an injunction. The injunction in a passing-off action is more limited, however, than in a case of infringement, in that it does not forbid the use of the trade name, *etc.*, absolutely, but only its use by the defendant without clearly distinguishing his goods from those of the plaintiff.

¹ In a passing-off action there is no provision for the issue of a certificate of validity which will entitle the plaintiff to solicitor and client costs in a subsequent action.

MERCHANDISE MARKS ACTS.

The Merchandise Marks Act of 1887, supplemented by the Acts of 1891 and 1894, deals *inter alia* with the subject of fraudulent marks on merchandise and the penalties (i.e., fine or imprisonment) inflicted on those who forge trade marks or falsely apply trade marks, or apply false trade descriptions, to goods, or cause any of these things to be done.

As provided by the Act, every person who—(a) forges any trade mark; or (b) falsely applies to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive; or (c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade mark; or (d) applies any false trade description to goods; or (e) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade mark; or (f) causes any of the things above mentioned to be done, will be guilty of an offence, unless he proves that he acted without intent to defraud.

Every person who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark or false trade description is applied, or to which any trade mark or mark so nearly resembling a trade mark as to be calculated to deceive is falsely applied, as the case may be, will be guilty of an offence, unless he proves—(a) that having taken all reasonable precautions against committing an offence, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of

the trade mark, mark, or trade description; and (b) that on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the person from whom he obtained such goods or things; or (c) that otherwise he had acted innocently.

The expression 'trade mark' means a trade mark registered in the register of trade marks, and includes any trade mark which, either with or without registration, is protected by law in any British possession or foreign state with which an arrangement for mutual protection of trade marks is in force.

The expression 'trade description' means any description, statement, or other indication, direct or indirect, (a) as to the number, quantity, measure, gauge, or weight of any goods, or (b) as to the place or country in which any goods were made or produced, or (c) as to the mode of manufacturing or producing any goods, or (d) as to the material of which any goods are composed, or (e) as to any goods being the subject of an existing patent, privilege, or copyright; and the use of any figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, is deemed to be a trade description.

The expression 'false trade description' means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false in a material respect.

The provisions of the Act respecting the application of a false trade description to goods extend to the application to goods of any such figures, words, or marks, or arrangement or combination thereof, whether including a trade mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are. The same is true of the application to goods of any false name or initials

of a person; and the provisions respecting goods to which a false trade description is applied extend to goods with the false name or initials of a person applied thereto, in like manner as if such name or initials were a trade description.

The expression 'false name or initials' means as applied to any goods, any name or initials of a person which—(a) are not a trade mark or part of a trade mark, and (b) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connexion with goods of the same description, and not having authorised the use of such name or initials, and (c) are either those of a fictitious person or of some person not *bonâ fide* carrying on business in connexion with such goods.

A person will be deemed to forge a trade mark who either—(a) without the assent of the proprietor of the trade mark makes that trade mark or a mark so nearly resembling that trade mark as to be calculated to deceive: or (b) falsifies any genuine trade mark, whether by alteration, addition, effacement, or otherwise.

A person will be deemed to apply a trade mark or mark or trade description to goods who—(a) applies it to the goods themselves; or (b) applies it to any covering, label, reel, or other thing in or with which the goods are sold or exposed or had in possession for any purpose of sale, trade, or manufacture; or (c) places, encloses, or annexes any goods which are sold or exposed or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a trade mark or trade description has been applied; or (d) uses a trade mark or mark or trade description in any manner calculated to lead to the belief that the goods in connexion with which it is used are designated or described by that trade mark or trade description.

A person will be deemed to falsely apply to goods a trade mark or mark, who without the assent of the proprietor of a trade mark applies such trade mark, or a mark so nearly resembling it as to be calculated to deceive: but in any prosecution for falsely applying a trade mark or

mark to goods the burden of proving the assent of the proprietor lies on the defendant.

Where a defendant is charged with making any die or other instrument for the purpose of forging, or being used for forging, a trade mark, or with falsely applying to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of these things to be done, and proves—(a) that in the ordinary course of his business he is employed, on behalf of other persons, to make dies or other instruments for making, or being used in making, trade marks, or to apply trade marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in the United Kingdom, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and (b) that he took reasonable precautions against committing the offence charged; and (c) that he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark, mark, or trade description; and (d) that he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade mark, mark, or description was applied; he will be discharged from the prosecution, but will be liable to pay the costs incurred by the prosecutor, unless he has given notice that he will rely on the above defence.

Any person who falsely represents that any goods are made by a person holding a royal warrant, or for the service of His Majesty, or any of the Royal Family, or any government department, will be liable, on summary conviction, to a penalty not exceeding £20.

In addition to the provisions above summarised the Merchandise Marks Acts also contain various regulations as to the marking of watch-cases, and other goods imported from abroad. A discussion of these subjects is foreign to the purpose of the present book, but we shall be pleased, so far as possible, to advise clients on any points that may arise in this connexion.

‘PATENT’ MEDICINES.

The term ‘patent medicines’ is popularly used to include not only patented medicines but also all proprietary medicines and all medicines subject to stamp duty.

A patented medicine is one for which letters patent have been issued by the Comptroller to an applicant who has filed the usual specification or specifications, and, if it answers the requirements of novelty, utility, *etc.*, may be held in monopoly like any other invention.

That few medicines are so patented is due partly to the nature of the subject matter, but even more to the generous rule followed by the medical profession of publishing inventions connected with the practice of medicine for the benefit of the profession at large. Of the patents that are granted many are taken out with no other object than to enable the holders to evade the provisions of the Pharmacy Acts relating to the sale of poisons.

The proprietary medicine which passes for a ‘patent medicine’ is merely a medicine which is sold in packets or bottles bearing a revenue stamp, the stamp representing a tax imposed on those who vend medicines which are recommended for the cure of any particular ailment, and affording no official guarantee of purity, *etc.* Such stamps are supplied by the commissioners of stamps and their use confers no monopoly like that given by letters patent for an invention.

COPYRIGHT REGISTRY.

On account of the interest in the subject shown by many of our clients we have thought it advisable to include in this edition a brief summary of the law of literary copyright, musical and dramatic copyright, and artistic copyright. The particulars given in the following paragraphs do no more than touch the fringe of the subject, but we shall be pleased to furnish further information on request.

The term of copyright in a book¹ published in the lifetime of the author is forty-two years from the date of publication, or during the life of the author and seven years from his death, whichever is the longer period. If the book is published after the author's death, then the proprietor has copyright for forty-two years from the first publication. The copyright in articles in encyclopædias, reviews, magazines, periodical works, or works published in a series of books or parts, belongs to the proprietor of the work, when such articles have been composed upon the terms that the copyright shall belong to him and have been actually paid for by him; but after twenty-eight years from the first publication the right of publishing such articles in separate form reverts to the author; and during these twenty-eight years the proprietor may not publish the articles separately or singly without the previous consent of the author or his assigns. Authors may reserve to themselves the right of publishing their articles in a separate form before the expiration of the twenty-eight years.

¹ The term 'book' means and includes every volume, part or division of a volume, pamphlet, sheet of letter-press, sheet of music, map, chart, or plan, separately published,

Copyright is created by Statute and does not depend upon registration, which is permissive only and not compulsory : but no proprietor of copyright in any book can take proceedings in respect of infringement of his copyright, unless he has first registered his book : the provisions of the Musical Copyright Act, 1906, only apply to musical works which have been registered.

Registration is effected by lodging at Stationers' Hall a demand signed by the proprietor, stating the title of the book and the date of the first publication, and accompanied by a fee of 5s.

The proprietor of the copyright in an encyclopaedia, review, magazine, periodical work, or other work published in a series of books or parts, is entitled to all the benefits of registration upon his registering the first volume, number or part.

Registered copyrights, or any share or shares thereof, may be assigned, without payment of any stamp duty, by the registered proprietor lodging at Stationers' Hall a demand signed by him, together with a fee of 5s.

A copy of every book published must be delivered at, or sent to, the British Museum immediately after publication ; and four copies should be delivered at Stationers' Hall for the Bodleian Library at Oxford, the Public Library at Cambridge, the Library of the Faculty of Advocates at Edinburgh, and the Library of Trinity College at Dublin.

Books first published in any British possession which does not provide for registration should be registered at Stationers' Hall.

Under the provisions of the Berne Convention, books copyright in the United Kingdom are protected in the following countries :—Belgium, France, Germany, Italy, Spain, Switzerland, Tunis, Hayti, Luxemburg, Monaco, Norway, Japan, Denmark (including the Farøe Islands, but excluding Iceland, Greenland, and the Danish Antilles), and Sweden ; and books are protected in the United Kingdom

which are first produced in any of these countries, and which are protected by the law of the country of origin, and would have been protected in the United Kingdom if first produced in the United Kingdom.

To secure copyright in the United Kingdom of works intended to be published in America and other foreign countries (except the Kingdoms and States represented in the Austrian Reichsrath) which have not adopted the provisions of the Berne Convention, simultaneous first publication in the United States or other foreign country and in the United Kingdom or a British possession is essential.

Proprietors of books first composed, or written, or printed in the United Kingdom, desiring to prevent the importation of foreign reprints, are advised to give notice in writing to the Commissioners of Customs, accompanied by a statutory declaration that the copyright subsists, and when it will expire. Registration at Stationers' Hall is also necessary before duties can be levied for the benefit of the proprietor of copyright on foreign reprints of British copyright works imported in the Bahamas, Barbados, Bermuda, British Guiana, Cape of Good Hope, Grenada, Jamaica, Natal, Nova Scotia, Newfoundland, Prince Edward Island, St. Christopher, St. Lucia, and St. Vincent.

The right to represent or perform a dramatic piece or musical composition is a right distinct from the copyright in a book containing or consisting of such dramatic piece or musical composition, and no assignment of the copyright of any such book conveys any right of representation or performance, unless so specified.

The author of a dramatic piece or his assignee has in perpetuity, under the Dramatic Act, 1833, the sole liberty of representing, or causing to be represented, at any place or places of dramatic entertainment whatsoever in any part of the United Kingdom, in the Isles of Man, Jersey, and Guernsey, or in any part of the British Dominions, if the piece has not been printed and published; and, if the piece has been printed and published, the performing right lasts for twenty-eight years from the date of first publication,

and further, for the life of the author or his assignee if the author be alive at the expiration of the twenty-eight years.

The author or assignee of the author of any tragedy, comedy, play, opera, farce, or other scenic, musical, or dramatic entertainment, or musical composition, has, under the Copyright Act, 1842, as his own property, the sole liberty of representing or performing, or causing or permitting to be represented or performed in public, any such dramatic piece or musical composition for forty-two years from the first public representation, or the life of the author, and seven years from his death, whichever is the longer term.

Registration is not compulsory, but a certificate of accurate registration affords *prima facie* proof of title.

The proprietor of the right of representation or performance of any dramatic piece or musical composition desiring to register his right at Stationers' Hall must lodge there, for entry in the register, a statement of the particulars, signed by him and witnessed, with a fee of 5s.

Assignment may be made by the registered proprietor of his interest, or any portion thereof, by filling up and lodging at Stationers' Hall, for entry in the register, a statement signed by him, together with a fee of 5s.

Proprietors of copyright in printed musical compositions entitled to, and desirous of retaining, the right of public representation or performance must print on the title-page of every copy a notice to the effect that the right of public representation or performance is reserved.

Under the Fine Arts Copyright Act, 1862, the author, being a British subject, or resident within His Majesty's dominions, of every original painting, drawing, or photograph (not sold before 29th July, 1862), has the exclusive right of copying, engraving, reproducing, and multiplying such painting or drawing, and the design thereof, or such photograph, and the negative thereof, by any means or size, whether made

in the King's dominions or not, for his life and seven years after; but any other person may represent the scene or object represented by such painting, drawing or photograph. The copyright of any painting, drawing, or negative of a photograph made for or on behalf of any person other than the author for a good or a valuable consideration belongs to such person. Upon transferring for the first time the ownership of any painting, drawing, or negative of a photograph the copyright must be transferred or reserved by agreement in writing, or it will cease to exist.

No proprietor of copyright is entitled to the benefit of the Act until registration, and no action can be maintained nor any penalty recovered in respect of anything done before registration.

Every copyright must be registered by delivering or sending to the Registrar, Stationers' Hall, a memorandum of such copyright, signed by the proprietor, with a fee of 1s.

Assignment of copyright under the Act must be made by some note or memorandum in writing signed by the proprietor of the copyright, or by his agent appointed for that purpose in writing, and must be registered at Stationers' Hall. This is effected by lodging there for entry in the register a memorandum signed by the assignee, with a fee of 1s.

By the International Copyright Act, 1886, the Fine Arts Copyright Act, 1862, is made applicable to paintings, drawings, and photographs first produced in a British possession, registration of the copyright in London not being required if the law of such possession provides for the registration of such copyright.

The copyright in busts and sculptures depends on the Sculpture Copyright Act, 1814. By this Act copyright is conferred on every person who makes or causes to be made any sculpture, model, copy or cast of the human figure, or of any bust, or of any part of the human figure, clothed in drapery or otherwise, or of any

animal or any part of any animal, combined with the human figure or otherwise, or of any subject being matter of invention in sculpture, or of any alto or basso-relievo representing any of the matters or things above mentioned. The duration of such copyright is fourteen years, counting from the first publication of the sculpture, *etc.*; after the expiration of fourteen years the copyright returns to the person who first had the copyright, if he be then living, for the further term of fourteen years. No registration of such copyright is required, but the proprietor must cause his name, with the date, to be put on all and every such new and original sculpture, *etc.*, before the same is put forth or published, on pain of forfeiture of the copyright.

PART II.

FOREIGN AND COLONIAL PATENTS

INTRODUCTORY.

Although a number of inventors may be contented with a monopoly in the United Kingdom, the majority of those who have made improvements likely to be in demand abroad are naturally anxious to secure to themselves the profits to be derived from the introduction of the inventions in the colonies and in foreign states. For this it is necessary to obtain the grant of a patent in each country in which possession of a monopoly is desired.

In determining where and whether to secure protection it is important that the inventor should have a general idea of the main provisions of the patent legislation of the countries that offer a market for his invention, in order that he may, on the one hand, take care to secure protection before the time for doing so has expired, and, on the other hand, by complying with the legal requirements imposed in the various states, conserve the rights afforded by his patents when granted.

The conditions attached to patents vary greatly in different states. In the following pages brief particulars are given for all those of any industrial importance.

In most foreign states applications can be filed in the names of assignees of inventors without joining the inventors in the applications.

As a rule, inventions that constitute subject matter for

valid patents in this country are equally patentable abroad, in the absence of any publications anticipating the applications in foreign countries.

In many states inventions of medicines are excepted from patent protection; it may be mentioned, however, that in several cases secret medicines can be protected in other ways.

In virtue of the International Convention a British patentee may apply for patents in any of the states comprised in the Union at any time within twelve months from the date of application in the United Kingdom, notwithstanding that the invention may have been published in the interval by the issue of the specification or otherwise. In this connection it should not be overlooked that the priority of twelve months referred to extends only to subject matter actually contained in the specification that accompanies the application in the United Kingdom. In cases, therefore, where the Convention is not applicable the foreign applications should be lodged before publication in any form.

As will be noticed, the legislation of many foreign states provides that a patent shall have no effect against *bona-fide* prior users of the invention; on this account it is not quite correct to say that an applicant who files a foreign application under the International Convention will have the same rights as if he had lodged the foreign application on the day of filing in the country of origin.

Foreign patents must, as a rule, be applied for through the intermediary of resident agents authorised by power of attorney, and specifications must be filed in the official language of each country in which an application is made. Objections to applications involving amendment of the specifications are occasionally made by the different foreign Patent Offices as the result of examination and search. We translate all official letters received, and, when necessary, explain to our clients the relevance of the references quoted, which are often in a foreign language. We also prepare suitable amendments and replies to objections, and

superintend the prosecution of every application until the patent is granted.

After the patent has been sealed, we will, on request, pay the renewal fees required to maintain the patent in force, and in countries where working is called for we can, if instructed, effect the working and obtain the requisite legal proof.

It may be noted that while an accurate statement is given of the dates when renewal fees are due, in some cases it is possible to obtain an extension of the time for making payment. Patentees should not rely, however, on the chance of obtaining extensions which are granted by way of exception.

It should also be understood that in cases where a fixed term is given for commencing working, to be considered *bonâ fide*, steps should be taken to comply with the requirement some months at least before the term runs out.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

A number of colonies and foreign states have entered into a Convention with this country and with each other for the protection of industrial property. These include Australia, Belgium, Brazil, Ceylon, Cuba, Denmark, France, with Algeria and colonies, Germany, Italy, Japan, Mexico, Netherlands, with the Dutch East Indies, Surinam and Curaçoa, New Zealand, Norway, Portugal, Santo Domingo, Servia, Spain, Sweden, Switzerland, Trinidad and Tobago, Tunis and the United States of America.

The following are the leading provisions of the Convention :—

“ The subjects or citizens of each of the contracting states shall, in all the other states of the Union, as regards patents, industrial designs or models, trade marks and trade names, enjoy the advantages that their respective laws grant or shall hereafter grant to their own subjects or citizens. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each state.

“ Subjects or citizens of states not parties to the Union, who are domiciled or have effective and genuine industrial or commercial establishments in the territory of any of the states of the Union, are assimilated to the subjects or citizens of the contracting states.

"Any person who has duly deposited an application for a patent, industrial design or model, or trade mark in one of the contracting states shall enjoy, as regards registration in other states, and reserving the rights of third parties, a right of priority during the terms hereinafter stated. Consequently, subsequent registration in any of the other states of the Union before expiry of those terms shall not be invalidated by any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it, by the sale of copies of the design or model, or by the use of the trade mark. The above mentioned terms of priority are twelve months for patents, and four months for industrial designs and models and trade marks.

"Patents applied for in the various contracting states by persons admitted to the benefits of the Convention shall be independent of patents obtained for the same invention in other states, whether parties to the Convention or not.

"In no state of the Union shall the patentee incur forfeiture of his patent for non-working until the expiration of a minimum term of three years commencing from the date of the deposit of his application in the state in question, and even then forfeiture shall be incurred only in case the patentee fails to give satisfactory reasons for his inaction.

"The introduction by the patentee into any state where a patent has been granted of articles manufactured in any other state of the Union shall not entail forfeiture of the patent. Nevertheless the patentee shall remain bound to work his patent in conformity with the laws of the state into which he introduces the patented articles.

"Every trade mark duly registered in the country of origin shall, on application, be admitted for registration, and protected in the form originally registered

in all other states of the Union. That state shall be deemed the country of origin where the applicant has his chief seat of business. If this chief seat of business is not situated in one of the states of the Union, the state to which the applicant belongs shall be deemed the country of origin. Registration may be refused if the object for which it is solicited is contrary to morality or public order.

"The nature of the goods on which a trade mark is to be used cannot in any case be an obstacle to registration of the trade mark.

"A trade name shall be protected in all the states of the Union without the necessity for registration, whether it forms part of a trade mark or not.

"All goods illegally bearing a trade mark or trade name may be seized on importation into those states of the Union where this mark or name has a right to legal protection. The seizure may be effected at the request either of the proper public department or of an interested party, pursuant to the internal legislation of each state. In states whose legislation does not allow seizure on importation this seizure may be replaced by prohibition of importation. The authorities are not bound, however, to effect seizure in the case of goods in transit.

"The provisions of the preceding paragraph apply to all goods falsely bearing the name of any locality as an indication of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention.

"The subjects or citizens of the states parties to the Convention enjoy in all the states of the Union the protection accorded to natives against unfair competition (*concurrence déloyale*).

"The high contracting parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade marks, for articles ex-

hibited at official or officially recognised international exhibitions which have been organised in the territory of one or them."

Similar arrangements for the mutual protection of inventions, designs and trade marks have been made between the United Kingdom on the one side, and each of the following states on the other:—Ecuador (designs and trade marks only), Greece (designs and trade marks only), Honduras, Paraguay, Rumania (designs and trade marks only), and Uruguay.

BRITISH COLONIES AND DEPENDENCIES.

Although the subject of Imperial patents has been discussed at Colonial Conferences and on other occasions, legislative provisions for granting such patents are wanting, and at present a British patent confers protection only for the United Kingdom and the Isle of Man.

In certain colonies letters of registration can be obtained extending to the respective colonies the protection afforded by a British patent: in others protection can only be secured by independent patents.

The procedure in obtaining colonial patents and the conditions of grant are approximately uniform, being copied from the system adopted in the United Kingdom, so that considerable abridgment is possible of the commentary on colonial patent practice. It may be noted, however, as a general feature of colonial patents, that the terms of grant are liberal and the burdens imposed far from onerous. Renewal fees are comparatively small and fall due only after the patent has been issued for some years, while extensions may be obtained by patentees who have not been adequately remunerated. In case of litigation, the law, being practically English law, is not unfamiliar, and, as the highest Court of Appeal is in London, British suitors are in a good position even when proceeding against distant infringers.

In few of the colonial statutes is a direct reference made to a requirement to work patented inventions. On the other hand, colonial letters patent usually contain a proviso that should the grant be prejudicial or inconvenient to the

subjects in general the patent will be utterly void. It would therefore be unsafe to assume that the patentee has a natural right to abuse his monopoly.

AUSTRALIA.

Letters patent are granted to :—(a) the actual inventor; or (b) his assignee, agent, attorney, or nominee; or (c) the actual inventor or his nominee jointly with the assignee of a part interest in the invention; or (d) the legal representative of a deceased actual inventor or his assignee; or (e) any person to whom the invention has been communicated by the actual inventor, his legal representative or assignee (if the actual inventor, his legal representative or assignee is not resident in the Commonwealth).

The term limited in every patent for the duration thereof is 14 years from its date, subject to payment of a renewal fee of £5 before the end of the seventh year.

The patentee may apply for an additional patent in respect of any improvement on his invention, and an additional patent may be granted for the unexpired term of the original patent, subject to payment of a renewal fee of £2 10s. at the end of the seventh year from its date.

Any person interested may, after the expiration of two years from the grant of the patent, present a petition to the Commissioner alleging that the reasonable requirements of the public with respect to the invention have not been satisfied and praying for the grant of a compulsory licence, or in the alternative for the revocation of the patent.¹

BAHAMAS.

Letters patent are granted for a term of 7 years, extensible to 21 years.

¹ A proposal has lately been made to bring the Australian Act into conformity with the Imperial Act in this respect.

BARBADOS.

Letters patent are granted for 14 years to the inventor or his representative or to the first importer within the Colony of any invention. Renewal fees of £50 and £100, payment of which may be distributed over several years, are payable before the expiry of four and seven years respectively from the date of the patent: letters of registration may be obtained by the owner of a British or foreign patent for the remainder of its term, upon which such fees are not payable.

BASUTOLAND.

The owner of any patent granted in Cape Colony may enter the same in the register of patents, and enjoy in Basutoland the same protection as is conferred by the colonial patent.

BERMUDAS.

Letters patent are granted for 14 years, free from payment of renewal fees.

BORNEO (BRITISH).

The Straits Settlements Ordinance has been adopted in BRITISH NORTH BORNEO.

While there are no legal provisions in SARAWAK relating to inventions, we are advised that owners of patent rights would receive protection in the local Courts against infringers.

An Order in Council provides for the exercise of His Majesty's jurisdiction over British subjects in the protectorate of BRUNEI.

BRITISH EAST AFRICA.

The British India Act has been applied to EAST AFRICA PROTECTORATE. Letters patent are granted for 14 years,

fees of 100 rupees and of 200 rupees respectively being payable before the expiry of the fourth and eighth years from the date of filing the specification.

The patent law of ZANZIBAR is identical with that of East Africa Protectorate.

No provision is made for granting patents in UGANDA but by the Africa Order in Council, 1889, any act which would be an offence in the United Kingdom, if committed by a British subject in Uganda, may be punished in a manner commensurate with the offence.

BRITISH GUIANA.

Letters patent are granted for a term of 14 years, subject to payment of a fee of 100 dollars before the expiration of seven years from the date of the patent.

BRITISH HONDURAS.

Letters patent are granted for a term of 14 years, subject to expiry with a prior foreign patent. Renewal fees of 50 dollars and 100 dollars respectively are payable before the expiry of the third and seventh years of the life of the patent.

BRITISH NEW GUINEA (PAPUA).

Letters patent are granted for a term of 14 years, subject to payment of renewal fees of £5 and £10 before the end of four years and eight years respectively.

CANADA.

Canadian patents apply to the whole Dominion, and are granted for 18 years to the inventor, or his assigns, of any invention not known or used by others before the date of his invention and not in public use or on sale with his consent or allowance for more than one year previous to his application for patent. An inventor already possessing

a patent in the United Kingdom or abroad must make application before the expiry of twelve months from the date of issue of the British or foreign patent.

In the case of interfering applications arbitration is resorted to for the purpose of determining the rights of the parties.

Renewal fees of \$20 each are payable before the end of six and twelve years.

The patent rights cease if the invention is not worked in Canada within two years of the date of the patent, or such further time as the patentee may by petition obtain, and if the patentee ceases to manufacture the invention in such manner that any person desiring to use it may obtain it or cause it to be made for him at a reasonable price at some manufactory or establishment for making or constructing it in Canada. The patentee may petition, however, to be relieved of the obligation to manufacture in Canada and to have his patent subject to the condition that compulsory licences may be granted to any persons desirous of using the invention. Patented articles may be imported for one year only, unless extension of the term for importation is asked for. Such extension is limited to one year.

CAPE COLONY.

Letters patent are granted for a term of 14 years, subject to the payment of renewal fees at the end of the third year (£10) and at the end of the seventh year (£20), and lapse with the first expiry of any prior foreign patent for the same invention.

CEYLON.

Letters patent are granted for a term of 14 years, subject to payment of renewal fees as follows: 50 rupees before the expiration of the 4th, 5th, 6th, 7th and 8th years; 100 rupees before the expiration of the 9th year; 150 rupees before the expiration of the 10th year; and 200

rupees before the expiration of the 11th, 12th and 13th years.

The *bonâ fide* grantee or assignee of a British patent may obtain the grant of a certificate of registration extending the protection to Ceylon. No renewal fees are required to maintain the certificate of registration in force, but protection ceases on the expiry of the British patent.

CHANNEL ISLANDS.

A British patent does not extend to the Channel Islands, but protection may be secured in JERSEY by registering a certified copy of the British patent in the Rolls of the Royal Court. Similar protection is obtainable in GUERNSEY.

CYPRUS.

There is no regulation as to the grant of patents, but exclusive privileges may be awarded by the High Commissioner.

DECCAN.

(NIZAM'S DOMINIONS.)

Letters patent are granted in Deccan for 14 years on substantially the same conditions as in British India.

EGYPT.

There is no Khedivial Patent Office, but protection for inventions may be obtained and upheld by the Courts of the Mixed Tribunals at Cairo by registration of the corresponding British or other foreign patent.

Registration at Khartoum extends protection to SUDAN.

FALKLAND ISLANDS.

Letters patent are granted to any person holding a valid British patent or to any person to whom the interest in

such patent in respect of the Colony has been assigned. The colonial patent expires with protection in the United Kingdom.

FEDERATED MALAY STATES.

In each of the Federated Malay States of NEGRI SEMBILAN, PAHANG, PERAK and SELANGOR an ordinance has been adopted by virtue of which letters patent are issued for a term of 14 years, subject to the payment of a fee of 25 dollars before the end of seven years from the date of grant. Valid letters patent may be obtained in these states for an invention patented in the United Kingdom or in any British possession at any time during the continuance of such other patent.

FIJI.

Letters patent are granted for 14 years to the inventor or his representative, or to the owner of a British patent for any invention. No fees are payable after the date of issue, but the patent expires with the first prior foreign patent for the same invention.

There is no provision for the registration of patents within the jurisdiction of the High Commissioner of the Western Pacific, but the common law of England applies throughout all British protectorates in the Pacific.

GIBRALTAR.

An invention patented in the United Kingdom may be protected in Gibraltar by ordinance of the Governor for the unexpired term of the British patent. There are no fees to pay after the grant.

HONG KONG.

Patents are granted for inventions that have been patented in the United Kingdom; the grant in the Colony being a mere extension to Hong Kong of the protection afforded by the British patent during the remainder of its term.

INDIA.

An application for a patent may be made by (1) the inventor; (2) his heirs, executors or administrators; (3) his assigns, who may, if desired, join the inventor in the application; or (4) the owner of a corresponding British patent; the application must be filed within one year from the acquisition of the first foreign patent for substantially the same invention.

The patent is granted for 14 years, counting from the date upon which the specification is filed, but ceases on the expiry of the British or any foreign patent for the same invention. To maintain the patent in force, fees of 50 rupees must be paid each year from the fourth to the eighth year, and of 100 rupees from the ninth till the thirteenth year.

The patent covers British India, including British Baluchistan and Burma (except the Shan States).

JAMAICA.

Letters patent are granted for 14 years, but expire with the first expiring foreign patent for the same invention. No fees are payable after the date of grant.

LEEWARD ISLANDS.

Letters patent are granted for 14 years, subject to payment of renewal fees of £20 due before the expiration of four years from the date of the patent and £40 due before the expiration of seven years; or such fees may be paid in annual instalments.

The owner of a British or foreign patent may obtain letters of registration on which no renewal fees are payable.

MALTA.

Letters patent are granted for 14 years with priority to the owner of a British patent. Renewal fees are payable

on original patents from the fifth to the fourteenth year amounting to £5, increasing by £1 annually. Patents of addition are also granted on which such fees are not payable. The patentee may be compelled to assign his right or to permit the use thereof, if the invention is not put into use within twelve months of the date of the grant, or if working is suspended for twelve months continuously.

MAURITIUS.

Letters patent are granted for a term of 14 years. An invention patented in the United Kingdom may be patented in Mauritius, provided the application be made within twelve months of the date of the British patent, notwithstanding prior use in Mauritius for not more than twelve months. No fees are payable after the issue of the patent.

MYSORE.

Patents are granted on substantially the same terms as in British India.

Renewal fees are payable from the date of filing the specification, as in British India, and subject to payment of these fees the patent has a duration of 14 years.

NATAL.

Patents are granted for a term of 14 years subject to the payment of renewal fees at the end of the third year (£5) and at the end of the seventh year (£10), but are limited in duration by prior foreign patents for the same invention.

NEWFOUNDLAND AND LABRADOR.

Letters patent are granted for 14 years subject to expiry with a prior foreign patent. No fees are payable after the grant, but the invention must be brought into operation in Newfoundland within two years of the date of the patent.

NEW ZEALAND.

Letters patent are granted for a term of 14 years from the date of acceptance of the application, subject to payment of renewal fees of £5 before the expiration of the fourth year and £10 before the expiration of the seventh year.

NIGERIA.

Separate patents are granted for 14 years in NORTHERN NIGERIA and in SOUTHERN NIGERIA, subject to payment of renewal fees of £50 before the expiration of four years, and £100 before the expiration of seven years; or such fees may be paid in annual instalments.

NYASALAND PROTECTORATE.

British letters patent may be registered in Nyasaland Protectorate; no fees are payable subsequent to registration.

OMAN.

There is no patent law in this state, but exclusive privileges may be obtained through the medium of the British political authorities at Muscat.

ORANGE RIVER COLONY.

Letters patent are granted for a term of 14 years, subject to the payment of renewal fees at the end of the third year (£5) and at the end of the seventh year (£10); but expire with a prior foreign patent.

The invention must not have been published or used within the Colony before the date of grant of the patent.

RHODESIA.

The law relating to the grant of letters patent is substantially the same as in Transvaal.

ST. HELENA.

British letters patent may be extended to St. Helena for the remaining term thereof in favour of the grantee or his assigns. Payment of the fees due on the British patent suffices to maintain the protection in force in St. Helena.

SEYCHELLES.

Letters patent are granted for 14 years to the inventor or his assigns or to the first importer into Seychelles of any invention.

Renewal fees of 500 rupees and of 1000 rupees are payable before the expiry of four years and seven years respectively from the date of the patent; or payment may be made in annual instalments.

SOMALILAND PROTECTORATE.

No regulations have been issued with regard to patents, and in the absence of such regulations decision in these matters rests with the Foreign Office, to which special reference must be made in each case.

STRAITS SETTLEMENTS.

Letters patent are granted to the inventor, his heirs, executors, administrators or assigns; to the owner of a patent in the United Kingdom or in any British possession; or to the first importer into the Colony. No fees are payable after the issue of the patent.

TRANSVAAL.

Letters patent are granted for a term of 14 years, subject to the payment of renewal fees, commencing with a fee of £2 payable before the end of the third year, and thereafter increased each year by 10s.

The owner of a British or foreign patent can validly apply for a patent in Transvaal at any time within twelve

months from the date of grant of such patent notwithstanding that in the interval the invention has been published in the Colony.

TRINIDAD AND TOBAGO.

Patents are granted for 14 years for inventions new within the Colony. No fees are payable after the issue of the patent.

WEI-HAI-WEI.

We are advised by H.M. Commissioner that while there is no law in existence dealing with inventions, the Government of the Protectorate will be prepared, if occasion arise, to introduce the same legislation as is in force in Hong Kong.

WEST AFRICAN COLONIES.

Letters patent are granted in GAMBIA for 14 years, subject to the payment of renewal fees of £50 and £100 before the expiry of four years and seven years respectively from the date of the patent; or payment may be made in annual instalments. The owner of a British or foreign patent may obtain letters of registration maintainable without payment of renewal fees.

The patent laws of GOLD COAST COLONY and of LAGOS are similar to that of Gambia.

Inventions can be protected in SIERRA LEONE only by way of legislative grant.

WINDWARD ISLANDS.

Letters patent are granted in GRENADA for 14 years, subject to payment of renewal fees of £3, £4, £5, £6 and £7, in respect of the fifth, sixth, seventh, eighth and ninth years, and a fee of £12 before the expiry of the eleventh year.

The patent laws of St. LUCIA and of St. VINCENT are practically identical with that of Grenada.

FOREIGN PATENTS.

AMERICA (UNITED STATES).

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in the United States before his invention or discovery thereof, and not patented or described in any printed publication in the United States or in any foreign country before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in the United States for more than two years prior to his application, unless the same is proved to have been abandoned, may obtain a patent in the United States.

No person otherwise entitled thereto will be debarred from receiving a patent for his invention or discovery, nor will any patent be declared invalid by reason of its having been patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country prior to the issue of the United States patent, unless the application for the foreign patent was filed more than twelve months prior to the date of application in the United States, in which case no patent will be granted in the United States.

An application for a patent for an invention or discovery filed in the United States by any person who has previously regularly filed an application for a patent for the same invention or discovery in a foreign country which by treaty, convention, or law affords similar privileges to citizens of the United States will have the same force and effect

as the same application would have if filed in the United States on the date on which the application for a patent for the same invention or discovery was first filed in such foreign country, provided the application in the United States is filed within twelve months from the earliest date on which any such foreign application was filed. But no patent will be granted on an application for a patent for an invention or discovery which had been patented or described in a printed publication in the United States or in any other country more than two years before the date of the actual filing of the application in the United States, or which had been in public use or on sale in the United States for more than two years prior to such filing.

An application for letters patent must be signed by the inventor, if alive: in case of the death of the inventor the application may be made by his executor or administrator.

In case of an assignment of the whole interest in the invention, or the whole interest in the patent to be granted, the patent will, upon request of the applicant embodied in the assignment, issue to the assignee; and if the assignee holds an undivided part interest, the patent will, upon request, issue jointly to the inventor and the assignee.

If it appear that the inventor at the time of filing his application believed himself to be the first inventor or discoverer, a patent will not be refused on account of the invention or discovery, or any part thereof, having been shown or described, but not claimed, in a prior United States patent, or previously described in a printed publication anywhere, or patented or known or used in any foreign country, before his invention or discovery thereof, unless the date of any such patent or publication is more than two years prior to the date of filing the application in the United States.

Joint inventors are entitled to a joint patent; neither of them can obtain a patent for an invention jointly invented by them. Independent inventors of distinct and independent

improvements in the same machine cannot obtain a joint patent for their separate inventions.

The application must be accompanied by a specification which is a written description of the invention or discovery and of the manner and process of making, constructing, compounding, and using the same, and is required to be in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make, construct, compound and use the same.

The specification must set forth the precise invention for which a patent is solicited and explain the principle thereof, and the best mode in which the applicant has contemplated applying that principle, in such manner as to distinguish it from other inventions.

The specification must conclude with a specific and distinct claim or claims of the part, improvement, or combination which the applicant regards as his invention or discovery.

Applications filed in the Patent Office are classified according to the various arts, and are taken up for examination in regular order of filing, those in the same class of inventions being examined and disposed of, as far as practicable, in the order in which the respective applications are completed.

Whenever, on examination, any claim of an application is rejected for want of novelty or for any reason whatever, the applicant is notified. The applicant may amend his application before or after the first rejection or action; and he may amend as often as the examiner presents new references or reasons for rejection. In so amending, the applicant must clearly point out all the patentable novelty he thinks the case presents in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections.

If an applicant neglects to prosecute his invention for one year after the date when the last official notice of any action by the Patent Office was mailed to him, the application will be held to be abandoned.

Where an application has been abandoned by failure to complete or prosecute, it may be revived as a pending application, if it is shown that the delay in completion or prosecution was unavoidable.

When it is found that the specification and claims are allowable, a notice of allowance is forwarded to the applicant. A final fee of \$20,00 must be paid at the Patent Office within six months from the date of the notice of allowance.

When a patent has been withheld by reason of non-payment of the final fee, any person, whether the inventor or an assignee, who has an interest in the invention, may file a renewal of the application for the same invention, but such second application must be made within two years after the allowance of the original application.

From a decision of the primary examiner rejecting an application the applicant may appeal to the examiners-in-chief. If the applicant is dissatisfied with the decision of the examiners-in-chief he may appeal to the Commissioner,¹ with the further right of appeal from an adverse decision of the Commissioner to the Court of Appeals of the District of Columbia, sitting *in banc*.

When a patent is refused upon appeal, the applicant may have remedy by bill in equity; and the Court may adjudge that the applicant is entitled to receive a patent for his invention or any part thereof. Such adjudication, if it be in favour of the right of the applicant, authorises the Commissioner to issue a patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law.

¹ At the time of going to press a Bill has been introduced for the purpose of limiting the number of appeals within the Patent Office to one only.

A reissue is granted to an original patentee, his legal representatives, or the assignees of the entire interest, when the original patent is inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his invention or discovery more than he had a right to claim as new, provided the error has arisen through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.

An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. Interferences are declared in the following cases when all the parties claim substantially the same patentable invention: (1) Between two or more original applications containing conflicting claims. (2) Between an original application and an unexpired patent containing conflicting claims, when the applicant, having been rejected on the patent, files an affidavit that he made the invention before the patentee's application was filed. (3) Between an original application and an application for the reissue of a patent granted during the pendency of such original application. (4) Between an original application and a reissue application, when the original applicant files an affidavit showing that he made the invention before the patentee's original application was filed. (5) Between two or more applications for the reissue of patents granted on applications pending at the same time. (6) Between two or more applications for the reissue of patents granted on applications not pending at the same time, when the applicant for reissue of the later patent files an affidavit showing that he made the invention before the application was filed on which the earlier patent was granted. (7) Between a reissue application and an unexpired patent, if the original applications were pending at the same time, and the reissue applicant files an affidavit showing that he made the invention before the original application of the other patentee was filed. (8) Between an application for reissue of a later unexpired patent and an earlier unexpired patent granted before the original application of the later patent was filed,

if the reissue applicant files an affidavit showing that he made the invention before the original application of the earlier patent was filed.

Each party to an interference is required to file a concise preliminary statement, under oath, showing the following facts: (1) The date of original conception of the invention set forth in the declaration of interference. (2) The date upon which a drawing of the invention was made. (3) The date upon which the invention was first disclosed to others. (4) The date of the reduction to practice of the invention. (5) A statement showing the extent of use of the invention. (6) The date and number of any application for the same invention filed within twelve months before the filing date in the United States in any foreign country adhering to the International Convention or having similar treaty relations with the United States.

If the invention was made abroad the statement should set forth: (1) That the applicant made the invention set forth in the declaration of interference. (2) Whether or not the invention was ever patented; if so, when and where. (3) Whether or not the invention was ever described in a printed publication; if so, when and where. (4) When the invention was introduced into the United States, giving the circumstances, with the dates connected therewith, which are relied upon to establish the fact.

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than he had a right to claim as new, his patent will be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, may make disclaimer of such parts of the thing patented as he or they shall not choose to claim or to hold by virtue of the patent or assignment.

The duration of the patent is 17 years from the date of issue, and no fees are payable after sealing of the patent.

There is no requirement to work the patented invention.

COLONIES.

The United States patent covers Hawaii and the Panama Canal Zone, but separate registration is required in respect of Porto Rico and the Philippine Islands.

ARGENTINE REPUBLIC.¹

Patents are granted for 5, 10 or 15 years, excepting when the invention is already patented abroad, in which case the foreign patent will be confirmed in the Argentine Republic for a maximum period of ten years.

A certificate of addition expires as a rule with the principal patent.

Renewal fees may be paid in advance with a discount of six per cent., or may be paid in annual instalments of 10 pesos.

The patent must be worked within the term of two years from the issue date of the patent, and working must not be interrupted for more than two years at a time, except in case of accident or circumstances beyond the control of the patentee.

AUSTRIA.

Patents are granted for new inventions which allow of industrial application.

Patents are not granted: (1) for inventions the object or use of which is contrary to law or morality, or injurious to health, or which are obviously intended to mislead the public; (2) for scientific theories or principles as such; (3) for inventions the subject of which is reserved for a State monopoly; (4) for inventions of: (a) articles for human food and consumption, (b) pharmaceutical preparations and disinfecting agents, (c) materials produced by chemical processes; in so far as the inventions mentioned

¹At the time of going to press a Bill is under the consideration of Congress, the effect of which, if passed, will be to establish a uniform term of 15 years for all patents, subject to payment of progressive renewal fees.

in (4) do not relate to definite technical processes for the production of such articles.

An invention is not regarded as new if before the date of its application it has been so described in printed publications in any country that its use appears to be rendered possible to persons versed in the art: or has been so openly used, openly exhibited, or demonstrated in Austria that its use by persons versed in the art appears to be rendered possible; or has formed the subject of a privilege conferred under a former Act which has been in force but has since become common property.

The procedure in connexion with the prosecution of an application closely resembles that in Germany, which is noted more fully below.

The term of protection is 15 years, counting from the date of the advertisement of acceptance of the application in the *Patent Journal*, subject to payment of renewal fees amounting to 50, 60, 80, 100, 120, 160, 200, 240, 280, 360, 440, 520, 600, and 680 crowns from the second to the fifteenth year respectively.

Patents of addition granted for improvements are upkeep without payment of renewal fees, and expire with the prior patent to which they refer.

A patent has no effect against anyone who, at the date of the application, has *bonâ fide* used the invention in Austria, or has made the necessary preparations for such use.

The owner of a patent for an invention which cannot be practised without using an invention already patented may demand a licence from the prior patentee after three years from the date of the publication of the grant of the prior patent in the *Patent Journal*, if the later invention is of considerable industrial importance. The grant of a licence entitles the prior patentee to demand in turn a licence from the later patentee.

A patent may be wholly or partially revoked if the patentee or his legal successor neglects to work the inven-

tion or allow it to be worked in Austria to an adequate extent, or to do everything necessary to ensure such working. The revocation cannot take place before the expiration of three years from the date of the publication of the grant of the patent in the *Patent Journal*. This time limit does not hold good, however, if the patentee, notwithstanding that the invention is being worked abroad, and that the public interest requires working also in Austria, continues to satisfy the native demand exclusively or mainly by importation.

The revocation of the patent is preceded by a warning stating the reasons, and fixing a suitable term for the adequate working of the invention.

BELGIUM.

Letters patent are granted without restriction for every discovery or improvement capable of being worked as an article of industry or of commerce.

The patent is granted without previous examination, at the risk and peril of the applicant, without guarantee of the reality, novelty, or merit of the invention, or of the correctness of the specification, and without prejudice to the rights of third parties.

A patent of invention has a duration of 20 years, subject to payment of renewal fees amounting to 20 francs for the second year and increasing by 10 francs annually: a patent of importation for an invention already patented abroad is granted only to the foreign patentee or his representative, and expires with the corresponding foreign patent: a patent of improvement on which no renewal fees are payable expires with the prior patent to which it refers.

The patentee must manufacture the patented article, or cause it to be manufactured in Belgium within one year from the commencement of its manufacture elsewhere; and, if the article is manufactured abroad, must not discontinue the manufacture in Belgium during one year without sufficient cause.

An extension of one year to effect working may be granted by Royal decree.

If the patented article is not manufactured on an industrial scale in Belgium or outside Belgium, but the patentee also holds other foreign patents which it is to be presumed are being worked, it is advisable to insert advertisements in Belgian trade journals in the name of the patentee, stating his willingness to grant licences.

A patent may be declared void if it is proved that the invention has been employed, put into use, or worked by a third party in Belgium for a commercial purpose before the date of application for a patent; if the patentee has intentionally omitted to disclose part of his invention or has described it incorrectly; if it is proved that the invention has been previously published in print, unless in the case of inventions patented abroad the publication has been exclusively the result of a legal requirement; if the invention has been previously patented in Belgium, or outside Belgium save in the case of a patent of importation.

BOLIVIA.

Patents are granted for 3, 6 or 10 years, on the condition that the invention is worked within one year from the date of grant. To guarantee this working the applicant must leave a deposit in the National Bank of Bolivia, which is returned upon proof of working. No renewal fees are payable after the grant of the patent.

BRAZIL.

Patents are granted for 15 years, subject to payment of renewal fees amounting to 30 dollars for the second year, with an annual increase of 10 dollars.

Certificates of addition on which such fees are not payable are granted to the proprietors of letters patent and expire with the latter.

The patented invention must be worked in Brazil within three years from the date of the patent, and working must not be discontinued for more than one year.

CHILE.

Patents are granted for a maximum duration of 10 years with the possibility of prolongation, the term being fixed by the Government. The term within which working must be commenced is notified by the Government when the patent is granted: this term is generally one year. When it is impossible to effect the working in the term appointed, an extension of one year can usually be obtained. No renewal fees are payable after issue of the patent.

COLOMBIA.

Letters patent are granted for 5, 10, 15, or 20 years, at the option of the applicant. There are no renewal fees to pay, but working of the invention should not cease for one year in the absence of special circumstances.

CONGO INDEPENDENT STATE.

The patent law of this state is substantially the Belgian law.

The term of a patent of invention is 20 years from the date of application: the term of a patent of importation is limited to that of any foreign patent: a patent of improvement expires at the same time as the principal patent.

There are no requirements as to working and no renewal fees are payable after the issue of the patent.

COSTA RICA.

Patents are granted for a duration of 20 years: but a foreign inventor can only obtain a patent for the unexpired term of any patent for the invention granted in his own country.

No renewal fees are payable after the grant of the patent, but the invention becomes public property if it is not put into practice within two years from the date of registration of the patent, or if working is discontinued during three consecutive years.

CUBA.

Letters patent are granted for 17 years under provisions similar to those of the law of the United States of America.

No renewal fees are payable, but working should be effected within one year and one day from the date of the grant. Patentees entitled to the benefits of the International Convention are not obliged to effect working until the expiration of three years from the date of the application for a patent in Cuba.

DENMARK.

Patents are granted for inventions which can be industrially utilised, or the application of which can be made the object of industrial gain.

The following are not patentable:—(1) inventions which cannot be considered to be of any substantial importance; (2) inventions the use of which is contrary to law, morality, or public order; (3) inventions which at the date of the application have already been described in some generally accessible print, or have been brought openly into use in Denmark, so that experts are thereby enabled to exercise them; and (4) inventions of medicines and articles of food or of refreshment, and of processes for the production of articles of food.

The right to a patent belongs only to the inventor or to the person to whom his right has legally passed. If several persons apply for a patent for the same or substantially the same invention, the first applicant has a preferential right to a patent.

The term of protection is 15 years counting from the date of issue of the patent. Alterations may be protected by patents of addition, which expire with the main patent.

For every patent, excepting patents of addition, renewal fees are payable, amounting to 25 crowns for the second

and third years, 50 crowns for each of the next three years, 100 crowns for each of the following three, 200 crowns for each of the following three, and 300 crowns for each of the three remaining years of the term of the patent.

A patent has no effect against any person who, before the application was filed, had used the invention in Denmark or made material preparations for so doing.

When an application has been filed, the Patent Commission examine the documents to ascertain whether the application satisfies formal requirements, and whether the invention is novel and patentable; if the result of the examination is favourable, the application is advertised and the documents are open to inspection during eight weeks.

At any time within this period any person may give notice of opposition, whereupon the Commission decide on the case.

In the case of an adverse decision on an application, the applicant may apply to the Patent Commission to reconsider their decision, and, if the decision is still adverse, the applicant may apply to the Minister of the Interior to have the case examined by a Special Commission.

A patent becomes void if the patentee omits to work the invention in Denmark within three years from the date of issue of the patent, or if he discontinues working for more than one year. The Patent Commission may prolong these terms if it be proved that circumstances beyond the patentee's control have prevented the working, or the Patent Commission may relieve the patentee from the obligation to manufacture the patented article in Denmark, if it be shown that the costs involved thereby are out of reasonable proportion to the home consumption, provided that the patentee undertakes that the article will always be kept on sale in Denmark.

DANISH COLONIES.

Patents may be obtained in ICELAND and the DANISH WEST INDIES on application to the respective Colonial Departments, on conditions similar to those affecting Danish patents, but free from the obligation to pay renewal fees.

ECUADOR.

The author of an invention can obtain a patent for a term varying from 10 to 15 years, commencing from the date of decree of the grant. No renewal fees are payable after the date of grant.

FINLAND.

New inventions which can be used in industrial operations are patentable.

An invention is not considered new, if, before the application for a patent, it has been so publicly described or so openly exercised as to enable the invention to be practised by an expert.

Publication of an invention due to the application for a foreign patent is no obstacle to the grant of a patent in Finland to the same applicant or his legal representative, if an application is made in Finland within six months after such publication.

A patent is operative for a term of 15 years, counting from the day of granting the patent. Patents of addition are granted and expire at the same time as the principal patent to which they refer.

On every patent, excepting patents of addition, renewal fees are payable, commencing with the second year of the patent, such fee being 20 marks yearly for the second and third years, 40 marks from the fourth to and including the sixth year, 50 marks from the seventh to and including the ninth year, 60 marks from the tenth to and including

the twelfth year, and 70 marks from the thirteenth to and including the fifteenth year.

If within three years from the grant of the patent the invention has not been put into practice within the country to any considerable extent, or if the practice has been discontinued after that time, the patentee is bound to grant permission to others to use the invention. If the invention has not been utilised to any considerable extent within the country, but has been exercised abroad, the patentee is bound to supply the patented article to the public in Finland so far as is practicable and at a satisfactory price. If the patentee neglects so to do, a Court of Justice can, on demand, declare the patent forfeited.

FRANCE.

Any discovery or invention in any department of industry may be patented.

The following are considered as new inventions or discoveries:—the invention of new industrial products: the invention of new means, or the new application of known means, for obtaining an industrial result or product.

The following are not patentable:—(1) pharmaceutical compositions or medicines of all kinds: (2) schemes and combinations relating to credit or finance.

The duration of the patent is 15 years, counting from the date of application, subject to the payment of renewal fees amounting to 100 francs annually.

Letters patent applied for in due form are issued without examination as to novelty, at the risk and peril of the applicant, without guarantee of the reality, novelty, or merit of the invention, or of the accuracy of the specification.

Alterations, improvements, and additions may be protected by certificates of addition, on which renewal fees are not payable.

A patent for an improvement on an invention previously patented (the application being filed within a year from the date of filing the previous application for patent) may be validly granted to any applicant, whether he is the patentee of the prior patent or not, but only under the following conditions :—

If the application for the improvement is made by the original patentee himself or his assignee, the application is made in the ordinary way, the original patentee having a preferential right to protect his improvement during one year. When the application for the improvement is filed by any person other than the original patentee or his assignee, the application must mention the fact and must be transmitted to and deposited under seal at the Ministry of Agriculture and Commerce : at the end of one year the seal is broken and a patent delivered, which will be valid provided the patentee has not availed himself of his preferential right.

The transfer of the whole or part of a patent can only be recorded after the payment of all the fees for the remaining term of the patent.

A patent is null and of no effect :—(1) if the alleged discovery, invention, or application is not new; (2) if the alleged invention, *etc.*, is not patentable; (3) if the patent refers to theoretical or purely scientific principles, methods, systems, discoveries, and conceptions, the industrial applications of which are not indicated; (4) if the invention is contrary to public order or safety, to morals, or to the laws of the country; (5) if the title, under which the patent has been applied for, fraudulently indicates an object other than the real object of the invention; (6) if the specification is not sufficient for working the invention, or if it does not point out, fairly and completely, the means employed by the inventor; (7) if the patent is for an improvement on a previously patented invention, and has been granted, within one year of the date of the earlier patent, to a third party who has not complied with the conditions above noted.

Certificates of addition in respect of alterations, improvements, or additions, which are not closely connected with the original patent, are likewise null and of no effect.

No invention is considered as new which, in France or abroad, and before the date of filing the application, has received sufficient publicity to enable the same to be worked. Such publicity may result not only from appearance in print but also from disclosure in any other way.

A patentee forfeits all his rights if he fails to exploit his invention in France within the term of two years from the date of signature of his patent, or if he ceases to exploit it during two consecutive years, unless he justifies his inaction. In the case of patents granted to applicants entitled to the benefits of the Convention the period of grace for commencing working is three years from the date of application.

In the absence of actual manufacture, it is advisable that the patentee should submit his invention to interested parties in France with a view to granting licences.

The French patent covers continental France, Algeria, French Indo-China, Madagascar, and all French colonies, but does not extend to Tunis, for which an independent patent may be obtained.

GERMANY.

Patents having force throughout the Empire and Colonies are granted for new inventions which allow of industrial application.

Excepted from protection are:—(1) inventions the use of which is contrary to law or morality; (2) inventions of foods and products for human consumption or enjoyment, and medicines, as also substances prepared by chemical processes, in so far as these inventions do not relate to definite processes for the preparation of such articles.

An invention is not considered new if, at the date of application, it has already been described in printed publications of the last hundred years in any country, or has been publicly used within the Empire, in such manner that its use by experts appears possible.

The first applicant is entitled to the grant of a patent. A later application cannot give a right to a patent if the invention forms the subject of a patent of a prior applicant. If the subject of the later application is covered in part by a prior patent, the later applicant has only the right to a patent limited to the remaining part.

An applicant has no right to the grant of a patent if the essentials of his application have been taken from the descriptions, drawings, models, apparatus or constructions of another, or from a process used by him, without his consent, and if the latter enters an opposition on this ground. If the opposition results in the withdrawal or refusal of the application, the opponent may, if he applies for a patent for the invention within a month from the date of the decision, demand that his application be dated as of the day previous to the publication of the prior application.

The effect of the patent is to give the owner the exclusive right of producing the subject of the invention industrially, bringing it into use, vending or using the same. If the patent is granted for a process, the effect of the patent extends to the results produced directly by the process.

The patent has no effect against a person who, at the date of the application, had already used the invention within the Empire, or made the necessary preparations for using the same. Such person has the right to use the invention for the requirements of his own business either in his own works or in the works of others. This right can only be inherited or disposed of together with the business.

The duration of the patent is 15 years, the term of which commences with the day following the application for the patent. An improvement on or development of an invention

covered by a prior patent may be protected by a patent of addition, which is granted for the unexpired term of the prior patent.

There is payable on every patent, excepting patents of addition, at the commencement of the second and every following year of its duration, a renewal fee commencing at 50 marks and increasing annually by 50 marks.

A patent is declared null if it is proved:—(1) that the subject matter was not patentable; (2) that the invention forms the subject of a patent to a prior applicant; (3) that the essentials of the application have been taken from the descriptions, drawings, models, apparatus or constructions of another person, or from a process used by him, without his consent.

If any one of these objections is only partially made out, action for declaration of nullity will have the effect of limiting the patent to a corresponding extent.

After the expiry of five years from the date of publication of the grant the objection that the alleged invention was not patentable cannot be admitted.

A patent may be revoked at the end of three years from the date of publication of the grant:—(a) if the owner of the patent neglects to put the invention into practice within the Empire to an adequate extent, or, at any rate, to do everything that is necessary to ensure the exploitation of the invention; (b) if it appears to be to the public interest that licences to others to use the invention should be granted, but the patentee refuses to grant such licences for reasonable compensation and on adequate security.

To obviate any petition for revocation a patentee who does not manufacture in Germany should submit his invention to interested parties in Germany with a view to granting licences.¹

¹ Reciprocal arrangements have been made with Italy and Switzerland, whereby a resident in one of the contracting states is deemed to have worked his German patent by working a corresponding Italian or Swiss patent.

The application for the grant of a patent is made in writing and is to be accompanied by a specification, with drawings, if required.

Every application is examined by a primary examiner as to the novelty and patentability of the subject matter claimed. If the application is not made in accordance with the rules, or if the invention is not patentable, or is found to be anticipated wholly or in part, the applicant is notified and may amend his application, or he may meet the objections by filing arguments in support of the application. The Application Department then comes to a decision in the matter.

If the application appears to be allowable, the specification is open to inspection, and thereupon the legal effect of the patent comes provisionally into force.

Within the term of two months opposition may be lodged. Opposition can only be based upon the grounds that the subject matter is not patentable, or that the applicant is not entitled to a patent as above recited.

After the expiration of the term for opposition the Patent Office decides as to the grant of the patent.

Against a decision rejecting the application the applicant can appeal within one month, and against the decision in the case of opposition the applicant or the opponent can also appeal within the same time.

If the grant of the patent is finally decided upon, the Patent Office gazettes the grant and delivers the letters patent to the applicant.

MODEL REGISTRATION.

To constitute subject matter for a German patent a fairly high standard of invention is required. In the case of purely structural improvements involving no novel effect patents are as a rule refused. Any such minor invention may be protected, however, by registration as a 'useful model,' i.e., as a *Gebrauchsmuster*.

The procedure in registering a *Gebrauchsmuster* is similar to that in granting a patent, but no examination is made as to novelty. When there is doubt as to whether a patent will be granted, or when there is ground for supposing that the examiner will not allow a patent claim for any part of the invention, the usual practice is to file simultaneously a patent application and an *Eventual Gebrauchsmuster* application, requesting examination of the patent application before the other is proceeded with. The official fees on the *Gebrauchsmuster* application need only be paid if the patent is refused, and in this way the priority of the date of filing is secured for the *Gebrauchsmuster*, should the latter be maintained.

The duration of protection is divided over two periods of three years each; the renewal being subject to payment of a fee of 60 marks.

GUATEMALA.

Patents are granted for a term fixed between 5 and 15 years, but only to residents in Guatemala and subjects of states with which a convention¹ is in force.

HONDURAS.

Patents are granted for a term fixed by the Government—generally 10 years, subject to payment of renewal fees, the amount of which varies from 10 to 50 gold pesos according to circumstances.

HUNGARY.

Any new invention capable of being used in industry can be patented.

Excepted from protection are:—(1) inventions the use of which is contrary to law or morality; (2) inventions which

¹ Such a convention exists between Guatemala and the United States of America.

relate to arms for war purposes, explosives, ammunition, fortifications or ships of war necessary for increasing the belligerent power of the Austro-Hungarian army, the navy, or the Hungarian militia, provided that the Minister of Commerce enters an opposition against the grant of such patent; (3) scientific theories or principles as such; or (4) articles serving for human or animal nourishment, medicines and materials produced by chemical processes; but the processes employed in making such materials may be patented.

An invention is not regarded as new if, at the date of application, it has been so made known by printed publications or other reproductions, or by public working, use or exhibition within one hundred years preceding the application that its employment by persons skilled in the art is rendered possible, or if it has already been the subject of a patent, *i.e.*, a patent granted under a former Act of which the specification was not published.

Every application is examined by the Patent Office, and, if the requirements are not complied with, the applicant is required to amend his application. If the defects are not removed, or if the invention is thought to be unpatentable, the application is rejected.

If the Application Department, or, in the case of an appeal, the Judicial Department, consider the application to be in order, and find that a patent may be granted for the invention, the application is published, and, subject to the determination of any opposition, a patent is issued to the applicant.

A patent having for its object an improvement of any other invention forming the subject matter of a patent or of a pending application, can, within one year from the date of the application for a patent for the original invention, be granted only to the original applicant or his successors.

A patent has no effect against a person who, before the date of filing the application by the patentee, has used the

invention in Hungary or made preparations involving its use.

Patents are granted for a term of 15 years, reckoned from the day of application. Patents of addition expire with the prior patent to which they refer.

Renewal fees are payable from the second to the fifteenth year of the term of the patent, amounting to 50, 60, 70, 80, 100, 120, 140, 160, 200, 250, 300, 350, 400, and 500 crowns respectively.

A patent may be revoked wholly or in part:—(1) If the patentee has neglected to work or use his invention in Hungary to an adequate extent, or if he has unjustifiably interrupted such working or use, or if he has not at least done all that is necessary, according to his own and the country's circumstances and conditions, for securing and continuing such working. This withdrawal or revocation cannot, as a rule, take place until three years after the publication of the grant of the patent. Exceptionally such withdrawal or revocation can take place at an earlier date, if the patentee does not meet the demands of the country by working the invention in Hungary, or does not permit working to be carried out by granting licences, and does not fulfil this obligation within a term appointed by the Patent Office, notwithstanding that the invention is worked abroad and its working in the country is desirable in the public interest. (2) After three years from publishing the grant of the patent, if the patentee does not work his patent to an extent commensurate with the demand of the country and refuses to grant licences to trustworthy manufacturers for a suitable compensation and on good security.

Before such revocation the patentee is notified, a suitable term being allowed him to comply with the requirements.

ITALY.

The inventor of a new invention or discovery in industry, or his assignee, may obtain a patent.

An invention is considered new when it was not before known: or even when the particulars necessary for putting it into practice were unknown, though a general notion of it existed.

A new invention or industrial discovery already patented abroad, although published by issue of the foreign patent, may be patented by the inventor or his assigns, provided an application is made in Italy before the expiration of the foreign patent, and before the invention or discovery has been freely imported and worked in Italy by other parties.

The following are unpatentable:—inventions relating to industries contrary to law, morality, or public safety; inventions or discoveries which have not for their object the production of material articles; inventions or discoveries of a purely theoretical nature, and medicines of any kind.

The maximum term of a patent is 15 years, reckoning from the last day of one of the months of March, June, September or December, whichever next follows the day on which the application is made.

A proportional tax is required in addition to annual renewal fees. The former amounts to as many times ten lire as the number of years of the term of the patent. The renewal fees amount to 40 lire for the second and third years, 65 lire for the following three years, 90 for the seventh, eighth, and ninth years, 115 for the tenth, eleventh, and twelfth, and 140 for the remaining three years.

During six months from the date of the patent, patents for modifications are only granted to the author of the patented invention or discovery, or to those interested through him.

With regard to inventions and discoveries relating to all kinds of beverages or foods, the Patent Office transmits the specification, and whatever else may be necessary, to the Superior Board of Health, to obtain its advice before delivering a patent.

If the application is informally made, or if the invention is unpatentable, the application is rejected. Against a decision of rejection the applicant may appeal within fifteen days.

A patent is null:—(1) if it refers to unpatentable inventions or discoveries; (2) if although relating to beverages or foods it has been delivered by error against the advice of the sanitary authority; (3) if, through the fraud of the patentee, the title of the invention does not correspond to its real object; (4) if the specification annexed to the application for patent is insufficient, or conceals or omits any of the description necessary for putting into practice the patented invention or discovery; (5) if the invention or discovery is not new or does not relate to industry; (6) if the invention is a modification of one already patented and the application has been made within the six months of priority allowed to the inventor, and persons interested through him.

A patent of addition is also null when the improvement for which it was granted is not connected with the principal invention.

A patent ceases to be valid if, in the case of a patent granted for 5 years or less, the patented invention has not been worked within the year following the grant of the same, or if working has been suspended during a whole year; or, in the case of a patent granted for 6 years or more, if the invention has not been worked, or working has been discontinued for two years. In either case annulment will not ensue if the inaction arises from causes beyond the control of the owner or owners of the patent. The patentee who wishes to maintain his patent and does not manufacture in Italy is advised to advertise the patent for sale or royalty in suitable technical papers, and to make offers by letter to Italian manufacturers.

In the case where the patentee belongs to one of the states that have adhered to the International Convention revocation cannot be ordered until the expiration of three years from the date of the application for a patent in Italy.

Reciprocal arrangements have been made with Germany, whereby a resident in Germany or Italy is deemed to have worked his Italian patent by working a corresponding German patent.

JAPAN.

The first inventor of an industrial article or process, or his assignee or successor, may obtain a patent.

The following subjects cannot be patented :—(1) articles of food, drink or taste; (2) medicines or methods of compounding them; (3) articles prejudicial to public order or morality; (4) articles publicly known or publicly used in Japan before the date of application for a patent, excepting those which are known to the public by way of experiment for a term not exceeding two years.

The patent when granted has a duration of 15 years, counting from the date of registration, subject to payment of renewal fees, amounting to 10 yen for the second and third years, and increasing by 5 yen every three years. Patents of addition are granted which are not subject to payment of renewal fees, and which expire with the prior patent to which they refer.

The Director of the Patent Office may cancel a patent, if the patentee, without sufficient cause, has failed to work or exploit his invention in Japan within three years from the date of his patent, or if he discontinues such working or exploitation for more than three years, and has refused the offer of a third party to purchase or use the invention on reasonable terms.

LIBERIA.

Patents are granted for 20 years to the inventor or assignee of any invention not known or used by others within the Republic. No renewal fees are payable, but the invention must be put in active operation in the Republic within three years from the date of the patent.

LUXEMBURG.

Letters patent will only be granted for an invention patented or to be patented in Germany.

The application must be made in Luxemburg before publication of the invention in print or before the invention has been sufficiently used in public, either in Luxemburg or in Germany, to enable others to work it.

Letters patent are granted for a term of 15 years, counting from the day following the date of application, but expire as a rule with the corresponding German patent. A certificate of addition expires with the patent to which it refers.

Renewal fees are payable on every patent, excepting certificates of addition, amounting to 20 francs for the second year, and increasing by 10 francs every year.

Working of the invention within the Grand Duchy must be effected within three years.

MEXICO.

Patents are granted for 1 year, extensible to 20 years during the first year. There is no requirement to pay renewal fees, and no obligation to work the invention; but a patentee who does not work his invention in Mexico may be compelled to grant licences.

NETHERLANDS.

There is no patent law in force, but efforts are still being made to induce the Government to pass a law.

NICARAGUA.

Patents are granted by Congress and sanctioned by Executive Power. The duration of the patent is fixed by the Government—from 5 to 10 years, subject to payment of annual renewal fees, the amount of which varies from

£4 to £20. Working must be effected within the term of one year from the date of grant of the patent, and must not be abandoned thereafter for more than one year.

NORWAY.

In practice, patents are granted for all new inventions capable of industrial application excepting those the use of which is contrary to law, morality, or public order; as also inventions of articles of food, nourishment, or medicine for human use, and simple chemical compounds, but a patent may be granted for a process or apparatus for manufacturing these articles.

An invention is not considered new if, before the date of application, it has been published in Norway or abroad so as to be capable of being carried out by others: but publication in print, or by public exhibition, during the six months anterior to the application, will not prevent the grant of a valid patent.

A patent can be validly granted only to the true and first inventor or his assignee.

In the case of interfering applications proof of the date of making the invention may be called for. When it is impossible to ascertain which of several applicants is the first inventor, the patent is issued to the first applicant.

The patentee has, during two years from the date of application, a prior right to obtain patents for improvements or additions to the invention already patented.

Applications made on behalf of third parties for such patents are kept under seal by the Patent Commission and are only proceeded with after the expiry of these two years in case the patentee has not exercised his preferential right.

Patents are granted for a term of 15 years, counting from the date of application; additions or improvements may be protected by patents of addition expiring with the original patent. The renewal fees for original patents

amount to 10 crowns for the second year, and increase annually by 5 crowns.

A patent has no effect against persons who have used the invention in Norway before the date of application, or have made the necessary preparations for the use of the same.

Every application is subjected to examination as to the patentability of the invention and the form of the documents.

If the application does not comply with the rules, the applicant is notified and given opportunity to amend his application.

If the application is in order, and the invention appears *prima facie* to be novel and patentable, the Patent Commission publishes the application, and the documents are open to public inspection.

Within eight weeks from the date of publication any person may lodge notice of opposition to the grant of a patent; the applicant having the right to appeal against an adverse decision.

The official examination and search take place after publication, and in case of anticipation or other objection the applicant may be called upon to amend the application. The decision of the Commission is given within sixteen weeks from the date of publication. If the applicant is dissatisfied with the decision, he may lodge a protest, whereupon the Commission reconsiders the case. Should the decision be still adverse, the applicant may demand the revision of the decision by a Superior Commission, which decides the case upon the documents submitted to the Patent Commission.

A patent may be revoked by judgment of a Court if the patentee has not, within three years from the date of issue of the patent, either himself or through others, exercised the invention in Norway or offered the patented article for sale, or if the manufacture or sale has been discontinued

for one year. As the law does not absolutely require manufacture in Norway, it is sufficient if the patentee, by advertisement in Norwegian journals, offers for sale through an agent the patented articles or articles made by the patented process. Alternatively, or at the same time, offers may be made to grant licences or to assign the patent.

PANAMA.

Patents are granted for 5, 10, 15 or 20 years. No fees are payable after issue.

United States patents are effective in the Canal Zone.

PARAGUAY.

Patents are granted for a term of 10 years, free from the obligation of working, and of payment of renewal fees.

PERU.

Patents are granted for a maximum term of 10 years. There are no renewal fees to pay, but a certificate must be presented within the first two years of the patent term, proving that the invention has been introduced into Peru. An extension of the term for presenting the certificate may be obtained.

PORTUGAL.

A patent of invention may be granted to anyone who invents any manufactured article or material commercial product, or perfects or improves any known product or manufactured article of the same nature, or discovers any easier or less expensive means of obtaining it.

An invention is not considered new, if it has been described in any publication within one hundred years, or has been publicly used in Portugal or in the Portuguese Dominions,

The patent may be granted for a term of 15 years, or for a shorter term which may be prolonged to 15 years on payment of a fee of 3000 reis for each year the patent is maintained.

A patent of addition expires with the original patent.

The patentee is required to manufacture the patented article in Portugal, and to continue the manufacture without interruption of more than two years at a time, unless he can prove a legitimate impediment.

In case actual manufacture has not taken place in Portugal, but the patentee can tender sufficient excuse for his default, a certificate may be issued which, with a series of advertisements offering to sell the patent or grant licences, is sufficient to preserve the legal force of the patent.

The patent may be extended to cover the Portuguese Colonies on application made at any time within two years from the date of publication of the application in Portugal.

RUMANIA.

Patents of invention are granted for 15 years : patents of importation for inventions patented abroad are granted on application made within six months of the foreign grant.

Renewal fees are payable on patents of invention as follows :—second and third years 30 francs each, fourth and fifth years 60 francs each, sixth to tenth years 100 francs each, eleventh to fifteenth years 200 francs each. On patents of importation these fees are doubled.

Patents of addition are granted free from the obligation to pay renewal fees.

The patented invention must be worked in Rumania within four years of the date of the patent, and must not be interrupted for more than two years at a time.

RUSSIA.

Letters patent for inventions and improvements are granted to Russian subjects and foreigners, and not only to inventors but also to their successors.

Patents cannot be validly granted for inventions and improvements:—(a) which consist of scientific discoveries and abstract theories; (b) which are contrary to public order, morals or decorum; (c) which, prior to the date of application for patent, have been patented in Russia or have been used there without a patent, or which have been described in printed books or journals in sufficient detail to enable them to be reproduced; (d) which are known abroad without a patent, or which are patented there in the name of a person other than the applicant or his assignee; (e) which are wanting in substantial novelty, but amount only to insignificant modifications of previous inventions. Further, patents are not granted for chemical, nutritious, or gustatory products, for medical compounds, or for processes and apparatus for the manufacture of medical compounds.

The application for patent must be accompanied by a specification, with drawings (if required), sufficiently detailed to enable the invention to be worked therefrom, and is examined as to the sufficiency of the specification and the patentability of the invention; after considerable delay a decision is issued either rejecting the application or notifying what claim or claims may be allowed.

If the applicant is dissatisfied with the decision, he may appeal within three months.

Patents are granted for 15 years, counting from the date of sealing. A patent for an invention already patented abroad before the date of filing the application in Russia cannot have a longer term than that of the foreign patent; if the same invention is patented in several foreign states, the Russian patent ceases to be in force with the expiration of the shortest term for which a patent was granted abroad.

After the expiry of one year from the publication of the grant, any person may obtain a patent for an improvement on the subject matter of the first patent. This second patent cannot be used by the original patentee, or by the second patentee, except by the mutual consent of the parties.

Renewal fees are payable as follows :—20 roubles for the second year, with an annual increase of 5 roubles for the next two years; 40 roubles for the fifth year, and 50 roubles for the sixth year, with an annual increase of 25 roubles for the next four years, the annual increase being then raised to 50 roubles. Patents of addition are granted which are not subject to payment of renewal fees.

The patentee must, within five years from the date of sealing the patent, put the patented invention into practical use in Russia, and file with the Industrial Section of the Ministry of Finance a certificate of such working by a competent authority nominated by the Minister of Finance.

SALVADOR.

Patents are granted for 20 years (or for the term of any foreign patent presented). Working is not required, but renewal fees of 50 dollars are due before the end of the fifth year, 75 dollars before the end of the tenth year, and 100 dollars before the end of the fifteenth year.

SPAIN.

Every Spaniard, or foreigner, whether an individual or a legal entity, who intends to establish or has established, on Spanish territory, a new industry, has the right to a patent.

A patent of invention gives the right to the exclusive manufacture, exercise, production, sale and use of the object of the invention; a patent of importation gives

the exclusive right to manufacture, exercise or produce the invention, but does not give power to prevent the importation and sale of similar articles received from abroad.

Every new invention which yields an industrial product or result may be the subject of a patent.

The foregoing comprises:—(a) machines, apparatus, instruments, processes or mechanical or chemical operations which are entirely or partly original and novel, and which may be the subject of a patent of invention; and those which, without fulfilling these conditions, have not been established or practised in Spanish territory and which may be the subject of a patent of importation; (b) new industrial products or results obtained by means either novel or previously known; provided that the working of the latter will establish a branch of industry not practised in the country.

The duration of patents of invention is 20 years, and of patents of importation 5 years, subject to payment of renewal fees amounting to 20 pesetas for the second year, with an annual increase of 10 pesetas.

Alterations or modifications of, or additions to the invention, if made by the patentee, are protected by certificates of addition.

The owner of a patent or of a certificate of addition is required to prove, within the term of three years from the date of the patent or certificate, that he has put it into practice on Spanish territory, establishing therein a new industry.

Working is considered as effected by the manufacture, production or execution of the subject of the patent in a reasonable proportion to its employment or consumption; if there is no market for the article, the existence at the disposal of the public of machines or materials sufficient for the manufacture is considered as working.

An official working certificate is issued on the favourable report of any properly accredited engineer; such reports

can usually be obtained by our correspondents, even when no actual manufacture has taken place.

Working must not be discontinued for a year and a day, unless the patentee proves that his inaction was due to *force majeure*. To rework the patent each year it is sufficient to advertise in one or more public journals offering the patent for sale or licence.

A Spanish patent covers all Spanish possessions.

SWEDEN.

Patents are granted to the inventors of industrial products or of particular methods of manufacturing such products, or to the assignees of such inventors.

Patents are not granted for inventions the use of which would be contrary to law or morality. In the case of an invention relating to food-stuffs or medicines, a patent is not granted for the commodity itself, but only for the particular method of manufacturing the same.

An invention is not considered new, if it has, prior to the date of the application for a patent, been so described in any printed publication to which the public have access, or so openly worked, that any person conversant with the subject can work the invention; or if the object of the invention does not differ materially from products or methods of manufacture already known.

Every application is examined and the sufficiency of the specification and the patentability of the invention considered.

If the nature of the invention is not of such a character that a patent may be granted, or the invention is evidently not new, the application is rejected; the applicant having an opportunity to meet the objections.

If the documents are in order, and there is no cause for rejection of the application, the application is advertised, and the specification laid open for public inspection.

During two months after the advertisement anyone may lodge notice of opposition; at the end of this term the Patent Office issues its decision.

When several persons seek patents for the same, or substantially the same invention, precedence is given to the party who first leaves complete application papers.

Letters patent are granted for a period of 15 years from the day of leaving the application. A patent of addition may be granted for the unexpired term of the principal patent.

Upon every patent granted, excepting patents of addition, renewal fees are payable, amounting for the second, third, fourth and fifth years of the patent to 25 crowns *per annum*; for each of the following five years 50 crowns, and for each of the remaining five years 75 crowns.

If the patented invention is not worked in Sweden to an extent substantially corresponding to the circumstances of the country within three years from the date of the grant of the patent, any person who requires a licence to use the invention may bring the patentee to Court. If the request is allowed, the Court determines with what restrictions, on what conditions, and for what compensation a licence may be granted to the petitioner.

A patent has no effect against any person who, at the date of application for a patent, had worked the patented invention within the country or made material preparations for such working.

SWITZERLAND.

Patents are granted for new inventions capable of industrial application.

The following cannot be patented:—(1) inventions the use of which would be contrary to law or morality; (2) inventions of chemical substances, and inventions of chemical processes for the manufacture of chemical

substances intended principally for the nourishment of man or beast; (3) inventions of medicines, foods, and beverages for the use of man or beast, which are obtained otherwise than by chemical methods, as also inventions of processes for the manufacture of these products; (4) inventions relating to products obtained by the application of processes, not purely mechanical, for the improvement of textile fibres of all kinds, whether raw or manufactured, and also such processes, in so far as these relate to the textile industry.

An invention will not be considered new if, before the date of the application, it has been divulged in Switzerland or disclosed by writings or drawings in publications in Switzerland in such a way that it can be carried out by persons skilled in the art.

A patent cannot prejudice any person who, at the date of filing the application, was *bond fide* working the invention industrially in Switzerland or had made special preparations for working it there. Such person has the right to use the invention for the requirements of his business, but can only transfer this right to others along with the business.

The term of a principal patent is 15 years at most, to date from the filing of the application; that of patents relating to chemical processes for the manufacture of medicines is limited to 10 years.

On every principal patent renewal fees are payable amounting to 30 francs for the second year, increasing by 10 francs annually.

The owner of a principal patent may obtain an additional patent for an improvement or development of the patented invention. For such additional patent no renewal fees are payable.

Additional patents may at any time be converted into principal patents. If several additional patents are dependent on one principal patent, and one is converted into a principal patent, one or more of the others may be made

dependent on it, and new patents of addition dependent on it may be issued. None of these patents can remain in force beyond the 15 years of the first principal patent.

At the end of the third year of the patent any person, on proving that he is interested, may institute an action for revocation if, prior to the institution of the proceedings, the invention has not been worked to a sufficient degree in Switzerland, and if the owner cannot give sufficient reason therefor.

The Federal Council may declare the requirement of working in Switzerland inapplicable as regards patentees belonging to states which grant reciprocity.¹

TUNIS.

Patents are granted for 15 years, subject to payment of annual renewal fees of 100 piastres. Certificates of addition are issued on which such fees are not payable and which expire with the patent to which they refer.

Working is required within two years from the date of sealing the patent, and must not be discontinued for more than two years.

Where the patentee belongs to a state which has adhered to the International Convention, revocation cannot be ordered until the expiration of three years from the date of application for a patent in Tunis.

TURKEY.

Patents having force throughout the Ottoman Empire are granted, without examination as to novelty, for a period of 15 years, subject to payment of renewal fees amounting to £T.4 *per annum*. A certificate of addition may be granted for the unexpired term of the principal patent, without payment of renewal fees.

¹ Reciprocal arrangements have been made with Germany, and the United States of America.

A patent for an invention already patented abroad expires with the corresponding foreign patent.

Working is required within two years from the date of the patent, and must not be discontinued for two consecutive years. A certificate of working can usually be obtained at small cost, but where this is impossible we can make application for an extension of time to effect working.

Importation of the patented article into Turkey, without permission, involves forfeiture of the patent.

URUGUAY.

Patents are granted for 3, 6, or 9 years, subject to payment of an annual renewal fee of 25 dollars. The applicant is required to file a declaration that the invention is in its first year of working, or that the original foreign patent is still in its first year.

The term of working is fixed by the Government when granting the patent, this term being generally two years.

VENEZUELA.

Letters Patent are granted for 5, 10, or 15 years; or, in the case of an invention patented abroad, for the unexpired term of the foreign patent.

The patented invention must be worked within a term which is indicated in the patent; such working need not be effected in Venezuela.

No fees are required to maintain letters patent in force after the date of grant.

OTHER FOREIGN STATES.

In Bulgaria, China, Crete, Greece, Haiti, Monaco, Montenegro, Santo Domingo, and Servia patents are not granted by law, but special privileges may be awarded by

the administrative authorities, in the case of important inventions, or where sufficient influence can be brought to bear on the parties in power.

In several states of little industrial importance, such as Abyssinia, Afghanistan, Korea, Morocco, Persia and Siam, concessions may be secured for such value as they may have.

The infringement of British patents in countries where the principle of extra-territoriality applies is forbidden by various Orders in Council.

MARKING ARTICLES "PATENTED."

In Canada the neglect to mark a patented article renders the patentee liable to a fine—in the United Kingdom, United States of America, Australia, Japan, Mexico and Switzerland to forfeiture of certain rights.

We recommend that patented articles be marked as follows :—

AUSTRALIA	.	.	"Patented," followed by the date and number.
AUSTRIA	.	.	"O.P. Nr.——."
BELGIUM	.	.	"Brevet No.——."
CANADA	.	.	"Patented," followed by the year.
DENMARK	.	.	"Dansk Patent No.——."
FRANCE	.	.	"Bté. S.G.D.G."
GERMANY	.	.	"D.R.P. No.——," if for a patent of invention.
GERMANY	.	.	"D.R.G.M. No.——," if for model registration.
HUNGARY	.	.	"Magy. szab——sz."
ITALY	.	.	"Brevettato, Vol. R.A. . . .No.——."
JAPAN	.	.	Patent date and number in Japanese characters.
LUXEMBURG	.	.	"Brevet Luxembourgeois No.——."
NORWAY	.	.	"Norsk Pat. No.——."
PORTUGAL	.	.	"Privilegiado Pat. No.——."
RUMANIA	.	.	"Brevet de inventiune. Regal Roman No.—— fara garantia guvernului."
RUSSIA	.	.	"Patent No.——" (in Russian characters).
SPAIN & SPANISH AMERICA			"Patentado en —— No.——."

- SWEDEN . . . " Svenskt Pat. No.——" ."
- SWITZERLAND . . . Federal Cross and the number of the patent.
- TUNIS . . . Brevet  sans garantie du Gouvernement Tunisien.
- UNITED KINGDOM & COLONIES (other than those above mentioned). " Patent No.——" and the year.
- UNITED STATES OF AMERICA . " Patent," followed by the day and year.

PROTECTION OF TRADE MARKS ABROAD.

The protection of his trade marks abroad is of the highest importance to the manufacturer or merchant who seeks to gain and maintain a footing in foreign and colonial markets. Immunity from piratical imitation is not assured by registration in the United Kingdom. On the contrary, a separate registration is required for every colony or state in which protection is wanted. Priority of user may be the foundation of a legal right, but experience shows that this is frequently lost by inaction or diverted from the true proprietor who finds his trade mark registered by an unscrupulous competitor, and the market closed to his goods.

In the colonies the law is substantially identical with that at home, the registration Acts being in many colonies reinforced by Merchandise Marks Acts similar to those of the United Kingdom. In most foreign states a condition antecedent to registration, or at least to the obtainment of efficient protection, by a British manufacturer is that the trade mark should be already registered in the United Kingdom, so that variations between the definition of a registrable trade mark in this country and foreign definitions are of no practical interest to the reader.

Certain facilities are afforded in accordance with the terms of the International Convention already referred to.

An arrangement signed at Madrid in 1891, to which, however, Great Britain is not a party, establishes an Inter-

national Office at Berne for registering trade marks. This arrangement applies only to subjects or citizens of the contracting states.

The United Kingdom is a party, however, to an arrangement, also concluded at Madrid in 1891, for the prevention of false indications of origin of goods. The other parties to the arrangement are Brazil, Cuba, France, Portugal, Spain, Switzerland and Tunis.

We append a list of the countries where registration can be effected, and shall be pleased to supply further particulars if required.

Argentine Republic.	Falkland Islands.
Australia.	Fiji.
Austria.	Finland.
Bahamas.	France and Colonies.
Barbados.	Gambia.
Belgium.	Germany and Colonies.
Bermudas.	Gold Coast Colony.
Bolivia.	Greece.
Brazil.	Guatemala.
British Guiana.	Guernsey.
British New Guinea.	Honduras.
British North Borneo.	Hong Kong.
Bulgaria.	Hungary.
Burma.	Iceland.
Canada.	India.
Cape Colony.	Italy.
Ceylon.	Jamaica.
Chile.	Japan.
China.	Jersey.
Colombia.	Labuan.
Congo Independent State.	Lagos.
Costa Rica.	Leeward Islands.
Cuba.	Luxemburg.
Curaçoa.	Malta.
Denmark.	Mauritius.
Dutch East Indies.	Mexico.
Ecuador.	Natal.
Egypt.	Netherlands.

Newfoundland & Labrador.	Seychelles.
New Zealand.	Southern Nigeria.
Nicaragua.	Spain.
Norway.	Straits Settlements.
Nyasaland Protectorate.	Sudan.
Orange River Colony.	Surinam.
Panama.	Sweden.
Paraguay.	Switzerland.
Peru.	Tahiti.
Philippine Islands.	Transvaal.
Porto Rico.	Trinidad and Tobago.
Portugal and Colonies.	Tunis.
Rhodesia.	Turkey.
Rumania.	United States of America.
Russia.	Uruguay.
Salvador.	Venezuela.
Santo Domingo.	Zanzibar
Servia.	

As to colonies not above mentioned it may be remarked that Merchandise Marks Acts are in force in British Honduras, Cyprus, Gibraltar, Grenada, Mysore, St. Lucia, St. Vincent, and Sierra Leone, which make it a criminal offence to forge a trade mark. Various Orders in Council and international agreements provide against infringement of British trade marks in Korea, Morocco, Siam and Uganda. In other states some protection may be obtained by advertising the proprietor's claim to the exclusive use of the mark.

REGISTRATION OF DESIGNS ABROAD.

Various proposals have been made to establish an International Register of designs, but no such suggestion has yet been carried into practice.

Copyright in designs can be obtained by separate registration in many of the colonies and foreign states in which patents are granted. The International Convention also applies to industrial designs and models, so that in states belonging to the Union four months' priority may be obtained by British applicants.

The period of protection varies in each state, from two years in Italy to perpetuity in France and Belgium. The cost is generally low, and in many states a number of designs may be registered as a series in one registration, so that the average cost for each design is insignificant.

We shall be pleased to furnish further particulars on request.

APPENDIX.

While the above treatise has been made as complete as limits of space permit, it does not and is not intended to take the place of legal text books which besides containing fuller reports of decided cases also give particulars required by practitioners as distinguished from lay clients. To these we desire to acknowledge our indebtedness, while also directing to these sources readers in quest of further information.

The following are the more important and recent contributions to patent literature which we have consulted and utilised :

Dr. William Martin :	The English Patent System.
Robert Frost :	Patent Law and Practice.
	The Patents and Designs Act, 1907.
J. Roberts and H. Fletcher Moulton :	The Patents and Designs Act, 1907.
J. W. Gordon :	The Statute Law relating to Patents of Invention and Registration of Designs
J. M. Easton :	Copinger's Law of Copyright.
D. M. Kerly and F. G. Underhay :	The Trade Marks Act, 1905.
L. B. Sebastian :	The Trade Marks Act, 1905.

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